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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Bellagio, LLC

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Serial No. 77175007

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Michael J. McCue and Emily A. Bayton of Lewis and Roca LLP for Bellagio, LLC.

Mark Shiner, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

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Before Grendel, Cataldo and Taylor, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Bellagio, LLC to register on the Principal Register the mark DUNES in standard characters for "casino services" in International Class 41.[1]

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[1] Application Serial No. 77175007 was filed on May 7, 2007, based on applicant's allegation of December 31, 1956 as a date of first use of the mark anywhere and in commerce under Section 1(a) of the Trademark Act.

In addition, applicant claimed ownership of cancelled Registration No. 1401610 for the mark DUNES for "casino services," issued to applicant's predecessor on July 15, 1986, assignment to applicant recorded on October 27, 1999, and cancelled under Section 8 of the Trademark Act on April 21, 2007. The file from the application underlying Registration No. 1401610 is not of record and, in any event, we note that applicant's

The trademark examining attorney initially rejected the specimen submitted with the application on the ground that it fails to indicate use of the mark as a service mark in connection with the recited services. When the examining attorney made final the requirement that applicant submit an acceptable specimen of use, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.[2]

Applicant asserts that its specimen of use (displayed below) "consists of a color photograph of a slot machine located on the floor of Applicant's casino in Las Vegas, Nevada;"[3] that "slot machines are the most popular gaming method in casinos and can constitute as much as 70% of an average casino's income;"[4] and that "given the popularity of slot machines in the gaming industry, consumers who encounter these machines on the casino floor know and

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cancelled registration is not evidence of anything except that it issued. *See* TBMP §704.03(b) (2d ed. rev. 2004) and cases cited therein. See also Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650 (TTAB 2002). Any benefits conferred by the registration, including the evidentiary presumptions afforded by Section 7(b) of the Trademark Act were lost when the registration expired. See, e.g., Anderson, Clayton & Co. v. Krier, 478 F.2d 1246, 178 USPQ 46 (CCPA 1973).

[2] The involved application was originally examined by another examining attorney, but was subsequently reassigned to the attorney whose name is shown to prepare the appeal brief.

[3] Applicant's brief, p. 9.

[4] Id.

understand that the machines are used for gaming."[5]

Applicant argues that its

> DUNES-branded slot machines appear throughout the Bellagio casino floor. Consumers encountering the DUNES slot machines are undoubtedly aware that the machines themselves are not for sale. Indeed, casinos do not sell slot machines. Rather, the DUNES-branded slot machines are used by customers for gaming, which is the casino service offered by Applicant to its customers. Indeed, casinos offer casino services through devices, including slot machines, roulette wheels, and tables. … Applicant's use of the DUNES mark on front panels of its slot machines creates in the mind of the consumer a direct association between Applicant's DUNES mark and its casino services.[6]

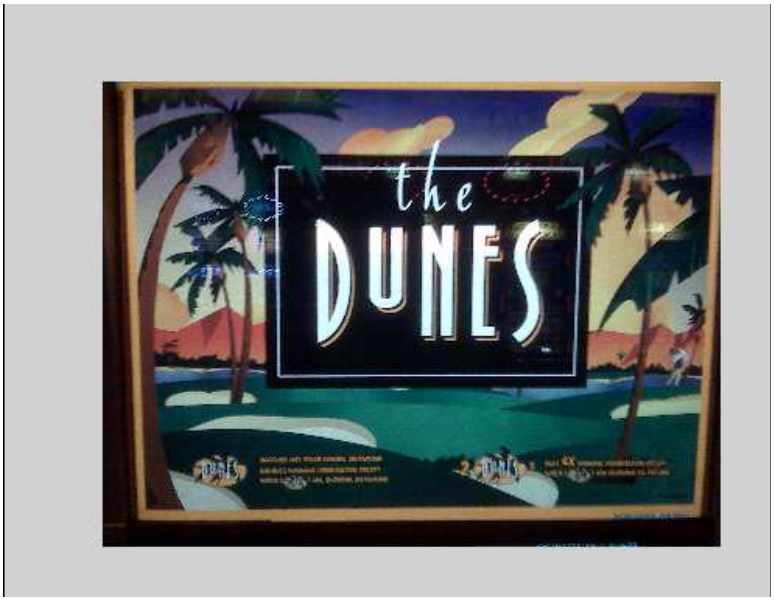
[5] Id.
[6] Id., p. 9-10.

Applicant argues that, as a result of the foregoing, "when encountering a DUNES-branded slot machine inside the Bellagio casino, consumers readily identify the slot machine as providing casino services."[7] In support of its arguments, applicant submitted with its September 26, 2008 request for reconsideration articles retrieved from the online, open-source dictionary, Wikipedia, concerning slot machines and the Dunes Hotel and Casino.

In addition, applicant submitted for the first time with its brief an alternative substitute specimen (displayed below) consisting of "a photograph of a sign indicating casino services relating to designated slot machines. The language on the image states:

> MATCHES ANY OTHER SYMBOL ON PAYLINE
> DOUBLES WINNING COMBINATION EXCEPT
> WHEN 3 DUNES ARE SHOWING ON PAYLINE
>
> PAYS 4X WINNING COMBINATION EXCEPT
> WHEN 3 DUNES ARE SHOWING ON PAYLINE"[8]

[7] Id., p. 10.
[8] Id., p. 11.



Applicant also submitted a declaration in support thereof.

The examining attorney maintains that the specimen submitted with the original application displays the mark on goods, namely, slot machines, and not in connection with the sale or advertising of applicant's "casino services." The examining attorney further maintains that, as a result, the submitted specimen fails to create the necessary association between the mark and the services identified thereunder. The examining attorney maintains in addition that the specimen fails to indicate applicant as the source of the services identified under the mark.

With regard to the substitute specimen submitted by applicant with its brief, the examining attorney contends that such substitute specimen is untimely and should not be considered. The examining attorney further argues that "in

any event, this specimen fails to show proper service mark usage in commerce for the same reasons as discussed below – it fails to associate applicant's mark with its casino services and there is no indication consumers would recognize the mark as indicating applicant as the source of such services."[9]

Specimen Submitted with Applicant's Brief

As an initial matter, we do not agree with the examining attorney that the substitute specimen submitted by applicant with its brief is untimely "evidence" submitted after appeal. Cf. TBMP §1207.01 and the authorities cited therein. Rather, the substitute specimen is more properly an amendment in the alternative to overcome the instant refusal to register. See TBMP §1205.01 and the authorities cited therein. In that regard, we note that the better practice would have been for applicant to file a request for remand to the examining attorney for consideration of the substitute specimen along with a request to suspend proceedings in the appeal pending the Board's determination thereof. See Id. Nonetheless, the Board may treat the substitute specimen submitted with applicant's brief as a request for remand, and consider

[9] Brief, p. 3.

whether good cause has been shown in determining the request. See Id.

In this case, however, we note that applicant has not made any showing of good cause to support a request to remand its application for consideration of the proposed substitute specimen. Thus, even if we construe applicant's submission of its alternative substitute specimen as a request for remand, such request fails to show good cause therefor. Furthermore, and as noted above, in addition to arguing in his brief that the proposed amendment is untimely, the examining attorney has indicated that the substitute specimen fails to associate applicant's DUNES mark with its casino services and thus fails to show use of DUNES as a service mark. Thus, the examining attorney has already indicated that the proposed substitute specimen is unacceptable. As a result, it would serve no useful purpose to remand the application to the examining attorney for consideration thereof.[10]

In view thereof, applicant's proposed substitute specimen, submitted with its brief on appeal, will be given no further consideration.

[10] We note in addition that applicant characterizes its substitute specimen above as a "sign indicating casino services relating to designated slot machines," and that such sign appears identical to the depiction of the applied-for DUNES mark in the original specimen, identified as a photograph of a slot machine.

Specimen Submitted with Application

Trademark Rule 2.34 provides, in part, that an application based on use in commerce must include one specimen showing how the applicant actually uses the mark in commerce. See 37 C.F.R. §2.34(a)(1)(iv). Trademark Rule 2.56(b)(2) specifies that a "service mark specimen must show the mark as actually used in the sale or advertising of the services." See 37 C.F.R. §2.56(b)(2). Section 45 of the Trademark Act provides, in part, that a service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...." See 15 U.S.C. §1127.

To be an acceptable specimen of use of the mark in the sale or advertising of the identified services, there must be a direct association between the mark sought to be registered and the services specified in the application, and there must be sufficient reference to the services in the specimens to create this association. See In re Monograms America Inc., 51 USPQ 1317 (TTAB 1999). It is not enough that the term alleged to constitute the mark be used in sale or advertising; there must also be a direct association between the term and the services. See In re Compagnie Nationale Air France, 265 F.2d 938, 121 USPQ 460

(CCPA 1959); In re Johnson Controls Inc., 33 USPQ2d 1318 (TTAB 1994); and Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320 (TTAB 1985). See also In re Adair, 45 USPQ2d 1211 (TTAB 1997). The mark must be used in such a manner that it would be readily perceived as identifying the source of such services. In re Advertising & Marketing Development, Inc., 821 F.2d 614 2 USPQ2d 2010 (Fed. Cir. 1987); and In re Metrotech, 33 USPQ2d 1049 (Com'r Pats. 1993). See also TMEP §1301.04 (4th ed. Rev. 2005). Thus, the issue before us is whether the specimen of record creates a direct association between applicant's DUNES mark and the services specified in the application.

In this case, we first find that the specimen submitted by applicant with its application displays its DUNES mark. Inasmuch as applicant applied for its mark in standard character form, the mark as it appears in stylized form in its specimen of use is considered to agree with the mark as it appears in its drawing. See Trademark Rule 2.52(a); 37 C.F.R. §2.52(a). See also TBMP §807.03(e).

However, we further find that applicant's specimen fails to show the requisite direct association between the mark and the activities described thereunder. Cf. In re Adair, supra; and In re Johnson Controls, Inc., supra. Specifically, the specimen is a photograph displaying the

mark on slot machines. Clearly, this photograph would be adequate as a specimen of use of the DUNES mark on slot machines because it depicts the mark on such goods. Nonetheless, applicant has not applied to register its mark on goods, but rather in connection with "casino services." Because applicant's specimen fails to mention the recited services or otherwise indicate that those services are being performed, it is not acceptable as evidence of applicant's use of the DUNES mark in connection with such services. We note, in that regard, that there is no evidence of record that placing a mark on a slot machine is a typical manner for a casino to use its mark in connection with casino services. Nor is there evidence of record that casino services are so inherently unusual that the typical methods of displaying a service mark therefor, e.g., signage or advertisements, would be unavailable.[11] Cf. In re Metriplex, Inc., 23 USPQ2d 1315 (TTAB 1992); and In re Red Robin Enterprises, Inc., 222 USPQ 911 (TTAB 1984).

Similarly, we are not persuaded by applicant's arguments that because the slot machines themselves are not offered for sale, but rather are present in applicant's

[11] In contrast, the Wikipedia evidence made of record by applicant includes a photograph of the now demolished Dunes hotel and casino featuring an enormous sign the height of the hotel itself prominently displaying DUNES at the top thereof.

casino, patrons thereof necessarily will make a direct association between the DUNES-marked slot machines and applicant's casino services. Applicant appears to argue that because it is located on the former site of The Dunes hotel and casino, which operated from 1955 until 1993,[12] and further because it utilizes the mark DUNES on slot machines in its casino, patrons of its casino will directly associate the DUNES mark with its casino services and not simply the slot machines upon which the mark appears. Notably, applicant did not submit arguments or evidence that it uses the DUNES mark on signage, advertisements, or other promotional material in connection with its casino services. The record instead shows that applicant's sole use of DUNES appears to be on slot machines located in its casino. We further note that evidence submitted by applicant indicates that slot machines, especially video slots, often are themed slots featuring graphics and music associated with entertainers, television programs such as *The Addams Family* or *I Dream of Jeannie*, or game shows such as *Wheel of Fortune*.[13]

Thus, a customer encountering a slot machine displaying DUNES as depicted above in applicant's casino,

[12] http://en.wikipedia.org/wiki/Dunes_(hotel_and_casino)
[13] http://en.wikipedia.org/wiki/Slot_machine

in the apparent absence of any signage or advertising associating such mark with applicant's services, must perceive that DUNES does not simply indicate a slot machine, possibly themed on the hotel and casino formerly occupying the site, but rather as a source indicator for applicant's casino services. Such an association requires a customer to recognize DUNES not as a trademark on the slot machines themselves, but as a service mark pointing to applicant as the source of the casino services in which the slot machine is located. We find that this is not a direct association, as argued by applicant, but requires at least one additional mental step. It may further be necessary for customers to be aware of the history of the former Dunes hotel and casino in order to make this association. Thus, while there appears to be no question that applicant utilizes DUNES-marked slot machines in the rendering of its casino services, applicant's use of the DUNES mark solely on such slot machines is insufficient as a specimen showing the sale or advertising of casino services in commerce as required by Section 45 of the Trademark Act.

As a result, we find that applicant's specimen fails to create a direct association between the DUNES mark and applicant's recited casino services. We therefore conclude that the specimen of record is not adequate to support the

use of the mark in connection with the identified services.

Decision: The refusal to register on the ground that the specimen is unacceptable evidence of service mark use in connection with the identified services is affirmed.