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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Grendel

Mailed: July 31, 2008

Opposition No. 91168312

Historic Hotels  
International, Inc.

v.

National Trust for  
Historic Preservation in  
the United States

Before Grendel, Rogers and Mermelstein, Administrative  
Trademark Judges.

Grendel, Administrative Trademark Judge:

This case now comes up on opposer's motion for summary  
judgment. For the reasons discussed below, we grant  
opposer's motion.

In application Serial No. 78454061, applicant seeks  
registration on the Principal Register of the mark HISTORIC  
HOTELS (in standard character form) for goods identified in  
the application as "printed publications, namely guidebooks,  
cookbooks and directories of historic hotels." The  
application was filed on July 21, 2004 and is based on use  
in commerce under Trademark Act Section 1(a), 15 U.S.C.  
§1051(a), with September 29, 1988 alleged to be the date of  
first use of the mark anywhere and August 1, 1989 alleged to

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be the date of first use of the mark in commerce. In the application, applicant claims ownership of prior Principal Register Reg. No. 1957141 of the mark HISTORIC HOTELS OF AMERICA (discussed below), and further claims, based on this prior registration, that the HISTORIC HOTELS mark it now seeks to register has acquired distinctiveness and therefore is registrable under Trademark Act Section 2(f), 15 U.S.C. §1052(f).

Opposer has opposed registration of applicant's mark on the grounds that the mark is merely descriptive of the goods and thus barred from registration under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), and that the mark has not acquired distinctiveness and therefore is not registrable under Trademark Act Section 2(f), 15 U.S.C. §1052(f).<sup>1</sup> In its answer to the notice of opposition, applicant has denied the salient allegations thereof.

Opposer now has moved for summary judgment on its claim that applicant's mark is merely descriptive and has not acquired distinctiveness and therefore is not registrable pursuant to Section 2(f). Opposer's motion is supported by the declaration of opposer's president Barry Preston and

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<sup>1</sup> Opposer also alleges as a ground of opposition that applicant has not used the involved mark HISTORIC HOTELS in commerce except as part of the mark HISTORIC HOTELS OF AMERICA, and that registration therefore is barred under Trademark Act Section 1(a). This ground of opposition is not at issue in connection with opposer's summary judgment motion.

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exhibits thereto, and by the declaration of opposer's counsel Gary Krugman and exhibits thereto.

Applicant filed a brief in response to opposer's motion for summary judgment, but submitted no affidavits, declarations or other evidence with its response brief.

Opposer filed a reply brief in support of its motion for summary judgment.

Summary judgment is a pretrial device to dispose of cases in which "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The purpose of the motion is judicial economy, that is, to avoid an unnecessary trial where there is no genuine issue of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case. *See, e.g., Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 221 USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

A factual dispute is genuine if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the nonmoving party. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847,

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23 USPQ2d 1471 (Fed. Cir. 1992); *Sweats Fashions Inc. v. Pannill Knitting Co., Inc.*, 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence of record must be viewed in a light most favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). All doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The party seeking summary judgment has the initial burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). In cases (such as this one) where the ultimate burden of persuasion on an essential element of the nonmovant's case is on the nonmovant, the moving party may establish its entitlement to summary judgment by establishing that there is no evidence on the basis of which the Board could rationally find for the nonmovant on that essential element of the nonmovant's case at trial. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). If the moving party meets this initial burden, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by

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affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. Fed. R. Civ. P. 56(e). See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Initially, we reject applicant's contention that we should deny opposer's summary judgment motion merely because discovery in this case allegedly has not been completed. If applicant required further discovery in order to adequately respond to opposer's summary judgment motion, applicant should have filed a properly-supported motion seeking such discovery pursuant to Fed. R. Civ. P. 56(f). See TBMP §528.06. Applicant did not do so.

We also reject applicant's contention that summary judgment on the issue of acquired distinctiveness is inappropriate merely because it is a question of fact. Applicant cites no authority for this proposition. Acquired distinctiveness is a question of fact,<sup>2</sup> but that does not preclude entry of summary judgment if it is shown that, on this summary judgment record, there is no genuine dispute as to that fact.

The issue before us is whether applicant's mark HISTORIC HOTELS, as applied to the "printed publications,

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<sup>2</sup> See *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001).

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namely guidebooks, cookbooks and directories of historic hotels" identified in applicant's application, has acquired distinctiveness and thus is registrable on the Principal Register under Trademark Act Section 2(f).

We first note that, by seeking registration under Section 2(f), applicant has conceded that its mark is merely descriptive. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). In addition to applicant's concession, we find in any event that HISTORIC HOTELS merely describes the subject matter of applicant's printed publications, and that it therefore is merely descriptive under Trademark Act Section 2(e)(1). *See, e.g., In re Cox Enterprises Inc.*, 82 USPQ2d 1040 (TTAB 2007) (THEATL merely descriptive of printed matter of interest to residents of and tourists and visitors to Atlanta, Georgia); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213 (TTAB 2000) (PSYCHOLOGY PRESS merely descriptive of books in the field of psychology); *In re Gracious Lady Service, Inc.*, 175 USPQ 380 (TTAB 1972) (CREDIT CARD MARKETING merely descriptive of publications in the field of credit card marketing). Thus, the issue before us is not whether applicant's mark is inherently distinctive (it is not), but whether the mark has acquired distinctiveness and thus is registrable under Section 2(f). We turn now to that issue.

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Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), provides that in determining whether a mark is registrable on the Principal Register pursuant to the acquired distinctiveness provisions of Trademark Act Section 2(f), the applicant's ownership of a prior Principal Register registration "of the same mark" may be accepted as "prima facie evidence of distinctiveness." In its application and in this opposition proceeding, applicant has based its Section 2(f) claim of acquired distinctiveness solely on its ownership of Registration No. 1957141.<sup>3</sup> That registration, which itself was issued pursuant to the acquired distinctiveness provisions of Section 2(f), is of the mark depicted below



for goods and services identified in the registration as:

printed publications, namely guidebooks, cookbooks  
and directories of historic hotels, in Class 16;

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<sup>3</sup> Reg. No. 1957141 was registered on February 20, 1996. Applicant's affidavits under Sections 8 and 15 were accepted and acknowledged, and the registration has been renewed.

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promoting the services of the historic hotel industry through the distribution of printed promotional materials; and procurement, namely purchasing hotel supplies for others, in Class 35;

development and dissemination of educational materials in the field of historic hotels, in Class 41; and

making hotel reservations for others, in Class 42.

Initially, we note that applicant did not make this registration of record by submitting it with its response to opposer's summary judgment motion.<sup>4</sup> For that reason alone, and because applicant has presented no other evidence in opposition to opposer's motion for summary judgment, we could find that applicant has failed to show that there is any genuine issue of material fact sufficient to defeat opposer's summary judgment motion. However, in its summary judgment briefs, opposer has treated the registration as being of record and as being owned by applicant. We shall do likewise, and shall assume that applicant would be able to establish at trial that this registration is in effect and is owned by applicant.

Applicant argues that, pursuant to Trademark Rule 2.41(b), its ownership of Reg. No. 1957141 constitutes prima facie evidence that the mark it now seeks to register has acquired distinctiveness. Opposer disputes this, arguing

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<sup>4</sup> We are able to consider the particulars of the registration only because we ourselves have reviewed the registration as it appears in the Office's electronic database.

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that the registered special form mark with the wording HISTORIC HOTELS OF AMERICA is not "the same mark" as the standard character HISTORIC HOTELS mark applicant now seeks to register, and that Trademark Rule 2.41(b) therefore is unavailable to applicant for purposes of establishing acquired distinctiveness.

We agree with opposer. The Federal Circuit has stated:

A proposed mark is the "same mark" as previously-registered marks for the purpose of Trademark Rule 2.41(b) if it is the "legal equivalent" of such marks. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. Whether marks are legal equivalents is a question of law subject to our de novo review. No evidence need be entertained other than the visual or aural appearance of the marks themselves. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991).

*In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

We find as a matter of law that, on their face, the registered mark HISTORIC HOTELS OF AMERICA (and design) and the applied-for mark HISTORIC HOTELS are materially different and not "the same mark," as required by Trademark Rule 2.41(b). Applicant's ownership of the prior registration therefore does not constitute prima facie

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evidence that applicant's involved mark HISTORIC HOTELS has acquired distinctiveness, under Trademark Rule 2.41(b).

Applicant bears the ultimate burden of proof at trial on its claim of acquired distinctiveness. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., supra.* Because we have found that applicant may not rely on its prior registration as evidence of acquired distinctiveness under Trademark Rule 2.41(b), and because applicant on summary judgment has not presented or even identified any other evidence which it might present at trial to carry its burden of proving acquired distinctiveness, we find that opposer is entitled to summary judgment on its pleaded claim that applicant's mark lacks acquired distinctiveness. *See Celotex Corp. v. Catrett, supra.*

In the alternative, even if we were to find as a matter of law that applicant's prior registered HISTORIC HOTELS OF AMERICA mark and the HISTORIC HOTELS mark it now seeks to register are "the same mark" and that applicant's ownership of the prior registration therefore constitutes prima facie evidence of acquired distinctiveness under Trademark Rule 2.41(b), we find that the evidence opposer has submitted on summary judgment is more than sufficient to rebut any such prima facie showing of acquired distinctiveness. Opposer's summary judgment evidence establishes beyond dispute that HISTORIC HOTELS is a highly descriptive designation as

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applied to applicant's goods, and indeed that it is so highly descriptive that applicant's mere ownership of its prior registration does not suffice to establish that the mark has acquired distinctiveness.

Before we consider opposer's summary judgment evidence, we find that the highly descriptive nature of HISTORIC HOTELS is evidenced by the fact that applicant itself uses "historic hotels" in a highly descriptive manner in its identification of goods in the present application, i.e., "printed publications, namely guidebooks, cookbooks and directories of **historic hotels**." (Emphasis added.)

Applicant likewise repeatedly uses "historic hotels" in a highly descriptive manner in the identification of goods and services in applicant's prior registration, i.e., "printed publications, namely guidebooks, cookbooks and directories of **historic hotels**," in Class 16, "promoting the services of the **historic hotel** industry through the distribution of printed promotional materials; and procurement, namely purchasing hotel supplies for others," in Class 35, and "development and dissemination of educational materials in the field of **historic hotels**," in Class 41. (Emphasis added.)

Opposer's summary judgment evidence includes excerpts of articles obtained from the NEXIS database, which further establish beyond dispute that HISTORIC HOTELS is highly

descriptive of applicant's printed publications." For example (emphasis added):

The West slept here ... Five **historic hotels**, from Los Angeles to Seattle, were built to lure and fete the powerful. Today, they continue to dazzle."

(Sunset, Nov. 1995.) (Krugman Exh. 47.)

A comeback for San Francisco's small, **historic hotels**. ... These 14 small, **historic hotels** aren't for everyone.

(Sunset, April 1986.) (Krugman Exh. 48.)

The Gold Country's **historic hotels**: a guide to 11 of the most enduring places to rest your head in California's Mother Lode.

(Sunset, April 1997.) (Krugman Exh. 49.)

Renovating **Historic Hotels**. ... Raffles International has always taken very seriously the restoration of our **historic hotels**.

(International Herald Tribune, October 26, 2001.) (Krugman Exh. 112.)

After years located on the ground floor of La Posada de Albuquerque, Jane Butel's Southwestern Cooking School is going dark. The cooking school is closing after December due to the renovation of the 1939 **historic hotel**.

(Albuquerque Journal, Nov. 25, 2005.) (Krugman Exh. 79.)

Not just a cookbook, "The Driskill Hotel: Stories of Austin's Legendary Hotel/A Cookbook for Special Occasions" relates the history of the **historic hotel**, from its beginnings in 1886 to its current upscale form.

(Austin American-Statesman (Texas), Feb. 23, 2006.) (Krugman Exh. 80.)

The shutoff is the city's latest attempt in a long-running battle to redevelop the **historic hotel** at Sixth and Hamilton streets.

(The Morning Call (Allentown, PA), Aug. 31, 2007.) (Krugman Exh. 84.)

The century-old Hotel Conneaut is celebrating its grand reopening, Conneaut Lake Park and American Resort Management LLC said Thursday. ... American Resort Management, of Erie, which operates hotels, water parks, resorts and restaurants, recently was chosen to operate the **historic hotel**.

(Pittsburgh Tribune Review, Aug. 31, 2007.)  
(Krugman Exh. 85.)

(Outside, the charisma of the **historic hotel** is still visible. But inside, much of the historic charm is covered with plaster, vinyl and neglect. (St. Petersburg Times (Florida), Aug. 30, 2007.)  
(Krugman Exh. 87.)

**Historic hotel** changes hands - One of Lewistown's most historic structures, the Calvert Hotel, was sold at an auction to a Stevensville couple for \$280,000.

(Great Falls Tribune (Montana), Aug. 28, 2007.)  
(Krugman Exh. 89.)

Forests obscure interconnecting roads that lead to the amenities in cities, towns and villages that are never more than 30 miles away. Part of the peninsula's wilderness charm is the accessibility of **historic hotels**, bed-and-breakfast inns, motels, restaurants, shops and attractions. (Chicago Tribune, Aug. 26, 2007.) (Krugman Exh. 91.)

("There are no televisions, mini refrigerators or coffee makers in the rooms so it forces you to get out and explore," she said. "It's a **historic hotel** located in what many people call the 'Switzerland of North America.'"

(Great Falls Tribune (Montana), Aug. 26, 2007.)  
(Krugman Exh. 92.)

(The Manning Hotel, a **historic hotel** in downtown Kewauqua, shows the high-water mark on July 13, 1993, as well as other high levels going back to 1903 on its brick exterior.

(Des Moines Register, Aug. 25, 2007.) (Krugman Exh. 95.)

Built in 1926, the **historic hotel** in recent decades has been used mainly as a layover destination for United Airlines employees. City

leaders have said they're excited to see it re-open as a hotel for tourists, business travelers and families of residents.

(Inside Bay Area (California), Aug. 24, 2007.)  
(Krugman Exh. 96.)

Historic Landmarks of Indiana provides guided tours at the two **historic hotels** four times a day. (The Miami Herald, Aug. 19, 2007.) (Krugman Exh. 99.)

We find that this evidence, if unopposed, would suffice at trial to establish that HISTORIC HOTELS is not only merely descriptive, but indeed is highly descriptive of applicant's publications which pertain to historic hotels. Because applicant has submitted absolutely no evidence in response to opposer's motion for summary judgment, it has failed to demonstrate that a genuine issue for trial exists as to the highly descriptive nature of its mark, and has failed to show that trial of the issue would result in a different record than that now before the Board.

We further find that opposer's unchallenged evidence of the highly descriptive nature of applicant's mark is sufficient to rebut the prima facie presumption of acquired distinctiveness which arises merely from applicant's ownership of its prior registration. It is settled that the greater the degree of a mark's descriptiveness, the greater the burden the applicant faces in establishing acquired distinctiveness. *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., supra.* Faced with opposer's summary judgment

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evidence showing that the mark is highly descriptive, it was incumbent upon applicant to come forward with countering evidence showing that there is a genuine issue for trial as to whether its mark has acquired distinctiveness notwithstanding the highly descriptive nature of the mark. Applicant failed to present any such other evidence, choosing instead to rely merely on its ownership of its prior registration.

In claiming that its mark is registrable under Trademark Act Section 2(f), applicant has the ultimate burden of proving by a preponderance of the evidence that its mark has acquired distinctiveness. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., supra*. On summary judgment, opposer has the initial burden of establishing that there is no genuine factual dispute that applicant's mark has not acquired distinctiveness. Opposer may meet this burden by establishing that there is no evidence upon which the Board at trial could rationally base a finding that the mark has acquired distinctiveness. *Celotex Corp. v. Catrett, supra*. If opposer carries that burden, then applicant may defeat opposer's summary judgment motion only by showing that in fact there is evidence which applicant could present at trial upon which the Board might rationally base a finding that the mark has acquired distinctiveness. For the reasons discussed above, we find that opposer has met its initial

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burden of showing that there is an absence of evidence sufficient to support applicant's claim of acquired distinctiveness. We further find that applicant has failed to counter opposer's showing with a showing of its own that there is evidence applicant could produce at trial upon which a reasonable factfinder might base a finding that the mark has acquired distinctiveness.

In summary, we find that there is no genuine issue of material fact for trial, and that opposer is entitled to judgment as a matter of law on its claim that applicant's merely descriptive mark has not acquired distinctiveness and thus is not entitled to registration pursuant to Trademark Act Section 2(f).

We also find that there is no genuine issue of material fact as to opposer's standing to oppose registration of applicant's mark. In his summary judgment declaration, opposer's president Barry Preston avers that opposer "uses the term 'Historic Hotels' as part of its domain name 'historichotels.com.' Opposer, on its travel related web site, descriptively refers to the terms 'Historic Hotels,' 'Hotels,' and 'Historic.'" (Preston Decl. at ¶2.) Mr. Preston also averred that opposer "has a continuing interest in developing, among other things, web based guides and directories of historic hotels and, therefore, Opposer has a continuing interest in using the descriptive term 'historic

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hotels' in connection with its travel related web-based business to refer to guides to and directories of historic hotels, namely, hotels having historical significance."

(Preston Dec. at ¶5.) We find that these undisputed averments suffice to establish opposer's standing in this case. Applicant does not contend otherwise.

Because opposer has established that there is no genuine issue of material fact as to its standing or as to its claim that applicant's merely descriptive mark has not acquired distinctiveness, and because we find that opposer is entitled to judgment as a matter of law in this opposition, we grant opposer's motion for summary judgment. Fed. R. Civ. P. 56(c).

Decision: The opposition is sustained.