

This Opinion is not a
Precedent of the TTAB

Mailed: May 19, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re Santucci
—

Serial Nos. 85877699 and 85878085
—

Matthew H. Swyers of The Trademark Company,
for Robert Santucci.

April Reeves, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

—
Before Zervas, Ritchie and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Robert Santucci (“Applicant”) seeks registration on the Principal Register of the marks RS ROCKSTAR HOSPITALITY GROUP and design¹ and RS ROCKSTAR HOTELS and design,² as displayed below, both for “Administrative hotel

¹ Application Serial No. 85877699, filed on March 15, 2013, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming January 1, 2013 as both the date of first use and the date of first use in commerce for both International Classes 35 and 43. The wording “HOSPITALITY GROUP” is disclaimed.

² Application Serial No. 85878055, filed on March 16, 2013, based on *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), for

management; Hotel management for others; Managing and operating resort hotels and business conference centers for others” in International Class 35; and “Hotel accommodation services; Hotel services; and Resort hotel services” in International Class 43.



The Trademark Examining Attorney has refused registration of both of Applicant’s marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that each of Applicant’s marks so resembles the registered mark ROCK STAR SUITES (in standard characters; SUITES disclaimed) for “hotel services” in International Class 43,³ that use of Applicant’s marks in connection with Applicant’s services is likely to cause confusion or mistake or deceive.

After the Trademark Examining Attorney made the refusals final, Applicant appealed and requested that his applications be remanded to the Examining Attorney

the services identified in both International Classes 35 and 43. The wording “HOTELS” is disclaimed.

³ Registration No. 4671990, issued on January 13, 2015.

for consideration of additional evidence and arguments with regard to the final refusals under Section 2(d) of the Trademark Act. After the Examining Attorney determined that Applicant's additional evidence and arguments did not resolve all the outstanding issues, the appeals resumed. We affirm the refusals to register each mark.

Appeals Consolidated

These appeals involve common questions of law and fact and the records are substantially similar. Accordingly, we consolidate and decide both appeals in this single decision. *See In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TBMP § 1214 (2015).

I. Applicable Law

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

A. *The similarity or dissimilarity of the marks.*

We first address the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re Nat’l Data*, 224 USPQ at 751.

Applicant's marks are ROCKSTAR HOSPITALITY GROUP and ROCKSTAR HOTELS, with ROCKSTAR appearing in larger font in both marks. Each mark also includes a design element described by Applicant as "the stylized text 'RS' intersecting the middle of a circle." While this mark comprises both words and a design, "the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed." *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), *citing CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983). Greater weight is often given to the wording because it is the wording that purchasers would use to refer to or request the goods or services. *See, e.g., In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012). Furthermore, although the "RS" design feature in each of Applicant's marks appears before the wording ROCKSTAR, it will be perceived as an abbreviation of the wording ROCKSTAR, which only reinforces the dominant nature of ROCKSTAR in each of Applicant's marks. We also find the wording HOSPITALITY GROUP and HOTELS less significant given their smaller size and the fact that the wording is generic, and has been appropriately disclaimed by Applicant.⁴ In view of the foregoing and because ROCKSTAR appears as the larger and more noticeable word in Applicant's marks, we find ROCKSTAR is the dominant element of Applicant's marks.

⁴ As noted, *infra*, Applicant concedes that this disclaimed matter is generic of its identified services. *See Applicant's Appeal Briefs*, p. 9.

ROCK STAR is also the dominant component of the cited mark.⁵ ROCK STAR would be perceived as a single term, and the remaining term in the mark, SUITES, is at best merely descriptive of a feature of Registrant's services, i.e. identifying the nature of its rooms provided as part of its "hotel services." The cited mark is a standard character mark, and hence can be displayed in any number of fonts, styles and sizes, with ROCK STAR emphasized in the same manner as Applicant emphasizes ROCKSTAR in its marks. *See Viterra*, 101 USPQ2d at 1909; *see also* 37 C.F.R. § 2.52(a). Because Applicant's marks and the cited mark share the dominant term ROCKSTAR and are followed by merely descriptive or generic terms, we find the marks to be similar in sound, appearance, meaning and commercial impression.

We are not persuaded by Applicant's argument that the stylized "RS" portion of his marks is dominant because the wording HOSPITALITY GROUPS and HOTELS are generic and ROCKSTAR is suggestive since it alludes to "a certain high quality of services available only to certain level of patrons, namely, Rock Stars." Applicant relies on a third-party registration for PARTY LIKE A ROCK STAR...SLEEP LIKE A BABY for "hotel services".⁶ First, as explained above, the "RS" design feature in each of Applicant's marks will be perceived as an abbreviation of the wording ROCKSTAR which reinforces the dominant nature of ROCKSTAR in each of Applicant's marks. Second, the third-party registration including the wording ROCK

⁵ The fact that there is no space between the terms ROCK and STAR in Applicant's marks does not meaningfully differentiate them from the ROCK STAR element in the cited mark.

⁶ Applicant's Appeal Briefs, p. 11; Applicant's September 15, 2015 Request for Remand (4 TTABVUE).

STAR submitted by Applicant fails to make Applicant's point regarding the meaning of the term because it uses the expression "party like a rock star" to signify "intensity" perhaps in work or entertainment and not a certain quality of services for certain patrons. Moreover, there is no disclaimer of "rock star" in the registration.

Overall, and considering the marks as a whole, we find that the similarities in sound, appearance, meaning and commercial impression between Applicant's marks and the cited mark clearly outweigh any differences.

The first *du Pont* factor thus supports a finding that confusion is likely.

B. *Relatedness of the Services and Trade Channels.*

Turning next to the services, which are identical in the Applications, we must determine whether their degree of relatedness to the services in the cited registration rises to such a level that consumers would mistakenly believe the services emanate from the same source. The comparison must be based on the identifications in the applications and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). If likelihood of confusion exists with respect to any of Applicant's identified services in a particular class, the refusal of registration must be affirmed as to all services in that class. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Here, Applicant's International Class 43 "hotel services" are identical to the services identified in the cited registration. Furthermore, Applicant's remaining

International Class 43 services, i.e., “hotel accommodation services” and “resort hotel services” are encompassed by Registrant’s more broadly defined “hotel services,” and are, therefore, identical in part to the services identified in the cited registration.

With regard to Applicant’s International Class 35 services, namely, “administrative hotel management services,” “hotel management for others,” and “managing and operating resort hotels and business conference centers for others,” we note that the Examining Attorney has made of record over thirty use-based third-party registrations in which the recitations of services consist of both Applicant’s International Class 35 services (in whole or in part), and “hotel services” in International Class 43, the services recited in the cited registration.⁷ Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the services listed therein are of a kind which may emanate from a single source under a single mark. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Additionally, the Examining Attorney submitted printouts from various third-party websites demonstrating that the services listed in Applicant’s applications and the cited registration are offered and promoted under the same mark by a single source.⁸ We find that this evidence, as well as the numerous third-party registrations made of record by the Examining Attorney, sufficient to establish that

⁷ See Office Actions dated January 28, 2015 and July 10, 2015 for both involved applications.

⁸ *Id.*

Applicant's International Class 35 services and Registrant's "hotel services" are related.

In view thereof, the *du Pont* factor relating to the similarity of the services weighs in favor of likely confusion. Applicant does not dispute this finding; Applicant "concede[s] the similarity of the goods or services as recited in the Applicant's applied-for trademark as well as the registered trademark."⁹

Because Applicant's "hotel services" are identical to the services in the cited registration, and since Applicant's remaining International Class 43 services are identical in part to Registrant's services, it is presumed that Applicant's International Class 43 services and Registrant's services are offered in the same channels of trade and to the same class of purchasers normal for those services. *See In re Viterra Inc.*, 101 USPQ2d at 1908 (the Board may rely on this legal presumption in determining likelihood of confusion). *See also Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.").

With regard to Applicant's International Class 35 services, there is no conclusive evidence of record to establish these services travel in the same trade channels or are

⁹ Applicant's Appeal Briefs, p. 12.

promoted to the same consumers as Registrant's "hotel services." Accordingly, this *du Pont* factor is neutral with regard to Applicant's International Class 35 services.

II. Conclusion.

In sum, because the marks in their entireties are similar, the services are identical in part, and related, in part, and at least insofar as Applicant's International Class 43 services are presumed to travel in the same trade channels and offered to the same class of purchasers as Registrant's services,¹⁰ we find that Applicant's marks are likely to cause confusion with the cited mark when used in association with the identified services.

Decision: The refusals to register Applicant's marks in application Serial Nos. 85877699 and 85878085 under Section 2(d) of the Trademark Act are affirmed.

¹⁰The fact that that the record does not establish conclusively that Applicant's International Class 35 services travel in the same channels of trade or are offered to the same class of consumers as Registrant's "hotel services" does not alter our decision herein, particularly in light of our findings that the marks at issue are similar in sound, appearance, meaning and commercial impression, and that the services rendered thereunder are related.