THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Oral Hearing: October 16, 2007

Mailed: January 15, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

The Ritz-Carlton Hotel Company, L.L.C.
v.
Robert B. Wilcox

Opposition No. 91161969
to application Serial No. 76553029
filed on October 21, 2003

Douglas R. Bush of Arent Fox Kintner Plotkin & Kahn, PLLC for The Ritz-Carlton Hotel Company, L.L.C.

Richard D. Clarke for Robert B. Wilcox.

Before Quinn, Bucher and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Robert B. Wilcox, seeks registration of the mark RITZ (in typed form) for services identified in the application as "art galleries offering original and limited edition fine art, namely, paintings, photographs, sculptures and prints" in International Class 35.[1]

[1] Serial No. 76553029, filed October 21, 2003, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

Opposer, The Ritz-Carlton Hotel Company, L.L.C., has opposed registration of applicant's mark on the grounds that applicant's mark RITZ proposed to be used for art gallery services so resembles opposer's previously used and registered marks "containing RITZ, including RITZ, RITZ-CARLTON, THE RITZ-CARLTON CLUB, THE RITZ KIDS, PUTTIN' ON THE RITZ, and THE RITZ-CARLTON LODGE," used in connection with various goods and services, "including fine art related goods and services such as hosting and sponsoring fine art exhibitions, leisure packages featuring tours of fine art collections, art tour guide books, and the sale of fine art and related goods; hotel, resort, restaurant, cabaret, cocktail lounge and bar services; recreational sports services; casino facilities; fund raising services; clothing; and paper goods and printed matter" that it is "likely to cause confusion, mistake, and deception as to the source or origin of Applicant's services and will injure and damage Opposer and the goodwill and reputation symbolized by the RITZ Marks" under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). Notice of Opposition ¶¶ 1, 9. In addition, opposer asserts a claim of dilution under Section 43(c) of the Trademark Act and a claim of false suggestion of a connection under Section 2(a) of the Trademark Act.

Applicant has filed an answer by which it has denied the salient allegations.

The evidence of record consists of the pleadings herein, the file of the opposed application, and trial testimony with accompanying exhibits taken by opposer of Julia Gajcak, opposer's vice president of marketing and communications, and Derek Andrew Flint, one of opposer's hotel managers and former senior corporate director of rooms. In addition, opposer submitted the following material under a notice of reliance: certified copies of fourteen of opposer's pleaded registrations, which show that the registrations are subsisting and owned by opposer; applicant's responses to opposer's interrogatories and requests for admissions; excerpts from pages of various printed publications showing, inter alia, third-party use of RITZ to identify opposer and associate opposer with fine art; and website printouts submitted upon stipulation showing, inter alia, opposer's association with art. Applicant did not take any testimony or file a notice of reliance.[2] An oral hearing was held at which both parties were represented by counsel.

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[2] Applicant's complaint that "opposer's attorneys engaged in a methodical 'delay and discourage' campaign and resisted every effort by Applicant to gather any type of evidence" and that "Applicant's evidence is not submitted because every effort to gather evidence was effectively blocked by Opposer" (Br. p 9-10) is not supported. There is nothing in the prosecution history of

**PRIORITY AND LIKELIHOOD OF CONFUSION**

As noted above, opposer submitted fourteen registrations and we summarize seven of them below:

Registration No. 1094823 for the mark RITZ-CARLTON (in typed form) for "hotel services" in International Class 42, issued on June 27, 1978, renewed;

Registration No. 1535834 for the mark RITZ for "hotel and restaurant services, including grill rooms, snack bars, bars, cabarets and tea room services" in International Class 42, issued on April 18, 1989, Section 8 accepted and Section 15 acknowledged;

Registration No. 1905234 for the mark THE RITZ-CARLTON for "cleansers: namely, skin soaps, hair shampoo and conditioner" in International Class 3, "metal key rings" in International Class 6, "paperweights, stationery, underarm portfolios, letter pads, folders holding notepaper pads, paper shopping bags, playing cards" in International Class 16, "passport cases, all-purpose sports bags, golf umbrellas, luggage tags, men's and women's valet bags, tote bags, duffle bags, luggage canvas bags" in International Class 18, crystal boxes for decoration, drinking glasses, coffee mugs, coasters" in International Class 21, "bath linens" in International Class 24, "clothing, namely, visors, golf caps, robes for use by and sale to hotel guests, golf shirts, tennis shirts, shorts, t-shirts, sweat shirts" in International Class 25, "toys, namely, stuffed animals, golf balls" in International Class 28, "processed foods, namely, jam jellies" in International Class 29, "staple foods, namely, candy, honey, sugar, ketchup, mustard" in International Class 30, "matches" in International Class 34, "entertainment services in the nature of cabarets" in International Class 41, and "hotel

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this case that would indicate any improper behavior by opposer's attorneys, nor did applicant at any time file a motion to compel.

services, restaurant services, restaurant services offering a grill room, snack bar, and tea room, cocktail lounge and bar services" in International Class 42, issued on July 18, 1995, renewed;

Registration No. 2298901 for the mark RITZ-CARLTON (in typed form) for "apartment, condominium and real estate management services; real estate brokerage services and real estate time-sharing services" in International Class 36, issued on December 7, 1999, Section 8 accepted and Section 15 acknowledged;

Registration No. 2446217 for the mark PUTTIN' ON THE RITZ (in typed form) for "charitable fundraising services" in International Class 36, issued on April 24, 2001;

Registration No. 2869095 for the mark RITZ (in typed form) for "providing gaming services accessed via local and worldwide computer networks, personal digital assistants, and electronic computer databases" in International Class 41, issued on August 3, 2004; and

Registration No. 2934838 for the mark RITZ (in typed form) for "hotel services, restaurant, catering, bar and lounge services, resort lodging services, provision of general purpose facilities for meetings, conferences and exhibitions, provision of banquet and social function facilities for special occasions, and reservation services for hotel accommodations" in International Class 42, issued on March 22, 2005.

Because opposer has made the pleaded registrations summarized above properly of record, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In addition, opposer has established common law rights in the marks RITZ-CARLTON, RITZ-CARLTON with lion logo

design and RITZ for use in connection with hotel services prior to the filing date of applicant's application (Gajcak Test. pp. 11-12 and 15).[3] Further, in connection with the hotel services opposer has also established that since prior to applicant's filing date opposer offers for sale in its RITZ-CARLTON gift stores and RITZ-CARLTON catalogues various types of fine art (Flint Test. pp. 13, 26, 35), offers art classes as part of its hotels' amenities (Flint Test. 33-34), hosts art exhibitions and auctions in its hotels (Flint Test. 33, 90-91); and has third-party art galleries in some of its hotels (Flint Test. pp. 55-56). Finally, in connection with the hotel services, opposer also displays art throughout its hotels, including pieces that are for sale (see, e.g., Flint Test. p. 26), provides art tours of its own hotels (Flint Test. 30, 71-72), and offers hotel packages that include access to local galleries and museums (Flint Test. 31, 33).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Two key considerations are the similarities between the marks

[3] We refer to the registered and common law marks collectively as

and the similarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Another important factor, when presented, is the fame of the mark. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

We begin with the factor of fame because fame "plays a 'dominant' role in the process of balancing the du Pont factors." Recot Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). "[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

The record shows that opposer owns several registrations for RITZ-CARLTON, RITZ-CARLTON with lion logo design and RITZ for a wide variety of goods and services, and the marks have been continuously registered since 1978, 1995 and 1989 respectively. Opposer advertises in widely circulated publications such as *The Wall Street Journal*, *The*

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"the RITZ marks."

*New York Times*, *Conde Nast*, *Town & Country* and *Vanity Fair*. Gajcak Test. p. 44. Its website receives 1.4 million visitors a month. Gajcak Test. p. 57. Ms. Gajcak testified that the Luxury Institute in New York recognized RITZ-CARLTON as being the most prestigious luxury brand in the United States. Gajcak Test. pp. 30-33, Exh. Nos. 9, 10. Opposer has also received several awards, including Mobil Five-Star awards, AAA Five-Diamond awards and the Malcolm Baldrige National Quality Award. Gajcak Test. pp. 37-38, Exh. No. 11. Opposer spends approximately $9 million annually on advertising. Its annual worldwide revenues are approximately $3 billion, the majority of which is generated from activities within the United States. Gajcak Test. p. 59. In 2006, approximately 3 million room nights were booked in the United States. Gajcak Test. p. 59.

Opposer's RITZ-CARLTON marks (with and without the lion logo) appear on a variety of merchandise, including robes, soap, tea, pasta, shampoo, body lotion, polo shirts, baseball caps, etc. Flint Test. Exh. Nos. 9-13. With regard to use of the term RITZ by itself, the most pronounced use is by the public to identify opposer. Flint Test. p. 25 Gajcak Test. p. 13. There are many examples in the record of the press and third-parties referring to opposer as "the RITZ." See Exh. No. 30 ("The luxe life comes to a congested and somewhat seedy corner of South

Beach in the form of this beachfront, lushly landscaped Ritz-Carlton. Debuting in the fall of 2003, this Ritz has restored the landmark Morris Lapidus-designed 1950s DiLido Hotel to its original Art Moderne style and filled it with the hotel's signature five-star service." www.southfloridaceo.com) and Exh. No. 18 ("On Feb. 5, social and civil leaders gathered at the South Beach Ritz for a gala evening of elegance..." *The Miami Herald*, February 14, 2005; "The view from the Ritz of New York Harbor, with the Statue of Liberty and city lights twinkling against a winter's night sky..." *The Record*, February 13, 2005; "Would she! Cowie and Oprah's film crew descended on the Ritz on Friday." *The Plain Dealer*, February 1, 2005; "The trip from the Ritz to the airport was an adventure Saturday afternoon." *The Atlanta Journal-Constitution*, January 30, 2005; "'The invitations went out very late, and people couldn't find rooms at the Ritz or the Four Seasons.' Cilione said." *The Palm Beach Post*, January 30, 2005; "'We thought, What about giving tech support that's as welcoming as the bar at the Ritz?'" *New York Times*, January 27, 2005; "There's just something special about the Ritz (the old one) and you know it the second you walk in the door. There's tradition. There's history. There's elegance." *Boston Herald*, January 27, 2005; "Frankly, I don't know if I'll ever be able to make up for the time I fed my sister Lauren

swamp water, so I took my suburban mom to tea at the Ritz." *The Boston Globe,* May 8, 2003; "Casino MonteLago, which held a soft opening for a group at the Ritz last week and hosts its grand opening Thursday, expects to draw tourists from the Ritz-Carlton as well as visitors to other Lake Las Vegas amenities such as golf courses, upscale boutiques and a nearby condo complex." *Las Vegas Sun*, May 7, 2003; and "Ritz deal threatens to unravel...The Ritz developers have asked the Baltimore Circuit Court to order the owner of the planned hotel site to honor a previous agreement to sell them the land." *The Baltimore Sun*, May 9, 2003).

Based on the record, we find that the evidence demonstrates that the RITZ marks are famous for, at a minimum, hotel services. Thus, given the wide latitude of protection afforded famous marks, we proceed with our analysis keeping this in mind. See Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Further, the broad scope of protection afforded to famous marks "applies with equal force when evaluating the likelihood of confusion between marks that are used with goods [or services] that are not closely related." Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

We next consider the similarity or dissimilarity of the marks when compared in their entireties in terms of

appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result.

In comparing opposer's marks RITZ, RITZ-CARLTON and RITZ-CARLTON with lion logo design, with applicant's RITZ mark within the above-noted legal parameters and taking into account the fame of opposer's marks, we find the points of similarity outweigh the dissimilarities. ESSO Standard Oil Co. v. Sun Oil Co., 229 F.2d 37, 108 USPQ 161, 163 (D.C. Cir. 1956).

Opposer's mark RITZ is identical to applicant's mark RITZ. In addition, in considering the similarity of appearance with the stylized RITZ mark, because applicant's mark is in standard character form, we must consider the possibility of it being presented in any reasonable form of display including the manner in which opposer's mark is displayed. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000).

With regard to the RITZ-CARLTON and RITZ-CARLTON and design marks, the term RITZ is the first and more memorable

literal portion of both of these marks. As shown by the evidence, RITZ-CARLTON is frequently shortened to RITZ by the public. See In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable"). RITZ is also registered and used separately by opposer and in connection with other wording (PUTTIN' ON THE RITZ and THE RITZ KIDS). CARLTON is never used in this manner. Thus, the addition of the term CARLTON is not sufficient to distinguish them from applicant's RITZ mark. Moreover, although there is no general rule as to whether a word or a design dominates a particular mark, given the common use of the word RITZ in calling for the services we find that the term RITZ also dominates over the lion logo design. Thus, we accord the term RITZ greater weight in determining the likelihood of confusion as between these marks. Ceccato v. Manifattura Land Gaetano Marzotto & Figli S.p.A., 32 USPQ2d 1192 (TTAB 1994). In doing so, we find that applicant's RITZ mark is similar in appearance, sound, connotation and commercial impression to opposer's RITZ-CARLTON marks.

Thus, we find that the overall commercial impression engendered by each of these marks is such that the similarities outweigh the differences. Taking into consideration the fame of opposer's RITZ marks, we conclude that the parties' marks are identical or substantially similar. Therefore, the factor of the similarity of the marks weighs in favor of opposer.

Applicant's argument that the term RITZ "has acquired usage as a common noun by the general public [and] [f]or this reason, the word 'ritz' alone may very well be generic," (br. p. 11) is not well taken. We first note that applicant has not filed a counterclaim against any of the registrations, thus, this argument constitutes an impermissible collateral attack at least insofar as the registered marks are concerned. Moreover, there is no evidence in the record to support this argument with respect to any of opposer's marks, whether registered or the subject of common law use. While we may take judicial notice of the dictionary definition of the term RITZ, this is irrelevant to the consideration of whether RITZ is generic of any of opposer's goods and services. Alberto-Culver Co. v. Helene Curtis Ind., Inc., 167 USPQ 365, 370 (TTAB 1970) ("The fact that a word or term may be found in a dictionary does not indicate that the word is lacking in trademark significance

unless the dictionary meaning of the word is descriptive of the goods in connection with which it is used.")

Similarly, applicant's unsupported reference to third-party uses and registration of the word RITZ is not persuasive. There is no evidence in the record of third-party use or registration. Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. TBMP §704.06(b) (2nd ed. rev. 2004). Respondent's mere references in its brief is not sufficient to make the registrations of record. Id. at 704.07. Further, there is no testimony or other evidence of third-party use, or the possible effect, if any, of such purported uses on potential consumers. In view thereof, this factor is neutral.

With regard to the services, although opposer provides a variety of goods and services, opposer's primary service consists of hotel services. However, while applicant's gallery services are obviously different, opposer, in conjunction with its hotel services, provides art-related services and serves essentially in many instances as a gallery itself.

A gallery is defined as " a. A building, an institution, or a room for the exhibition of artistic work. B. An establishment that displays and sells works of art." <u>The American Heritage Dictionary of the English Language</u>

(4th ed. 2006).[4] Opposer displays art throughout its hotels and in some cases the paintings or sculpture are for sale. See, e.g., Flint Test. p. 34. The following testimony is representative of some of opposer's art-related activities.

> Q. And are there some restaurants – I think you mentioned one, but just so the record is clear, is the art displayed in some of those restaurants offered for sale as well?
> A. Yes. Specifically my hotel, Ritz-Carlton, Singapore, Marina del Ray, and Shanghai does it as well.
> Q. Okay. Does Ritz-Carlton itself sell any kind of art through its catalog or gift shops or website?
> A. Yeah. Through our retail catalogs. I mean, there's Luxury tier items that would be considered art.
> Q. Okay. Can you think of any examples of art that sold through the company?
> A. Faberge eggs, you know, those sort of things.
> Q. Okay.
> A. We've got glassware, bowls, music boxes, frames. I mean, all sorts of stuff.
> Q. And this would be in addition to the paintings you've described on the walls and that sort of thing?
> A. Correct.
> Q. Do you have any – can you give us any sense as to the price range that these various art items are sold for?
> A. Yeah. I mean, they range from a few dollars to thousands and thousands of dollars. I mean, I know that we have some sculptures that are in our gift shop and on display in our lobby that goes for thousands of dollars.
> Q. Okay. Do you sell –
> A. Thousands and thousands of dollars.
> Q. Okay. So I take it some of these works of art, the paintings, the sculptures, the other

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[4] The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

> things you described, are they originals as opposed to prints or copies?
> A. No, they're mostly original.
> Q. Okay. And again, why do you do this? Why do you offer art for sale in the hotels?
> A. Because I think it's part of who we are. I mean, again, I go about - I talk about expectations. When people walk into Ritz-Carlton, they expect, these days, to see artwork, to be able to purchase artwork.

Flint Test. pp. 34-36.

As opposer states "Ritz-Carlton need not operate a stand-alone art gallery in a 'gallery setting' that sells fine art exclusively in order to be deemed to be using its marks in connection with the advertising, promoting, and sale of art gallery services. In essence, RITZ-CARLTON hotels are art galleries. Fine art is sold at RITZ-CARLTON properties by Ritz-Carlton and others, including art featured on the hotel walls and in gift shops, and Ritz-Carlton uses the RITZ marks to promote the services Ritz-Carlton offers at those properties." Reply Br. pp. 12-13.

Contrary to applicant's contention, opposer's activities sufficiently connect its marks with the services of selling fine art in a gallery setting. Thus, under the circumstances of this case, we find that opposer's hotel services are sufficiently related to applicant's proposed gallery services such that use of a similar mark would likely cause confusion. While hotel services and gallery services are quite different, in this case, they have been shown to be, at a minimum, complementary. In addition,

opposer's other art-related services provided under its RITZ marks, including retail sales of fine art, art classes, hosting of art exhibitions and auctions are related to gallery services.

Considering the channels of trade and class of purchasers, there are no restrictions in opposer's registrations or the subject application, and the evidence of record shows that art galleries are found in hotels or they are located in close proximity to hotels, art galleries and hotels advertise in the same publications, and hotels offer packages that include access to art galleries. Thus, with regard to opposer's registrations we must presume that applicant's and opposer's services will be sold in the same channels of trade and will be bought by the same classes of purchasers. See Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994).

In addition, with regard to opposer's common law use, the record shows that opposer has art galleries in its hotels, operates in close proximity to galleries, offers packages that include access to galleries and advertises in the same magazines as galleries. In fact, applicant has admitted that:

> Art galleries sometimes market their goods and services by providing brochures and information to hotels or concierges employed by hotels;
>
> Hotels market their services by arranging packages for guests featuring art gallery tours or art exhibitions;
>
> Among the prospective purchasers of the services you intend to offer under the mark RITZ are hotel guests, including guests of RITZ-CARLTON hotels; and
>
> Guests staying at RITZ-CARLTON are typically more likely to purchase art than guests staying at less expensive hotels.

Exh. No. 17 Requests for Admission Nos. 11-14.

Therefore, the record also supports a finding, based on opposer's common law use, that the services travel in the same channels of trade and share the same class of customers.

In view of the above, the du Pont factors of the similarity of the services, the channels of trade and class of purchasers favor a finding of likelihood of confusion.

With regard to the conditions of sale, applicant argues that the parties' potential customers would be sophisticated and would exercise care in the purchasing decision. As noted above, applicant has not introduced evidence to support a finding that all "fine art" is expensive and purchased with care. There is testimony to the effect that the "art items" sold by opposer in its gift shops and through its catalogs range in price from a few dollars to thousands of dollars, including original works of art, for

example sculpture. Flint Test. pp. 334-36. However, applicant's identification is limited to only "original" and "limited edition" art which would indicate a more expensive category than "a few dollars." The purchase of such items would presumably be done with a higher degree of care than a print purchased in a gift shop. However, due to the fame of opposer's mark and its connection to fine art, including original works, through opposer's various hotel and retail services and hosting of galleries, exhibitions and art auctions, to the extent this factor favors applicant, it is not sufficient to outweigh the other factors.

Thus, considering the marks in their entireties, we conclude that the evidence of record as it pertains to the relevant du Pont factors supports a finding of a likelihood of confusion as between applicant's RITZ mark and opposer's RITZ marks, such that registration of applicant's mark is barred under Trademark Act Section 2(d). To the extent we have any doubt, we must resolve that doubt in favor of opposer, the prior user and registrant. See Hard Rock Cafe International (USA) Inc. v. Thomas D. Elsea, 56 USPQ2d 1504, 1514 (TTAB 2000) and W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc., 190 USPQ 308, 311 (TTAB 1976).

In view of our decision on likelihood of confusion we do not reach the claims brought under Sections 2(a) and 43(c).

**Decision:** The opposition is sustained as to opposer's claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act.