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Subject: U.S. TRADEMARK APPLICATION NO. 85878085 - RS ROCKSTAR HOTELS - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85878085

MARK: RS ROCKSTAR HOTELS



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the mark RS ROCKSTAR HOTELS (and design) for "Administrative hotel management; Business management of hotels for others; Hotel management for others" in International Class 35 and "Hotel accommodation services; Hotel services; Resort hotel services" in International Class 43 based on a likelihood of confusion under

Trademark Act Section 2(d), 15 U.S.C. §1052(d) with Registration No. 4671990, for the mark ROCK STAR SUITES (in standard characters), for “hotel services.”

FACTS

On March 16, 2013, Robert Santucci applied for registration of the service mark RS ROCKSTAR HOTELS (and design) pursuant to 15 U.S.C. §1051(b). The services in the application were identified as “Administrative hotel management; Business management of hotels for others; Hotel management for others,” in International Class 35, and “Hotel accommodation services; Hotel services; Resort hotel services” in International Class 43.

On June 25, 2013, the examining attorney suspended action on the application pending the disposition of earlier-filed Application Serial No. 78582083, ROCK STAR SUITES for “Hotel services” in International Class 43. The examining attorney believed that if registered, the prior-pending application could be the basis for a Section 2(d) refusal of applicant’s mark.

On January 13, 2015, Application Serial No. 78582083 registered as Registration No. 4671990. On January 16, 2015, applicant responded to the Letter of Suspension by informing the examining attorney that the prior-pending application had registered, and presenting arguments against a Section 2(d) refusal.

On January 28, 2015, the examining attorney removed the application from suspension and refused the application under Section 2(d) based on a likelihood of confusion with the mark in Registration No. 4671990. Applicant responded to this Office action on June 19, 2015 by stating that he “respectfully resubmits the argument submitted on January 16, 2015 for review regarding the likelihood

of confusion.” The examining attorney issued a final refusal of the application under Section 2(d) on July 10, 2015.

Applicant filed a Notice of Appeal on July 23, 2015. On September 15, 2015, applicant filed a Motion to Remand Application requesting that the examining attorney consider additional evidence. Specifically, applicant sought to introduce and make of record Registration No. 3733204 for PARTY LIKE A ROCK STAR...SLEEP LIKE A BABY (in standard characters) for “hotel services” in International Class 43. The Board restored jurisdiction to the examining attorney on September 18, 2015.

The examining attorney considered the new evidence and issued a denial of Request for Reconsideration on October 14, 2015. Proceedings at the Board resumed October 15, 2015.

Applicant filed its appeal brief on December 14, 2015 and the Trademark Trial and Appeal Board forwarded the appeal for examiner brief on December 15, 2015.

ISSUE

The sole issue on appeal is whether the applicant’s mark, when used in connection with the identified services, so resembles the mark in Registration No. 4671990, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

ARGUMENT

Applicant’s mark, RS ROCKSTAR HOTELS, used in connection with “Administrative hotel management; Business management of hotels for others; Hotel management for others” and “Hotel accommodation services; Hotel services; Resort hotel services” is likely to be confused with the mark in

Registration No. 4671990, which is ROCK STAR SUITES for “Hotel services.” Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

I. APPLICANT’S MARK IS CONFUSINGLY SIMILAR TO REGISTRANT’S MARK

Applicant’s mark is confusingly similar to registrant’s mark. Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1371,

73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

The respective marks, RS ROCKSTAR HOTELS and ROCK STAR SUITES, are highly similar in appearance, sound and meaning. Both share the common dominant literal element, “ROCK STAR.” The only differences are applicant’s stylization and “RS” element, applicant’s replacement of the descriptive word “SUITES” with the descriptive word “HOTELS,” and applicant’s use of “ROCKSTAR” as a single word rather than two words.

“ROCK STAR” is the dominant portion of both marks. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

In this case, the marks share the same first full words, “ROCK” and “STAR.” This fact contributes to the marks having the same commercial impression because consumers are more likely to focus on the term “ROCK STAR” when viewing or hearing the marks.

Additionally, the fact that there is no space between “ROCK” and “STAR” in the applied-for mark does not meaningfully differentiate it from the “ROCK STAR” element of the registered mark. The capitalization of the letters “R” and “S” in applicant’s mark will cause consumers to perceive the dominant portion of applicant’s mark as two words, “ROCK STAR.” Accordingly, consumers will perceive

the dominant elements of both marks to be identical. It is also noteworthy that applicant refers to this element as two words, "ROCK STAR," in his brief.

Further, applicant's use of "HOTELS" in his mark in place of "SUITES" in the registered mark does not obviate the overall similarity between the marks. Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

In this case, the word "HOTELS" in the applied-for mark is disclaimed, and the word "SUITES" in the registered mark is disclaimed, both for being descriptive of the parties' services. As such, "HOTELS" and "SUITES" are less significant when comparing the marks, and leave "ROCK STAR" as the dominant portion of both marks.

Applicant argues that the stylized "RS" portion of his mark is dominant because "HOTELS" is generic and "ROCK STAR" is highly suggestive. Applicant believes that "ROCK STAR" is suggestive because it suggests "a certain high quality of services available only to a certain level of patron, namely, Rock Stars." (Brief of the Applicant, page 11). Applicant also argues that the registered mark PARTY LIKE A ROCK STAR...SLEEP LIKE A BABY for "hotel services" (Registration No. 3733204, Applicant's Motion to Remand Application, Ex. 1) shows that "ROCK STAR" is suggestive of the quality of hotel services.

These arguments are unpersuasive for several reasons. First, the existence of a single third-party registered mark featuring the term "ROCK STAR" does not render "ROCK STAR" weak or suggestive for hotel services, and applicant has provided no evidence or reasoning to support this argument.

Second, the "RS" element of applicant's mark is merely a stylized abbreviation of its dominant element, "ROCK STAR." As such, the "RS" abbreviation in applicant's mark reiterates the dominant "ROCK STAR" portion of the mark, which is identical to the dominant portion of the registered mark.

Finally, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”).

In this case, the registered mark is in standard characters, which means it may be displayed with any design or stylization, including the applicant’s. Therefore, the applicant’s stylized “RS” lettering is not the dominant element of the applied-for mark and does not create a different commercial impression.

Thus, the applied-for mark creates a likelihood of confusion with the cited registration because the marks share the identical dominant literal element, “ROCK STAR,” which gives the marks the same commercial impression.

II. APPLICANT’S SERVICES ARE HIGHLY RELATED TO REGISTRANT’S SERVICES

The applicant’s “Administrative hotel management; Business management of hotels for others; Hotel management for others” and “Hotel accommodation services; Hotel services; Resort hotel services” are closely related to the registrant’s “hotel services” because the registrant’s services are

broad enough to encompass some of the applicant's services, and applicant's and registrant's services are frequently offered by the same entities under the same service marks.

Additionally, applicant presented no arguments against the relatedness of the services in its brief. Rather, applicant stated that he "must concede the similarity of the goods or services as recited in the Applicant's applied-for trademark as well as the registered trademark." (Brief of the Applicant, page 12).

Regardless of applicant's concession, the registrant's "hotel services" are broad enough to encompass the applicant's "Hotel accommodation services; Hotel services; Resort hotel services." With respect to applicant's and registrant's services, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth in the application and registration have no restrictions as to nature, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the

registration uses the broad wording “hotel services” to describe the services, and this wording is presumed to encompass all services of the type described, including the applicant’s “Hotel accommodation services; Hotel services; Resort hotel services.”

Additionally, applicant’s “Administrative hotel management; Business management of hotels for others; Hotel management for others” and “Hotel accommodation services; Hotel services; Resort hotel services” are related to registrant’s “hotel services” because these services are frequently offered by the same entities under the same service marks. The record in this case contains third-party webpages showing hotel services and hotel management services offered under the same service marks:

- HILTON provides hotel management, hotel services, and resort hotel services. (final Office action, July 10, 2015, pages 33-37).
- CAPELLA provides hotel management and hotel services. (final Office action, July 10, 2015, pages 38-41).
- STARWOOD provides hotel management, hotel services, and resort hotel services. (final Office action, July 10, 2015, pages 63-64).
- CRESCENT provides hotel management, hotel business management, hotel services, and resort hotel services. (final Office action, July 10, 2015, pages 65-66).
- MODUS provides hotel management and hotel services. (final Office action, July 10, 2015, pages 67-69).
- DRIFTWOOD provides hotel services and hotel management (final Office action, July 10, 2015, pages 42-62).

See, e.g., In re Davey Prods. Pty Ltd., 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys.*

Corp., 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

Additionally, third-party registrations in the record show the relatedness of “Administrative hotel management; Business management of hotels for others; Hotel management for others,” “Hotel accommodation services; Hotel services; Resort hotel services,” and “hotel services”:

- Registration No. 4287066 for “Administrative hotel management,” “Business management of hotels for others,” “Hotel management for others,” “Hotel services,” and “Hotel accommodation services.” (final Office action dated July 10, 2015, pages. 4-6).
- Registration No. 4364036 for “Administrative hotel management; Business management of hotels for others; Hotel management for others,” “Hotel accommodation services; Hotel services” and “Resort hotel services.” (final Office action dated July 10, 2015, pages. 7-9).
- Registration No. 4612166 for “Administrative hotel management,” “Hotel accommodation services; Hotel services” and “Resort hotel services.” (final Office action dated July 10, 2015, pages. 16-18).
- Registration No. 4690691 for “Hotel accommodation services,” “Hotel services” and “Resort hotel services.” (final Office action dated July 10, 2015, pages. 19-21).
- Registration No. 4737469 for “hotel accommodation services,” and “hotel, bar and restaurant services.” (final Office action dated July 10, 2015, pages. 22-24).
- Registration No. 4674879 for “HOTEL MANAGEMENT FOR OTHERS,” “HOTEL SERVICES,” and “RESORT HOTEL SERVICES.” (final Office action dated July 10, 2015, pages. 25-27).
- Registration No. 4754839 for “Hotel accommodation services,” and “Hotel services.” (final Office action dated July 10, 2015, pages. 28-30).
- Registration No. 4764093 for “Hotel accommodation services,” and “Hotel services.” (final Office action dated July 10, 2015, pages. 31-32).
- Registration No. 3479760 for “Hotel management and operation of hotels for others; business management of hotels,” “hotel and restaurant services,” and “resort hotel services.” (Office action dated January 28, 2015, pages 4-6).

- Registration No. 3997674 for “Administrative hotel management; hotel management for others,” and “hotel services; resort lodging services.” (Office action dated January 28, 2015, pages 34-36).
- Registration No. 4070741 for “Administrative hotel management; Business management of hotels for others; Hotel management for others,” “Hotel accommodation services” “Hotel services,” and “Resort hotels.” (Office action dated January 28, 2015, pages. 40-42).

Third-party registrations show that the listed services are of a kind that may emanate from a single source under a single mark. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP §1207.01(d)(iii).

Although applicant concedes that the applied-for and registered services are related, applicant argues that the marks are different enough to render confusion unlikely. However, the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

CONCLUSION

Based on case law and evidence in the record, applicant’s mark, when used in connection with the identified services, so resembles the mark in Registration No. 4671990 that it is likely to cause

confusion, to cause mistake, or to deceive. The examining attorney respectfully requests the Board affirm the refusal to register the mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Respectfully submitted,

/April Reeves/

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