

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 8/25/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

CSX IP, Inc. and CSX Hotels, Inc.
v.
Greenbriar Corporation

Opposition No. 109,424
to application Serial No. 75/140,107
filed on July 24, 1996

Richard L. Kirkpatrick and Laura C. Gustafson of Pillsbury
Madison & Sutro LLP for CSX IP, Inc. and CSX Hotels, Inc.

Gregory M. Howison of Thompson & Howison LLP for Greenbriar
Corporation.

Before Seeherman, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Greenbriar Corporation has filed an application to
register the mark depicted below

for services which were subsequently described as "assisted living centers, namely, residential care facilities providing personal assistance with the activities of daily living including special health care services in the nature of dementia care."¹

Registration has been opposed by CSX IP, Inc. and CSX Hotels, Inc. 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 opposers' previously used and registered marks set forth below, as to be likely to cause confusion:

- (a) THE GREENBRIER for resort hotel and restaurant services;²
- (b) GREENBRIER in the stylized form below

for resort hotel services;³

- (c) "G" in the stylized form below

¹ Serial No. 75/140,107 filed July 24, 1996, alleging dates of first use of February 1996. The words "Corporation" and "The Assisted Living Company" have been disclaimed apart from the mark as shown.

² Registration No. 1,776,855 issued June 15, 1993; Sections 8 & 15 affidavit accepted.

³ Registration No. 1,482,046 issued March 22, 1988; Sections 8 & 15 affidavit accepted.

for resort hotel services;⁴

- (d) THE GREENBRIER for diagnostic health care services;⁵ and
- (e) THE GREENBRIER for conducting exercise classes and providing exercise facilities, and health spa and mineral bath services.⁶

Applicant, in its answer, denied the salient allegations of the opposition. The case has been fully briefed, but no oral hearing was requested.

We must first address an evidentiary matter. Applicant submitted, under notice of reliance, Internet website printouts of companies purportedly using "Greenbrier" or "Greenbriar" and printouts of various domain name registrations consisting of "Greenbrier" or "Greenbriar" obtained from the Internet website of Network Solutions, Inc., a domain name registry. Accompanying these materials are the affidavits of Eric Jorgensen, an employee of applicant's law firm, who retrieved the information. Applicant contends that these materials indicate that GREENBRIER is a weak mark and entitled to a narrow scope of protection. Opposers, in their brief on the case, have objected to the materials on the ground that they are not

⁴ Registration No. 1,482,047 issued March 22, 1988; Sections 8 & 15 affidavit accepted.

⁵ Registration No. 1,619,169 issued October 23, 1990; Sections 8 & 15 affidavit accepted.

⁶ Registration No. 1,634,426 issued February 5, 1991; Sections 8 & 15 affidavit accepted.

printed publications, and thus, not properly submitted by way of notice of reliance.⁷ It is well settled that Internet website printouts are not admissible under Trademark Rule 2.122(e) because they are not self-authenticating as contemplated by the rule and they are not generally considered printed publications. See *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). Similarly, the printouts of domain names is inadmissible under Trademark Rule 2.122(e). In view thereof, opposers' objection to these materials is well taken, and we have not considered them in reaching our decision. We should point out that, in any event, the Internet website printouts would not have been particularly probative because the vast majority cover goods and/or services unrelated to those involved herein and they are not evidence that the purported marks are in use. In addition, the printouts of domain names would not have been particularly probative inasmuch as we do not know if such names are being used as trademarks, the extent of any such use, and the goods or services in connection with which the domain names are used. In short,

⁷ We note applicant's contention that opposers' objection is untimely. Section 718.02(c) of the Trademark Trial and Appeal Board Manual of Procedure states that an objection to a notice of reliance on substantive grounds normally should be raised in the objecting party's brief on the case, unless the ground for objection is one which could be cured promptly by motion to strike. In this case, opposers' objection could not have been cured promptly because it would have required the taking of a testimony deposition to make these materials of record. In view

Opposition No. 109,424

even if these materials were admissible, their probative value would be minimal, at best.

Thus, the record consists of the pleadings; the file of the opposed application; and the trial testimony, with related exhibits, of opposers' witnesses James A. Searle, Jr. and Madalyn D. Rofer-Choate. In addition, opposers submitted under notice of reliance, copies of the pleaded registrations as well as other registrations owned by them; copies of third-party registrations; a copy of applicant's trademark search report;⁸ excerpts from printed publications; applicant's responses to certain of opposers' requests for admissions and interrogatories; and portions of discovery deposition testimony. Opposers also submitted, pursuant to a stipulation, excerpts from the website of Marriott International, Inc., copies of registrations owned by Marriott and copies of that company's 1997 and 1998 annual reports. Applicant submitted, under notice of reliance, opposers' responses to certain of applicant's interrogatories; portions of discovery deposition testimony, and excerpts from a printed publication.

The record shows that CSX IP, Inc. and CSX Hotels, Inc., are related companies, with CSX IP, Inc. being the owner of the

thereof, applicant's contention that opposers' objection to the materials is untimely is not well taken.

⁸ A trademark search report is generally not admissible by notice of reliance. However, we have considered the search report in

Opposition No. 109,424

above pleaded registrations. According to the testimony, THE GREENBRIER was first used for resort hotel services in 1913. THE GREENBRIER resort hotel is located on 6500 acres in White Sulphur Springs, West Virginia and features not only the hotel, but The Greenbrier Clinic, spas and mineral baths, and a private residential development known as The Greenbrier Village. THE GREENBRIER resort hotel offers guests numerous activities, including golf, tennis, swimming, exercise facilities and other entertainment and outdoor activities. It also provides on-site dining and a variety of accommodations including guest rooms, suites, guest houses and estate houses.

Every year for the past thirty years approximately 90,000 guests have visited THE GREENBRIER. The resort hotel has received every conceivable award in the resort hotel industry. At the time of trial (1997), THE GREENBRIER had won the Five Star rating from the Mobil Travel Guide every year for thirty-eight years and the Five Diamond rating from the American Automobile Association every year for twenty years.

In 1990, THE GREENBRIER was designated a National Historic Landmark, in recognition of its being one of the most historic places in the United States. We note, in this regard, that during World War II the resort served first as

this case because applicant did not object thereto, but rather

Opposition No. 109,424

the home of a number of foreign diplomats and later it was transformed into an Army hospital. During the Cold War, a secret bunker was constructed at the site which was designed to house members of Congress in the case of a nuclear attack.

THE GREENBRIER resort has been associated with health and wellness from its inception, when people came to White Sulphur Springs to bathe in and drink the mineral water. The Greenbrier Clinic, which began operations in 1948, is located on THE GREENBRIER property and offers preventative healthcare and medical services. The clinic has served over 70,000 individuals since 1948 and currently serves approximately 5,000 individuals each year. The clinic has eight internists, two radiologists and a staff of seventy. It conducts diagnostic exams and tests, including an assessment of an individual's general health status, evaluation of current symptoms and guidelines for healthier living. The clinic also assists individuals in developing preventative health programs, including providing nutritional counseling and assisting the individual in developing a personally tailored exercise program. A significant portion of clinic patients are older, and are evaluated for osteoporosis, Alzheimer's and other age-related illnesses.

treated it as of record.

Opposition No. 109,424

The Greenbrier Village is a private residential community located on THE GREENBRIER property. Most of the residents are former guests of THE GREENBRIER or knew of its reputation. The community opened in 1975 and consists of 38 townhouse units and 27 single-family lots, some of which have individual homes located thereon.

Opposer CSX Hotels, Inc. advertises the services bearing THE GREENBRIER mark through its website; The Greenbrier Magazine; brochures; national publications; including Town & Country, Conde Naste Traveler, Golf World, Food & Wine, and Bon Appetit; newspapers, including The Wall Street Journal; and travel directories. Opposers' resort hotel has been the subject of extensive press coverage, including nationally televised programming in the United States and abroad. In 1994 NBC's "Dateline" broadcast a story on the Cold War bunker facilities located at THE GREENBRIER. In addition, several major sporting events at THE GREENBRIER have been nationally televised.

Opposers primarily use THE GREENBRIER mark in a script form with a prominent "G." The mark is also used with a floral design as depicted below:

Opposers presently license the use of THE GREENBRIER mark for a spa in Savannah, Georgia and a resort in Japan. In addition, opposers sell a wide variety of collateral merchandise, including wine, golf clubs, mineral water, and clothing under THE GREENBRIER mark.

Opposer's sales and advertising figures have been made of record under seal. A review of the documents relative thereto shows large numbers in both categories.

Customers of opposers' services come from throughout the United States and abroad. Sixty percent of the guest population belong to group, corporation or association events. A significant portion of the guest population is in the older age category and many are families.

Applicant Greenbriar Corporation is in the business of operating assisted living centers. These centers are designed for persons generally around 80 years old who are able to manage most of their daily activities, but occasionally need help with dressing, bathing, or medication reminders. Applicant has around fifty such centers and they are primarily located in towns with a population of 30,000 or less.

Applicant was previously known as Medical Resource Companies of America and changed its name to Greenbriar

Opposition No. 109,424

Corporation on March 26, 1996. James Gilley, applicant's president and chief executive officer, testified that the name was changed because it did not properly identify the direction in which the company was moving. According to the testimony of Mr. Gilley, a number of names were evaluated and he liked the name Greenbriar Corporation best. At the time of selecting the name, Mr. Gilley was well aware of THE GREENBRIER resort and its facilities. He testified that he and his family had been to THE GREENBRIER resort for thirty-two years in a row; it was a family tradition.

As indicated above, opposers made of record status and title copies of the pleaded registrations. Thus, there is no issue with respect to opposers' priority of their registered marks. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn our attention to the issue of likelihood of confusion.⁹ Our determination under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I.*

⁹ As indicated above, opposers pleaded ownership of a registration for the mark THE GREENBRIER for "conducting exercise classes and providing exercise facilities, and health spa and mineral bath services." In addition, opposers pleaded ownership of a registration for a mark consisting of a stylized letter "G" for "resort hotel services." Opposers did not focus on either of these registrations in their brief, and therefore, we have not considered the issue of likelihood of confusion with respect to either of these registrations.

Opposition No. 109,424

duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding are

Opposition No. 109,424

discussed below.

Turning first to a consideration of the parties' marks, we find that opposers' marks GREENBRIER, THE GREENBRIER, and THE GREENBRIER in stylized lettering and applicant's mark GREENBRIAR CORPORATION . . . THE ASSISTED LIVING COMPANY and design create similar commercial impressions.

In comparing the marks, we recognize that the descriptive (and disclaimed) words "CORPORATION" and "THE ASSISTED LIVING COMPANY" in applicant's mark cannot be ignored. See *Giant Food, Inc. v National Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1993). However, although we have resolved the issue of likelihood of confusion by a consideration of the marks in their entireties, there is nothing improper in giving more weight, for rational reasons, to a particular feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, we have given more weight to the GREENBRIAR portion of applicant's mark, which is substantially similar to opposers' GREENBRIER marks. This is so, not only because of the descriptive nature of the words "CORPORATION" and "THE ASSISTED LIVING COMPANY," but also because these words are depicted in much smaller size than the word GREENBRIER in applicant's mark. Further, it is often the first part of a mark which is most likely to be

Opposition No. 109,424

impressed upon the mind of a purchaser and remembered, and we are of the opinion that GREENBRIAR would be likely to be used to refer to applicant's services. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); and *Mine Safety Appliances Co. v. Management Science America, Inc.*, 212 USPQ 105, 108 (TTAB 1987). We note, in this regard, the following examples in applicant's specimen brochure wherein it uses simply "Greenbriar."

Greenbriar serves more than 1,200 senior residents in 17 residences in six states—California, Idaho . . .

A typical Greenbriar resident's profile . . .

Often, those with Alzheimer's who are in nursing homes or at home with 24-hour nursing care would be better served by living in a residential setting designed to meet their special needs—the care the Greenbriar residences provide.

The strength of opposers' GREENBRIER marks is a critical du Pont factor in opposers' favor in this case. Our principal reviewing court, the Court of Appeals for the Federal Circuit, recently reaffirmed the importance that fame plays in determining likelihood of confusion. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). ["When a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a 'long shadow which competitors must avoid.'"]. In this case, the record clearly establishes the fame of the GREENBRIER marks in the

Opposition No. 109,424

resort hotel field. Opposers' marks have been the subject of extensive exposure in the marketplace. The record shows impressive revenue figures and significant promotional expenditures.

The fame of opposers' marks is not diminished by the alleged evidence of third-party usage in applicant's search report. Federal and state registrations are not evidence of the use of the marks listed therein. Also, company listings taken from business directories, which are unlike advertisements, are not evidence of use. See *Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996). Moreover, we note that the vast majority of the registrations and company listings cover services which are different from the services involved herein.

Another factor that bears upon our determination is the circumstances surrounding the applicant's adoption of its mark. James Gilley, applicant's president and chief executive officer, testified that he was well aware of THE GREENBRIER resort at the time of adoption of applicant's mark. He and his family had visited the resort for over thirty years.

A party which knowingly adopts a mark similar to one used by another for similar goods or services does so at its peril. In such cases, all doubt on the issue of likelihood of confusion must be resolved against the newcomer. Nina

Opposition No. 109,424

Ricci S.A.R.I. v. E.T.F. Enterprises Inc., 889 F2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); Kimberly Clark Corp. v. H. Douglas Enterprises, Ltd., 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985); and Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768 (TTAB 1992). Although Mr. Gilley testified that he did not necessarily think of the GREENBRIER marks when he selected GREENBRIAR CORPOPRATION . . . THE ASSISTED LIVING COMPANY and design as applicant's mark, we agree with opposer that applicant's choice of a very similar script for the letter "G" in the GREENBRIAR portion of its mark, as well as its use of a similar flower design, sheds some light on applicant's intentions.¹⁰ See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) ["there is . . . no excuse for even approaching the well-known trademark of a competitor, but to do so raises 'but one inference--that of gaining advantage from the wide reputation established by [the prior user] in the services bearing the mark' . . ."]; and Kenner Parker Toys Inc., supra at 1458. We have reproduced below opposers' stylized mark and applicant's mark and the respective flower designs:

¹⁰ We note that applicant did not adopt a design which resembles a greenbrier flower. According to applicant's witness, the greenbrier flower is not particularly attractive.

Opposition No. 109,424

Opposers' stylized
mark

Applicant's mark

Opposers' flower
design

Applicant's flower
design

With the foregoing in mind, we turn to a consideration of the parties' services. Applicant maintains that its assisted living centers are specifically different from opposers' resort hotel services.

However, in order to support a finding of likelihood of confusion it is not necessary for the goods or services of the parties to be similar or competitive, or even that they move in the same channels of trade. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would be encountered by the same persons under

Opposition No. 109,424

circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1987).

In this case, opposers have introduced stipulated evidence showing that two major hotel companies have expanded into offering living facilities for senior citizens. Newspaper articles, advertisements and annual filings before the Securities and Exchange Commission show that the Marriott Corporation offers both independent and assisted living facilities and the Hyatt Corporation offers independent living facilities. In their advertising, both companies tout their breadth of experience in the hotel market. Several of the newspaper articles mention that independent and assisted living facilities are a natural area of expansion for companies involved in lodging. Opposers have indicated that this is an area which they too are considering.

In addition, the record shows that since 1948 opposers have offered diagnostic health care services under THE GREENBRIER mark. Applicant offers health care services in the nature of dementia care under its mark. Also, opposers have expanded their services to include The Greenbrier Village residential community. Likewise, applicant's assisted living centers are residential communities.

Opposition No. 109,424

In view of the foregoing, we find that applicant's use of GREENBRIAR CORPORATION . . . THE ASSISTED LIVING COMPANY and design for assisted living centers, namely, residential care facilities providing personal assistance with the activities of daily living including special health care services in the nature of dementia care is likely to cause confusion with opposer's GREENBRIER marks for resort hotel services and diagnostic health care services. Consumers familiar with opposers' resort hotel services and/or diagnostic health care services offered under the GREENBRIER marks, upon encountering applicant's mark for an assisted living center, may well assume that opposers have expanded their business to offer these services.

We recognize that persons (or family members acting on their behalf) who are considering a move to an assisted living center will exercise care in the selection of such a center. Thus, the duPont factor of sophisticated/discriminating purchaser favors applicant. However, when all the relevant duPont factors are considered herein, particularly the fame of opposers' GREENBRIER marks, we find that, on balance, the relevant factors favor opposers.

Opposition No. 109,424

Decision: The opposition is sustained.

E. J. Seeherman

P. T. Hairston

C. M. Bottorff
Administrative Trademark Judges
Trademark Trial and Appeal Board