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

GCP

Mailed: April 12, 2012

Opposition No. 91191947

HLT Domestic IP LLC

v.

Eric Marcus

Before Seeherman, Ritchie, and Wolfson, Administrative Trademark Judges.

By the Board:

Eric Marcus ("applicant") seeks to register the mark WOOFDORF-ASTORIA DOG HOTEL & DAY SPA in standard characters for "kennel services, namely, boarding for pets" in International Class 43.[1]

HLT Domestic IP LLC ("opposer") has filed a notice of opposition to registration of applicant's mark on the grounds of likelihood of confusion and dilution by blurring. In support of its asserted claims, opposer has pleaded that it has common law rights in the mark WALDORF-ASTORIA, previously used on or in connection with hotel services and related

[1] Application Serial No. 77633434, filed on December 15, 2008, based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), claiming September 20, 2006 as both the date of first use and the date of first use in commerce. Applicant has provided a disclaimer of the wording "DOG HOTEL & DAY SPA."

goods, as well as ownership of the following registered marks: (1) WALDORF-ASTORIA in standard characters for "hotel services" in International Class 42;[2] (2) WALDORF=ASTORIA COLLECTION in standard characters for "hotel services; restaurants and catering services; provision of facilities for meetings, conferences and exhibitions" in International Class 43;[3] and (3) WALDORF=ASTORIA COLLECTION and design for "hotel services; restaurants and catering services; provision of facilities for meetings, conferences and exhibitions" in International Class 43.[4]

Applicant, in his answer, has denied the salient allegations of the notice of opposition.

This case now comes before the Board for consideration of (1) applicant's motion for summary judgment on opposer's asserted ground of likelihood of confusion[5] and (2) opposer's motion for summary judgment on its asserted claim of dilution by blurring. The motions are fully briefed.

Summary judgment is an appropriate method of disposing of cases that present no genuine disputes of material fact,

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[2] Registration No. 1065983, issued on May 17, 1977. Combined Section 8/Section 9 accepted/granted; renewed.
[3] Registration No. 3165117, issued on October 31, 2006.
[4] Registration No. 3267555, issued on July 24, 2007.
[5] Although the opening paragraph of applicant's motion seeks entry of summary judgment dismissing the opposition in its entirety, we note that applicant only argues the merits of opposer's pleaded likelihood of confusion claim and concludes his motion by stating that confusion is not likely. Accordingly, we construe applicant's motion as only concerning opposer's pleaded claim of likelihood of confusion.

thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Lloyd's Food Products, Inc. v. Eli's, Inc*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Here, applicant has the burden of demonstrating the absence of any genuine dispute of material fact, and that he is entitled to judgment as a matter of law, with respect to opposer's claim of likelihood of confusion, and opposer has the corresponding burden with respect to its dilution claim. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

We first turn to applicant's motion for summary judgment regarding opposer's asserted ground of likelihood of confusion. In support of his motion, applicant essentially argues that since his involved mark constitutes an effective parody of opposer's pleaded marks, there can be no likelihood of confusion.

In response, opposer maintains that applicant's motion should be summarily dismissed inasmuch as it is not supported by any evidence nor does the motion provide any

analysis of the likelihood of confusion factors under *In re E.I. du Pont Nemours & Co.*, 476 F.2d 1357 (CCPA 1973) and, therefore, applicant has failed to discharge his burden of establishing that no genuine dispute of material fact remains and that he is entitled to judgment as a matter of law. Opposer further argues that parody is not a defense to a claim of likelihood of confusion and that, in any event, genuine disputes of material fact exist, at a minimum, as to the relatedness of the parties' respective services.[6] In particular, opposer maintains that it offers a wide variety of pet-related goods and services that are identical to or overlap with applicant's services, including, among others, (1) permitting and encouraging hotel guests to bring their pets with them during their stay, (2) dog walking, grooming, shopping, spa and feeding services, and (3) providing dog beds, collars, leashes and pet bowls. In support thereof, opposer has submitted the declaration of Barbara Arnold, opposer's Director of Intellectual Property, who, by her declaration, attests to the types of pet services provided by opposer at its hotels and resorts.

Parody is not, *per se*, a "defense" to a claim of likelihood of confusion; rather, "it is merely a way of

[6] We note that opposer also argues that applicant's motion for summary judgment should be denied with regard to opposer's pleaded claim of dilution. However, as previously noted, we have construed applicant's motion to only concern opposer's pleaded claim of likelihood of confusion.

phrasing the traditional response that customers are not likely to be confused as to source, sponsorship or approval." *Schieffein & Co. v. Jack Co. of Boca*, 725 F. Supp. 1314, 1323 (S.D.N.Y. 1989) (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 31:156 (4th ed. database updated 2012)). Thus, parody is simply another factor which is relevant to the analysis of likelihood of confusion because parody is merely another way of arguing that confusion is not likely. *Nike, Inc. v. Just Did It Enterprises*, 6 F.3d 1125, 28 USPQ2d 1942 (7th Cir. 1993); *Utah Lighthouse Ministry v. Found. For Apologetic Info. and Research*, 527 F.3d 1045, 86 USPQ2d 1865 (10th Cir. 1988). In other words, even if the defendant's mark has a parody aspect, that is not necessarily sufficient to prevent likelihood of confusion. *See Elvis Presley Enterprises Inc. v. Capece*, 141 F.3d 188, 46 USPQ2d 1737, 1744 (5th Cir. 1998); *Dr. Suess Enterprises L.P. v. Penguin Books USA*, 109 F.3d 1394, 42 USPQ2d 1184, 1193 (9th Cir. 1977).

In view of the fact that parody does not, as a matter of law, avoid a likelihood of confusion[7] and because this is the sole basis for applicant's motion, applicant having failed to address any of the *du Pont* likelihood of confusion factors or submit any evidence in support of his motion for

[7] As noted *infra*, there is also a genuine issue as to whether applicant's mark would be perceived as a parody.

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