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RFC/KdeJ

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Best Western International, Inc.

v.

Clubhouse Inns of America, Inc.

_____

Opposition No. 99,156
to application Serial No. 74/574,780
filed on September 16, 1994

_____

Joseph H. Roediger of Nelson & Roediger for Best Western International, Inc.

Edward L. Brown, Jr. for Clubhouse Inns of America, Inc.

_____

Before Cissel, Seeherman and Chapman, Administrative Trademark Judges.

Cissel, Administrative Trademark Judge:

On September 16, 1994, Clubhouse Inns of America, Inc., hereinafter referred to as "applicant," applied to register the mark "BEST GUEST" for "hotel services," in Class 42.[1] The basis for the application was applicant's claim of use of the mark in commerce since February 1, 1991.

[1]Application Serial No. 74/574,780.

On October 13, 1995, Best Western International, Inc.,

hereinafter referred to as "opposer," filed a timely notice of opposition. As grounds for opposition, opposer asserted that it has used the mark "BEST GUEST" "in advertising its hotel and motel services" since at least as early as August 1, 1989; that it has used the mark "BEST GUEST" "as a mark for making hotel and motel reservations in the United States and Canada" since at least as early as August 1, 1989; that it used the mark "BEST GUEST" prior to applicant's alleged first use of "BEST GUEST"; and that applicant's "BEST GUEST" mark, as used in connection with the services set forth in the application, so resembles opposer's "BEST GUEST" mark that confusion, deception and mistake are likely.

In answer to the notice of opposition, applicant admitted that opposer has used "BEST GUEST" "in advertising" since at least as early as August 1, 1989, but denied that opposer has used "BEST GUEST" as a service mark, and otherwise denied the salient allegations of the notice of opposition. Applicant has also asserted that there is no likelihood of confusion because opposer used "BEST GUEST" as a descriptive term and failed to establish secondary meaning prior to applicant's first use of the mark.

A trial was conducted in accordance with the Trademark Rules of Practice, but only opposer submitted evidence and a brief. Neither party requested an oral hearing before the Board.

The record includes the pleadings, the file of the opposed application, and the testimony, by stipulated declaration, with exhibits, of Dorian LeFre, opposer's Legal Administrator.[2]

The issues before the Board are priority of use of the mark "BEST GUEST" and the likelihood of confusion between opposer's "BEST GUEST" mark and applicant's "BEST GUEST" mark.

The evidence and testimony of record in this proceeding show that opposer has provided hotel and related services since 1946, and claims to be one of the world's largest lodging chains. Opposer began using the alpha-numeric toll-free telephone number 1-800-BEST-GUEST in 1989 in connection with its GOLD CROWN CLUB program, which was begun in the previous year to reward frequent guests of opposer's hotels and motels. From its inception in 1988, opposer's GOLD CROWN CLUB grew to 420,000 members in 1991. GOLD CROWN CLUB members earn points based on the amount spent on lodging in opposer's hotels and motels, and when they reach certain numbers of points, they can redeem them for awards, such as free lodging, U.S. Savings Bonds, automobile club memberships and gift certificates, by calling the telephone number 1-800-BEST-GUEST. In addition to redeemable points,

[2]The parties have stipulated, pursuant to Trademark Rule 2.123(b), that the testimony by declaration of Dorian LeFre should be considered to meet the requirements for trial testimony.

GOLD CROWN CLUB members enjoy "Best Guest"[3] "treatment," "privileges" or "amenities" that vary with each hotel or motel, but typically include free room upgrades, free coffee in the room, free cocktails, and the like.

Opposer does not have a registration for the mark "BEST GUEST," and so must rely on its common law rights based on use of the mark. Based on the evidence of record, we find that opposer began using the term "BEST GUEST" as a service mark in promotional materials for opposer's GOLD CROWN CLUB, including applications for club membership, "Go for the Gold" catalogs describing the awards available to club members, and annual GOLD CROWN CLUB directories and road atlas and travel guides, before applicant filed the application which is the subject of this opposition.

A number of opposer's exhibits, particularly Exhibits "A," "C," "F," "G" and "J," establish that opposer uses the alpha-numeric toll-free telephone numbers 1-800-BEST-GUEST and 1-800-BEST GUEST in connection with its hotel and motel services. Some courts have held that marks which correspond to telephone numbers may be protectable as trademarks. *See Dranoff-Perlstein Assoc. v. Sklar*, 967 F.2d 852, 23 USPQ2d 1174 (3d Cir. 1992), and cases cited therein. In this case,

[3]Although opposer uses "BEST GUEST" in block capital letters in its toll-free telephone number, when opposer uses the term as a service mark, it appears as "Best Guest," in quotation marks and with the first letter of each word capitalized. For the sake of consistency, we hereinafter refer to opposer's mark as "BEST GUEST."

however, we do not have to consider the issue because the manner in which opposer uses 1-800-BEST-GUEST and 1-800-BEST GUEST is not as a mark identifying the source of opposer's services, but rather, merely as a telephone number.

Even though opposer cannot base its rights on use of its toll-free telephone number, opposer used the term "BEST GUEST" as a service mark well prior to September 16, 1994, the earliest date upon which applicant may rely. Three of opposer's exhibits -- Exhibit "B," a portion of an application for membership in opposer's GOLD CROWN CLUB with an August 1, 1989 revision date; Exhibit "D," a copy of two pages of opposer's *1990 Road Atlas and Travel Guide*; and Exhibit "E," a copy of two pages of opposer's *1991 Road Atlas and Travel Guide* -- show service mark use of the mark "BEST GUEST" as follows:

> You'll receive "Best Guest" treatment every time you stay. . . .

Likewise, Exhibit "H," a copy of two pages of the Spring 1993 issue of opposer's *All Points Bulletin*, shows the following service mark use of the term "BEST GUEST":

> Our exciting new merchandise program is your reward for being a Best Western "Best Guest."

Service mark use of "BEST GUEST" is also shown in Exhibit "I," a copy of two pages of the Fall/Winter 1993 *All Points Bulletin*:

> Your Gold Crown Club Directory provides the amenities you can expect at each Best Western facility. It's

> all part of the Best Guest amenities you enjoy as a Gold Crown Club International member!

Exhibit "K," a copy of the cover page of opposer's 1993 *Gold Crown Club International Directory*, as revised in December of 1992, also shows use of "BEST GUEST" as a service mark:

> As a member of the Gold Crown Club, you will receive "Best Guest" privileges at many individual properties . . . .

In summary on this issue, based on a review of this evidence,[4] we find that opposer began using "BEST GUEST" as a service mark for its hotel services for preferred customers prior to the September 16, 1994 filing date of the opposed application, which, in the absence of evidence establishing applicant's first use date, is the earliest date upon which applicant is entitled to rely. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994). Thus, opposer has established priority over applicant.

In view of opposer's priority of use, we then turn to the issue of likelihood of confusion. Because opposer's mark is virtually identical to applicant's mark, and opposer's services are closely related to applicant's identified services, "hotel services," applicant's use of its mark for the identified services is likely to cause confusion.

[4]The remaining evidence (Exhibits "L" through "T") concerns opposer's use of the mark "BEST GUEST" after applicant's September 16, 1994 application filing date.

In reaching this conclusion, we have considered the evidence of record in light of the relevant evidentiary factors set out in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Not all of the *duPont* factors are relevant or of similar weight in every case. *Opryland USA Inc. v. The Great American Music Show Inc.*, 23 USPQ2d 1471 (CAFC 1992). Two of the primary factors in the instant case are the parties' marks and the services with which they are used.

As to the marks, we note again that opposer's mark, as used, is "Best Guest," capitalizing the first letter of each word and setting the mark apart with quotation marks. Applicant's mark is "BEST GUEST" in typed form. This form would include protection for a mark displayed in identical form to opposer's mark. In appearance, pronunciation, meaning and commercial impression, opposer's mark is virtually identical to applicant's mark.

Before proceeding to a comparison of the services, we note that where, as here, the marks are the same or nearly so, it is only necessary that there be a viable relationship between the goods or services in order to support a finding of a likelihood of confusion. *See In re Concordia International Forwarding Co.*, 222 USPQ 355 (TTAB 1983). The question of likelihood of confusion in this opposition proceeding must be determined not on the basis of evidence

adduced as to the nature and character of applicant's services as they are actually rendered, but rather, on the basis of a comparison of the services set forth in the application with the services with which opposer has shown prior use of its unregistered mark. *See Hecon Corp. v. Magnetic Video Corp.*, 199 USPQ 502 (TTAB 1978).

In this case, the opposed application broadly identifies applicant's services as "hotel services." Exhibits "B," "D," "E," "H," "I" and "K" clearly show "BEST GUEST" used by opposer as a service mark for services it provides to its hotel guests. Exhibit "L," a copy of four pages from opposer's 1994 *Gold Crown Club International Directory*, establishes that these services, referred to as "'Best Guest' Amenities," include providing additional benefits, such as free newspapers, free cocktails, free coffee in the room, free local telephone calls, free facsimile services, free room upgrades, free breakfasts and later checkout times, to preferred guests of opposer's hotels. Applicant's identified hotel services are highly similar and otherwise closely related to the services opposer has rendered under the mark "BEST GUEST" to frequent guests of its hotels and motels. While lodging upgrades, coffee, cocktails and so forth are not ordinarily offered free of charge by hotels, they are certainly encompassed within the broad range of services referred to as "hotel

services." That no separate charge is levied for these activities does not alter the fact that opposer's mark identifies their source.

Inasmuch as opposer has established its priority and the parties are using legally identical marks in connection with similar services, confusion is likely.

DECISION: The opposition is sustained.

R. F. Cissel

E. J. Seeherman

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board