

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

JAN. 11, 98

Hearing:  
April 15, 1998

Paper No. 15  
PTH

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Riviera Operating Corporation

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Serial No. 74/646,349

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Glenn A. Gundersen of Dechert, Price & Rhoads for Riviera Operating Corporation.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105 (Thomas Howell, Managing Attorney).

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Before Hanak, Quinn and Hairston, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Riviera Operating Corporation to register the mark RIVIERA for services which were subsequently identified as "hotels; providing banquet, convention, business meeting, and social function facilities for special occasions."<sup>1</sup>

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<sup>1</sup> Application Serial No. 74/646,349, filed March 13, 1995; alleging dates of first use of April 20, 1955.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark set forth below for "restaurant services"<sup>2</sup> as to be likely to cause confusion.



When the refusal was made final, applicant appealed. Briefs have been filed and an oral hearing was held before the Board.

As a preliminary matter, we note that applicant maintains that the final refusal to register was premature. In particular, applicant states that its original recitation of services included restaurant services as well as hotel services. In the first Office action, the Examining Attorney refused registration under Section 2(d), citing the above registered mark, and stating that "the services of the parties are related, because they are both

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<sup>2</sup> Registration No. 1,051,534 issued October 26, 1976; renewed. The word "CAFE" has been disclaimed apart from the mark as shown.

restaurant services." There was no mention made of any relationship between applicant's hotel services and registrant's restaurant services. In response to the refusal, applicant deleted "restaurant services" from the recitation of services. According to applicant, it assumed that the Examining Attorney would then withdraw the refusal to register. Instead, in the second Office action, the Examining Attorney again refused registration under Section 2(d) in view of the above registered mark, and stated that "the services of the parties are related, because restaurants may be located in hotels." The refusal to register was made final. It is applicant's position that the final refusal was premature because the Examining Attorney made no mention, in the first Office action, of a likelihood of confusion between the marks as used in connection with hotel services and restaurant services. However, inasmuch as the ground for refusal was the same in the first and final Office actions, i.e., Section 2(d), we cannot say that the refusal was premature. Moreover, applicant was not precluded from arguing against the Examining Attorney's position because applicant did file a request for reconsideration (which the Examining Attorney considered) wherein it set forth its arguments.

Turning then to the refusal, it is essentially the Examining Attorney's position that there is a likelihood of confusion because the respective marks are very similar and the services are related. In support of the refusal, the Examining Attorney made of record a number of third-party registrations for marks which cover both hotel and restaurant services. Also, the Examining Attorney made of record excerpts from the NEXIS data base, which he maintains show that hotel and restaurant services are related.

Applicant, in urging reversal of the refusal to register, argues that there is no per se rule that the use of identical or substantially similar marks in connection with hotel services and restaurant services is likely to cause confusion. Applicant points to three examples where identical or substantially similar marks have been registered by different entities for hotel services on the one hand and restaurant services, on the other.<sup>3</sup> Also, applicant argues that there is no likelihood of confusion

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<sup>3</sup> They are: (1) Registration No. 1,635,788 for the mark FOUR SEASONS HOTELS-RESORTS and design for hotel and resort innkeeping services and Registration No. 936,802 for the mark THE FOUR SEASONS for restaurant services; (2) Registration No. 1,535,837 for the mark THE PEABODY and design for hotel services and Registration No. 2,039,810 for PEABODY'S COFFEE CO. and design for restaurant services specializing in coffees, teas and other beverages; and (3) Registration No. 2,054,525 for the mark MIRAGE

in this case because its mark and the cited mark have coexisted for 27 years with no instances of actual confusion.

Turning first to the marks, while they are similar, we note that they are not identical. Although the word CAFE in the registered mark has been disclaimed, it cannot be ignored. Further, we note that RIVIERA and RIVIERA CAFE are suggestive as used in connection with the parties' respective services. We judicially notice that "riviera" is defined in Webster's New Collegiate Dictionary (1979) as: "a coastal region frequented as a resort and usu. marked by a mild climate."

Turning to the services, admittedly they are related, but they are not the same. While we recognize that entities have registered a single mark for hotel and restaurant services, there have been at least three instances where identical or substantially similar marks have been registered for hotel services, on the one hand, and restaurant services, on the other. Further, it is common knowledge that hotel restaurants generally do not bear the name of the hotel itself. We note in this regard the specimen brochure submitted by applicant which shows

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for resort and hotel services and Registration No. 1,352,229 for the mark MIRAGE for restaurant and bar services.

that applicant's hotel features four restaurants, namely Risorante Italiano, Rik' Shaw, Kristofer's, and Kady's. Also, although not unprecedented, it is not a common practice for restaurants to expand into the hotel business.

Finally, we cannot overlook the fact that these marks have coexisted for over twenty-seven years with no apparent instances of confusion. Although there is no consent to register here, this case shares some similarities with *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993). The Court there, in finding that the applicant's use of FOUR SEASONS BILTMORE for an oceanfront resort was not likely to cause confusion with the registered mark THE BILTMORE LOS ANGELES for a city hotel, noted that while the services performed by the parties were similar, they were not identical, and acknowledged that the marks at issue had coexisted for some time.

Thus, notwithstanding any relatedness in the services herein, we find that applicant's use of the mark RIVIERA in connection with hotels; providing banquet, convention, business meeting, and social function facilities for special occasions, is not likely to cause confusion with the registered mark RIVIERA CAFÉ and design for restaurant services.

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**Decision:** The refusal to register is reversed.

E. W. Hanak

T. J. Quinn

P. T. Hairston  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board