

This Opinion is Not a  
Precedent of the TTAB

Mailed: July 8, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Eldorado Resorts LLC*  
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Serial No. 88514634  
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William T. McGrath and Paras R. Shah of Davis McGrath LLC,  
for Eldorado Resorts LLC.

Chioma (Bata) Oputa, Trademark Examining Attorney, Law Office 103,  
Stacy Wahlberg, Managing Attorney.

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Before Kuczma, Larkin, and Johnson,  
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

Eldorado Resorts LLC (“Applicant”) seeks registration on the Principal Register of the mark ELDORADO RESORT CASINO RENO (in standard characters) for “Bar services; Hotel services; Restaurant services; Resort hotel services,” in International Class 43.<sup>1</sup>

<sup>1</sup> Application Serial No. 88514634, filed on July 15, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as Feb. 1, 2014. “RESORT CASINO RENO” is disclaimed. As originally filed, the application also included services in International Class 41. Inasmuch as the refusal did not apply to those services, on October 16, 2020, Applicant filed a Request to Divide, which was granted on November 12, 2020. Those services were moved to a separate

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the services identified in the application, so resembles the following marks, all in International Class 43 and registered on the Principal Register, as to be likely to cause confusion, to cause mistake, or to deceive:




<u>Owner</u>	<u>Reg. No.</u>	<u>Issued</u>	<u>Mark</u>	<u>Services</u>
El Dorado Cantina 55, LLC	5468181 <sup>2</sup>	May 15, 2018		Restaurant and bar services.
	5468340 <sup>3</sup>	May 15, 2018		Fast-food restaurant services.
Fantastic Brands, LLC	5653945 <sup>4</sup>	Jan. 15, 2019		Hotel and resort hotel services; travel agency services, namely, making reservations and bookings for temporary lodging.

application, Child Application Serial No. 88979590, which matured into Registration No. 6286519 on March 9, 2021. See Trademark Rule 2.87, 37 C.F.R. § 2.87.

<sup>2</sup> The mark is described as follows: “The mark consists of a gold pyramid formed by several different-sized rectangles on the left. On the right is the wording ‘EL DORADO CANTINA’ in white lettering. A gold line underlines the pyramid and wording. Below the underline is the wording ‘RESTAURANT & BAR’ in white lettering.” “CANTINA RESTAURANT & BAR” is disclaimed.

<sup>3</sup> The mark is described as follows: “The mark consists of the stylized wording ‘EL DORADO EXPRESS STREET TACOS’ inside a rectangle with a semicircle extending from the top. A pyramid formed by several rectangles is inside the semicircle. The rectangle design is superimposed across an inverted triangle with symmetrical horizontal lines across it.” Color is not claimed as a feature of the mark. “EXPRESS” and “STREET TACOS” are disclaimed.

<sup>4</sup> The mark is described as follows: “The mark consists of the stylized wording ‘EL DORADO CASITAS ROYALE’ with a stylized representation of a palm tree within a circle positioned above the word ‘DORADO.’” Color is not claimed as a feature of the mark. The English translation of “CASITAS ROYALE” in the mark is “little house royal.”

<u>Owner</u>	<u>Reg. No.</u>	<u>Issued</u>	<u>Mark</u>	<u>Services</u>
	5653946 <sup>5</sup>	Jan. 15, 2019		Hotel and resort hotel services; travel agency services, namely, making reservations and bookings for temporary lodging.
	5653947 <sup>6</sup>	Jan. 15, 2019		Hotel and resort hotel services; travel agency services, namely, making reservations and bookings for temporary lodging.
	5653948 <sup>7</sup>	Jan. 15, 2019		Hotel and resort hotel services; travel agency services, namely, making reservations and bookings for temporary lodging.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for

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<sup>5</sup> The mark is described as follows: “The mark consists of the stylized wording ‘EL DORADO MAROMA’ with a stylized representation of a palm tree within a circle positioned above the word ‘DORADO.’” Color is not claimed as a feature of the mark. The English translation of “MAROMA” in the mark is “rope.”

<sup>6</sup> The mark is described as follows: “The mark consists of the stylized wording ‘EL DORADO SEASIDE SUITES’ with a stylized representation of a palm tree within a circle positioned above the word ‘DORADO.’” Color is not claimed as a feature of the mark. “SEASIDE SUITES” is disclaimed.

<sup>7</sup> The mark is described as follows: “The mark consists of the stylized wording ‘EL DORADO ROYALE’ with a stylized representation of a palm tree within a circle positioned above the word ‘DORADO.’” Color is not claimed as a feature of the mark. The English translation of “ROYALE” in the mark is “royal.”

reconsideration, the appeal was resumed. The appeal has been fully briefed. We reverse the refusal to register.<sup>8</sup>

### **I. Likelihood of Confusion**

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). There is no mechanical test for determining likelihood of confusion and “each case must be decided on its own facts.” *DuPont*, 177 USPQ at 567.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for

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<sup>8</sup> In reaching our decision, we note that the six exhibits attached to Applicant’s Brief are duplicates of material in the record, and it was thus unnecessary for Applicant to attach copies to its brief. Papers that are already in the application file should not, as a matter of course, be resubmitted as exhibits to the brief. *In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015); *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching exhibits to brief of material already of record only adds to the bulk of the file, and requires Board to determine whether attachments has been properly made of record); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 1203.01, 1203.02(e) (2021).

which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (citation omitted).

**A. The Similarity or Dissimilarity of the Marks.**

With respect to the first *DuPont* factor, inasmuch as the first, and dominant, term in Applicant’s mark is “ELDORADO” and the first, and dominant, term in the six cited marks is the literal term “EL DORADO,” the marks overall are similar in sound, appearance, connotation, and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”). We make this finding even though the six cited marks incorporate a design element in each mark. *See In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999) (when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods; therefore, the word portion is normally accorded greater weight in determining whether marks are confusingly similar). In addition, the removal of the space in the literal term “EL DORADO” to create “ELDORADO” does not form a different, recognizable word. *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009) (“the spaces that respondent places between the words do not create a distinct commercial impression from petitioner’s presentation of his mark as one word” (comparing DESIGNED TO SELL with DESIGNED2SELL)). And although “there is

no correct pronunciation of a trademark,” *Viterra Inc.*, 101 USPQ2d at 1912, Applicant’s “ELDORADO” and “EL DORADO,” as shown in the cited marks, sound the same when verbalized. *See Stockpot, Inc. v. Stock Pot Rest., Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff’d*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir 1984) (marks STOCKPOT and STOCK POT are phonetically identical and visually almost identical).

As to “RESORT CASINO RENO,” although these disclaimed terms may technically differentiate Applicant’s mark from the cited marks, we find that the descriptive nature of these terms do not obviate any likelihood of confusion between Applicant’s mark and the marks in the cited registrations. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) and J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:45 (5th ed. 2021) (“The fact that in a registration, certain descriptive or generic terms are disclaimed indicates that those terms are less significant and the other parts of the mark are the dominant parts that will impact most strongly on the ordinary buyer.”)); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 1207.01(b)(viii) (Oct. 2018). And, due to the descriptiveness of “RESORT CASINO RENO,” those words are unlikely to change the overall commercial impression engendered by the marks. *See Detroit Athletic*, 128 USPQ2d at 1049-50 (citation omitted); *cf.* MCCARTHY ON TRADEMARKS § 23:50 (merely adding “a generic, descriptive or highly suggestive term ... is generally not sufficient to avoid

confusion”). For the same reasons, we find that the disclaimed matter in the cited marks does not obviate any similarity between Applicant’s mark and any of the cited marks.

We also “must compare the marks as they appear in the drawings, and not on any [actual use] that may have additional wording or information.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018). Since Applicant’s mark is in standard characters, Applicant is not limited to the manner in which it may display its mark. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). Applicant could display its mark in a stylization and color scheme similar to the literal portions of the cited marks, “because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.” *Aquitaine Wine USA*, 126 USPQ2d at 1186 (citation omitted).

Furthermore, when evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services. *Id.* at 1184 (citing *Viterra Inc.*, 101 USPQ2d at 1908); TMEP § 1207.01(c)(ii). So even though we evaluate the similarities between Applicant’s mark and the cited marks by considering them in their entirety, we consider the word portions of the marks to be the dominant features, and accord greater weight to such portions, even if some words have been

disclaimed. *See Viterra Inc.*, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

While we do not discount the effect of the design elements in each of the cited marks, they are, individually, insufficient to overcome the strong similarity engendered by the dominant element “ELDORADO” in Applicant’s mark, and the dominant literal element “EL DORADO” found in each of the cited marks. The design elements in the cited marks do not obviate the similarities between Applicant’s mark and the cited marks. Nor do they create distinct commercial impressions, since those designs are paired with the literal term “EL DORADO” — appearing first, and rather prominently, in each of the cited marks — which is virtually identical to “ELDORADO,” the first term in Applicant’s mark. The first *DuPont* factor supports a finding of a likelihood of confusion.

**B. The Similarity or Dissimilarity of the Services and Trade Channels.**

As to the second *DuPont* factor, the similarity or dissimilarity and nature of the goods or services as described in an application or registration, and the third *DuPont* factor, the similarity or dissimilarity of established, likely-to-continue trade channels, where, as here, the services are identical or in-part identical, relatedness of the services is established. *See DuPont*, 177 USPQ at 567 (discussing second and third factors); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (“[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of [services] within a particular class in the application.”). Moreover, we presume that the channels of trade and classes of





purchasers for those services are the same: here, ordinary consumers of bar, hotel, restaurant, and resort hotel services. *See In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where the goods are legally identical, the channels of trade and classes of purchasers are considered to be the same); *see also In re Solid State Design Inc.*, 125 USPQ2d 1409, 1414 (TTAB 2018) (“Because we must deem the goods to be legally identical in-part, we are obligated to assume that their channels of trade are legally identical as well, even in the absence of record evidence.”). The second and third *DuPont* factors also support a finding of a likelihood of confusion.

**C. The Thirteenth *DuPont* Factor and Applicant’s Two Prior Registrations.**

Typically, similarity among the marks and similarity of the services would suffice to support a finding of a likelihood of confusion. However, in some instances, a single additional *DuPont* factor is pivotal and outweighs these two key factors. Such is the case here.

The thirteenth *DuPont* factor examines “any other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. Rarely invoked, the thirteenth factor is intended to accommodate “the need for flexibility in assessing each unique set of facts.” *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012). Cases involving prior registrations under the thirteenth factor customarily determine whether substantially similar marks should be allowed to coexist on the register because of an applicant’s prior registration of a similar mark for the involved goods or services. *See, e.g., In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790

(TTAB 2017) (finding composite mark USA WARRIORS ICE HOCKEY NONE TOUGHER likely to cause confusion with composite mark USA HOCKEY despite applicant's prior registration of composite mark USA WARRIORS ICE HOCKEY NONE TOUGHER); *Strategic Partners*, 102 USPQ2d at 1400 (finding that coexistence of applicant's prior registration of the mark ANYWEARS with third-party

cited mark  for more than five years made confusion between the applicant's mark  and the cited mark unlikely).

Applicant argues that it owns registrations for the marks ELDORADO HOTEL CASINO RENO<sup>9</sup> in standard characters for “cabaret shows and hotel and restaurant



services,” and <sup>10</sup> for “hotel and restaurant services,” and since these registrations pre-date the registration dates of the EL DORADO-formative marks cited by the Office, this is the type of “unusual situation”

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<sup>9</sup> Reg. No. 2263306, registered July 20, 1999, renewed Aug. 15, 2009. The words HOTEL CASINO RENO are disclaimed. This registration also covers services in class 41, but those services are not at issue here.

<sup>10</sup> Reg. No. 2372823, registered Aug. 1, 2000, renewed on July 31, 2010 and on Jan. 30, 2021. The words HOTEL CASINO RENO are disclaimed. This registration also covers services in class 41, but those services are not at issue here.

contemplated by *Strategic Partners*.<sup>11</sup> To counter Applicant's argument, the Examining Attorney asserts that reliance on *Strategic Partners* is misplaced because Applicant's prior registrations have not coexisted on the Principal Register with the cited registrations for at least five years.<sup>12</sup> In reply, Applicant asserts that its prior registered marks and the cited marks did coexist in the marketplace for over five years, so even if the cited marks were not registered until 2018 and 2019, they were used in commerce since 2008 and 2013; and that our rationale in *In re Daboub and Giner*, Ser. No. 87351674, 2018 WL 4203365 (TTAB Aug. 28, 2018), a non-precedential opinion that reversed a refusal to register under Section 2(d) based on application of the thirteenth *DuPont* factor, should apply here.<sup>13</sup>

First, we note that Applicant failed to make of record documents which show the current status and title of its two prior registrations. *See* TBMP § 1208.02 (for registrations that are not the subject of the appeal, a copy from either the electronic records of the USPTO or the paper USPTO record must be submitted); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations in brief insufficient to make them of record). However, since the Examining Attorney did not object to Applicant's

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<sup>11</sup> 6 TTABVUE 11.

<sup>12</sup> 8 TTABVUE 13.

<sup>13</sup> 6 TTABVUE 11-12. A decision designated as not precedential is not binding on the Board, but may be cited for whatever persuasive value it might have. *In re Soc'y of Health & Physical Educators*, 127 USPQ2d 1584, 1587 n.7 (TTAB 2018); TBMP §§ 101.03, 1203.02(f); TMEP § 705.05.

reliance on its prior registrations, we consider Applicant's arguments under the thirteenth *DuPont* factor based on those registrations.

When determining whether the coexistence of an applicant's prior registration with another party's registration weighs against citing the latter registration in a Section 2(d) refusal of the applicant's mark, the examining attorney should consider: (1) whether the applicant's prior registered mark is the same as applicant's mark or is otherwise not meaningfully different; (2) whether the identifications of goods or services in the application and the applicant's prior registration are identical or identical in relevant part; and (3) the length of time the applicant's prior registration has coexisted with the registration being considered as the basis for the Section 2(d) refusal. *Strategic Partners*, 102 USPQ2d at 1400; TMEP § 1207.01. The duration of coexistence is not dispositive as to whether a Section 2(d) refusal should issue; instead, this factor should be considered together with all the other relevant *DuPont* factors. *See id.*; *cf. In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1748 (TTAB 2018) (finding that applicant's earlier registration of a partially similar mark was a neutral factor in the Section 2(d) analysis, because the mark in the application was more similar to the cited registered mark than applicant's previously registered mark); *USA Warriors Ice Hockey Program*, 122 USPQ2d at 1793 (distinguishing *Strategic Partners* and finding that the three and-a-half year coexistence of applicant's prior registration and the cited registration was a relevant consideration but did not cause the thirteenth factor to outweigh the other relevant *DuPont* factors).

In *Strategic Partners*, the Board reversed a refusal to register the mark

ANYWEAR

for “footwear,” finding no likelihood of confusion with the registered



mark,

for “jackets, shirts, pants, stretch T-tops

and stoles.” Given the similarity in the marks and the relatedness of the goods, the

Board stated that it would conclude that confusion is likely to occur “under usual

circumstances.” 102 USPQ2d at 1399. An “unusual situation” existed in *Strategic*

*Partners*, however, compelling the Board “to balance the similarities between the

marks and goods against the facts that applicant already owns a registration for a

substantially similar mark for the identical goods, and that applicant’s registration

and the cited registration have coexisted for over five years.” *Id.* Applicant’s prior

registration of ANYWEARS (in standard characters) for goods including footwear was

found substantially similar to applicant’s ANYWEAR for the same goods, and the

prior registration had achieved incontestable status. *Id.* Basing its decision on the

thirteenth *DuPont* factor, the Board determined that this factor outweighed the

others and confusion was unlikely. *Id.* at 1399-1400 (quoting *DuPont*, 177 USPQ at

567).

In *Daboub*, the Board reversed a Section 2(d) refusal of the mark LA CHULA & Design (shown below)



for “preserved, frozen, dried, and cooked fruits,” finding no likelihood of confusion with the registered mark, CHULA BRAND (“brand” disclaimed), for “fresh fruits and vegetables, namely, citrus, lemons, avocados, coconuts, papayas, pineapples.” Because applicant’s mark and the cited mark shared “the dominant, arbitrary” term, CHULA, the Board held that the marks overall were similar in sound, appearance, connotation, and commercial impression, despite the different Spanish language translations of the marks. 8 TTABVUE 4 (Ser. No. 87351674). In addition, third-party website evidence showed both applicant’s and registrant’s products were sold under the same mark. *Id.* at 4-5. Critical to the Board’s reversal was the applicant’s ownership of a more than ten-year-old registration (without a color claim), shown below, for “fruit conserves,” which was legally identical to the mark for which the applicant was seeking registration.




The examining attorney in *Daboub* attempted to distinguish *Strategic Partners*, emphasizing that in that case, the cited registration and the applicant's prior registration "were immune from a petition to cancel based on the ground of likelihood of confusion" inasmuch as both registrations had coexisted for more than five years. *Id.* at 7. The Board, however, rejected such a narrow interpretation of *Strategic Partners*, reasoning that it was not fatal that the cited registration was not over five years old. *Id.* at 8. In support of the reversal, the Board reasoned:

[U]nder the unusual circumstances here, where the Applicants own a prior registration for essentially the same mark covering highly related, if not almost identical goods, and that prior registration cannot be challenged under Section 2(d), we must consider this in our likelihood of confusion analysis. Thus, even though the first and second *DuPont* factors weigh in favor of finding a likelihood of confusion, we find that the thirteenth factor outweighs them all, making confusion unlikely.


*Id.*

Here, unlike in *Strategic Partners* and *Daboub*, two of the cited marks have coexisted with Applicant's prior registrations for three years, and four of the cited marks have coexisted with Applicant's prior registrations for two years. We

emphasize, however, that a holistic review of the record and our case law require us to base our decision and rationale on more than just the length of time the cited marks, post-registration, have coexisted with Applicant's prior registrations. The applicant's mark and the mark in the prior registration in *Daboub* were essentially

identical; in *Strategic Partners*, the applicant's mark  was substantially similar to the mark in its prior registration, ANYWEARS. In this case, Applicant's standard character mark, ELDORADO RESORT CASINO RENO, and the mark in its prior standard character registration, ELDORADO HOTEL CASINO RENO, both for "hotel and restaurant services," differ only by the disclaimed terms "RESORT" and "HOTEL." And Applicant's standard character mark, ELDORADO RESORT CASINO RENO, does not differ meaningfully from the literal portion of the



mark in Applicant's prior registration, , for identical "hotel and restaurant services," since consumers are generally more inclined to focus on and remember the word portion of a composite mark. *Aquitaine Wine USA*, 126 USPQ2d at 1184 (citation omitted); *see also Palm Bay Imps.*, 73 USPQ2d at 1692 (consumers are generally more inclined to focus on the first word of a mark).

We acknowledge that prior decisions and actions of other trademark examining attorneys are not binding on the USPTO or the Board. *See In re Davey Prods. Pty. Ltd.*, 92 USPQ 2d 1198, 1206 (TTAB 2009); *USA Warriors Ice Hockey Program*,



122 USPQ2d at 1793 & n.10. The Board's non-precedential decisions are not binding either. *See Soc'y of Health & Physical Educators*, 127 USPQ2d at 1587 n.7. Notwithstanding the Office's allowance of the six cited registrations over Applicant's two prior registrations, we do not hold that we are bound by decisions, made by the involved examining attorneys, that there was no likelihood of confusion between the cited EL DORADO-formative marks and the standard character mark in Applicant's prior ELDORADO RESORT CASINO RENO registration, or between the cited EL DORADO-formative marks and the mark in Applicant's prior



registration. Instead, we conclude that under the particular circumstances of this case, where: (1) Applicant owns two prior registrations for substantially similar marks covering identical or legally identical services to those in the involved application; and (2) not one of the examining attorneys who examined the cited registrations refused registration of those marks based on a likelihood of confusion with the marks in applicant's prior registrations, we give the fact that no likelihood of confusion was found in six separate situations due weight in our analysis as support for our ultimate conclusion, based on all of the *DuPont* factors, that, as in *Strategic Partners*, confusion is unlikely. Moreover, Applicant's two prior marks have been registered since 1999 and 2000, so those registrations cannot be challenged based on likelihood of confusion. Thus, although the first, second, and third *DuPont*

factors weigh in favor of finding a likelihood of confusion, we find, as in *Strategic Partners*, that the thirteenth factor tips the scale and outweighs them all, making confusion unlikely under the specific facts of this case.

## **II. Conclusion**

After considering all of the evidence and arguments, even if not specifically discussed herein, we find that despite the similarity of the marks in sound, appearance, connotation, and commercial impression; the legal identity of the services; and the consequent legally identical channels of trade, confusion is not likely. The fact that between 2018 and 2019, the Office permitted the six EL DORADO-formative cited registrations to issue over Applicant's prior 22- and 21- year-old registrations for substantially similar marks and identical services, buttresses our ultimate conclusion that there is no likelihood of confusion between Applicant's ELDORADO RESORT CASINO RENO mark and the marks in the six cited registrations.

**Decision:** The Section 2(d) refusal to register Applicant's mark is reversed.