

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 18, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re FWREF II Rochester, LLC

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Serial No. 97343258

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Matthew A. Williams and Mrinalini R. Jayashankar, of Wyatt, Tarrant & Combs,
LLP, for FWREF II Rochester, LLC.

Gabrielle Rennie, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

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Before English, Lebow, and Elgin,
Administrative Trademark Judges.

Opinion by Elgin, Administrative Trademark Judge:¹

¹ As part of an internal Board pilot citation program on possibly broadening acceptable forms of legal citation in Board cases, this opinion varies from the citation form recommended in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2023). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion employs citation to the LEXIS database. Until further notice, practitioners should continue to adhere to the practice set forth in TBMP § 101.03.

Citations to the prosecution record refer to the downloadable .pdf version of the Trademark Status and Document Retrieval (TSDR) system. *See In re Integra Biosciences Corp.*, 2022 TTAB LEXIS 17, at *6 (TTAB 2022). Citations to the briefs in the appeal record refer to the Board's TTABVUE docket system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 TTAB LEXIS 199, at *4 n.1 (TTAB 2020).

FWREF II Rochester, LLC (“Applicant”) seeks registration on the Principal Register of the mark ROYAL PARK HOTEL (in standard characters, “hotel” disclaimed) for the following services:

Providing exercise facilities; recreational services in the nature of providing walking, hiking, and nature appreciation trails; special event planning services for entertainment purposes; providing facilities for educational conventions; organizing and arranging meetings and seminars in the fields of marketing and sales promotions; arranging for ticket reservations for shows and other entertainment events; entertainment services, namely, wine tastings; entertainment services in the nature of organizing social entertainment events; arranging, organizing, conducting, and hosting social entertainment events; lending library services, in International Class 41; and

Hotel accomodation [sic] services; providing and arranging hotel accommodations; resort hotel accomodation [sic] services; health resort services, namely providing food and lodging that specialize in promoting patrons’ general health and well-being; restaurant and bar services; catering services; provision of conference, exhibition and meeting facilities; providing banquet and social function facilities for special occasions; making restaurant reservations for others; hotel accommodation, restaurant, bar, and catering services; rental of banquet and social function facilities for special occasions, namely wedding receptions, social receptions, civic functions, in International Class 43.²

The Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that, as applied to the services identified in the application, it so resembles the five Principal Register

² Application Serial No. 97343258 was filed on April 1, 2022, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s allegation of first use and first use in commerce as early as September 30, 2004.

marks below, all owned by the same entity, as to be likely to cause confusion, to cause mistake, or to deceive:

PARK ROYAL in standard characters for “Travel club services; travel agency services, namely, arranging and booking air, ground and sea transportation, arranging and booking cruises, arranging and booking lodging; arranging travel tours,” in International Class 39;³

and the composite marks depicted below:⁴



all for “Travel club services; travel agency services, namely, arranging and booking air, ground and sea transportation, arranging and booking cruises; arranging of transportation for travel tours,” in International Class 39; and

³ Reg. No. 3146797 issued Sept. 19, 2006 under Trademark Section 1(a); renewed.

⁴ PARK ROYAL CITY & design, Reg. No. 5973880, issued Jan. 28, 2020 under Trademark Section 1(a). “City” is disclaimed. The mark is described as “a blue arch over the words ‘PARK ROYAL’ in grey over the word ‘CITY’ in grey.”

PARK ROYAL HOMESTAY & design, Reg. No. 5962817, issued Jan. 14, 2020. “Homestay” is disclaimed. The mark is described as “an arch that changes from green to gold over the words ‘PARK ROYAL’ in grey over the word ‘HOMESTAY’ in grey.”

PARK ROYAL HOTELS & RESORTS & design, Reg. No. 5968660, issued Jan. 21, 2020 under Trademark Section 1(a). “Hotels & Resorts” is disclaimed. The mark is described as “an arch that changes from dark purple to lighter purple over the words ‘PARK ROYAL’ in grey over the word ‘HOTELS & RESORTS’ in grey.”

PARK ROYAL BEACH RESORTS & design, Reg. No. 5968661, issued Jan. 21, 2020 under Trademark Section 1(a). “Beach Resorts” is disclaimed. The mark is described as “an arch that changes from red to orange over the words ‘PARK ROYAL’ in grey over the word ‘BEACH RESORTS’ in grey.”

“Restaurant services; Providing online reservations and bookings for temporary lodging and accommodations; Travel agency services, namely, making reservations and booking for temporary lodging,” in International Class 43.

When the refusal was made final,⁵ Applicant requested reconsideration, which was denied.⁶ Applicant then filed an appeal and requested reconsideration a second time,⁷ and that request was denied.⁸ The appeal was resumed and is now fully briefed.⁹

For the reasons set forth below, we affirm the refusal to register on the basis of



likelihood of confusion with the mark

in Registration No. 5968660.

I. The Record on Appeal

The Examining Attorney made of record pages from the USPTO’s TSDR database regarding the cited registrations;¹⁰ screenshots of third-party Internet webpages;¹¹ records of third-party registrations;¹² and dictionary definitions for the terms “park”

⁵ May 19, 2023 Final Office Action.

⁶ June 14, 2023 Request for Reconsideration; July 14, 2023 Denial of Request for Reconsideration.

⁷ August 10, 2023 Second Request for Reconsideration.

⁸ August 31, 2023 Denial of Second Request for Reconsideration.

⁹ Applicant’s Brief and Reply Brief are at 6 TTABVUE and 9 TTABVUE. The Examining Attorney’s Brief is at 8 TTABVUE.

¹⁰ January 19, 2023 Office Action at TSDR 9-19.

¹¹ *Id.* at TSDR 21-77; May 19, 2023 Final Office Action at TSDR 31-87, 108-29; July 14, 2023 Denial of Request for Reconsideration at TSDR 6-23; August 31, 2023 Denial of Second Request for Reconsideration at 6-23 (these appear to be duplicates of the materials attached to the July 14, 2023 denial).

¹² May 19, 2023 Final Office Action at TSDR 88-129.

and “royal.”¹³ Applicant made of record the TSDR record of Applicant’s cancelled Registration No. 3095714 for ROYAL PARK HOTEL (the “Prior Registration”).¹⁴

II. Preliminary Issue

Before proceeding to the merits of the refusals, we address an evidentiary matter. Applicant included in its Appeal Brief a hyperlink to a dictionary definition of “natural language” and a hyperlink to the website grammarly.com.¹⁵ The Examining Attorney objected to these links as they were not previously made of record and no printouts from the underlying webpages were submitted.¹⁶

Under Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), the record in an application should be complete before the filing of an appeal. *See also In re tapio GmbH*, 2020 TTAB LEXIS 483, at *8 (TTAB 2020). Moreover, providing a hyperlink to Internet materials is insufficient to make such materials of record. *In re ADCO Indus. – Techs., L.P.*, 2020 TTAB LEXIS 7, at *4 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record) (citations omitted); *In re Aquitaine Wine USA, LLC*, 2018 TTAB LEXIS 108, at *27 n.21 (TTAB 2018) (Board does not consider websites for which only links are provided); *see also* TBMP § 1208.03.

¹³ *Id.* at TSDR 20-30.

¹⁴ June 14, 2023 Request for Reconsideration, at TSDR 32-35. Applicant also attached duplicative TSDR records of the Prior Registration and cited registrations to its Brief, *see* 6 TTABVUE 17-38, which was improper and unnecessary.

¹⁵ *See* Applicant’s Brief, 6 TTABVUE 12-13, nn. 1 (definition for “natural language” at dictionary.cambridge.org/us/dictionary/English/natural-language) and 2 (grammarly.com regarding adjective and verb placement).

¹⁶ Examining Attorney’s Brief, 8 TTABVUE 3-4.

Nonetheless, the Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format, to the extent they are useful, and thus we have considered the proffered dictionary evidence of “natural language” for whatever probative value it has. *In re Cordua Rests. LP*, 2014 TTAB LEXIS 94, at *6 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594 (Fed. Cir. 2016); *see also B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 728 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”).

The Board, however, does not have access to the grammarly.com website, nor do we find evidence of language structure to be useful in this case. Accordingly, we have not utilized the hyperlink to grammarly.com and give no consideration to arguments based on evidence purportedly found at the hyperlink.

III. Likelihood of Confusion

“The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 1379 (Fed. Cir. 2023) (cleaned up). Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). *See Charger Ventures*, 64 F.4th at 1379.

We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). “In any likelihood

of confusion analysis, two key considerations are the similarities between the marks and the similarities between the [goods or] services.” *Monster Energy Co. v. Lo*, 2023 TTAB LEXIS 14, at *18 (TTAB 2023) (citing *Federated Foods, Inc. v. Ft. Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976)).

For purposes of our *DuPont* analysis, we focus on the composite mark



in Registration No. 5968660 because this mark and the identified services are most similar to Applicant’s mark and services. If we find a likelihood of confusion as to this mark and the associated services, we need not find it as to the other cited marks. Conversely, if we do not find a likelihood of confusion as to these marks, we would not find it as to the other cited marks. *See In re Max Cap. Grp.*, 2010 TTAB LEXIS 1, at *5 (TTAB 2010).

A. Similarity or Dissimilarity of the Services, Trade Channels, and Class of Consumers

“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of [services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s [services], the particular channels of trade or the class of purchasers to which the sales of [services] are directed.” *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990); *see also Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014). We group these *DuPont* factors together because of the shared focus on the identifications of the services.

The goods and services need not be identical or even competitive to support a finding that confusion is likely. *See On-line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1086 (Fed. Cir. 2000) (“[A]lthough the services are different, it is reasonable to believe that the general public would likely assume that the origin of the services are the same.”) (citing *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000)). The services need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods or] services emanate from the same source.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 2007 TTAB LEXIS 58, at *28-29 (TTAB 2007)).

In a multiple-class application such as is presented here, each class stands on its own as it would if it were in a separate application. *See In re Bonni Keller Collections, Ltd.*, 1987 TTAB LEXIS 12, at *5 (TTAB 1987) (each class in a multiple-class application is a separate application that is combined for the convenience of the applicant and the Office). Accordingly, we must make determinations for each separate class. We need not find similarity as to each service listed in each class in the application. It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of services in a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981); *In re St. Julian Wine Co.*, 2020 TTAB LEXIS 196, at *10 (TTAB 2020) (citation omitted); *In re i.am.symbolic, llc*, 2015 TTAB LEXIS 369, at *8 (TTAB 2015), *aff’d*, 866 F.3d 1315 (Fed. Cir. 2017).

Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods or services are used together or used by the same purchasers; advertisements showing that the relevant goods or services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration. *In re Country Oven, Inc.*, 2019 TTAB LEXIS 381, at *9-10 (TTAB 2019).

1. Applicant's Class 41 Services

As a reminder, Applicant's Class 41 services are:

Providing exercise facilities; recreational services in the nature of providing walking, hiking, and nature appreciation trails; special event planning services for entertainment purposes; providing facilities for educational conventions; organizing and arranging meetings and seminars in the fields of marketing and sales promotions; arranging for ticket reservations for shows and other entertainment events; entertainment services, namely, wine tastings; entertainment services in the nature of organizing social entertainment events; arranging, organizing, conducting, and hosting social entertainment events; lending library services.

The Examining Attorney provided evidence to demonstrate that "hospitality companies commonly provide facilities for conventions, special event planning services, recreational planning services, and/or wine tasting (as listed in the subject application) along with restaurant services" (as listed in the cited registration), and that such services travel in the same channels of trade and are purchased by the same

class of consumers.¹⁷ We focus on the services “entertainment services, namely, wine tastings” in the subject application, as the majority of evidence concerns this service.

The Examining Attorney made of record ten use-based registrations by ten third parties that include both restaurant and wine tasting services.¹⁸ Third-party registrations based on use in commerce that individually cover a number of different goods or services may have probative value to the extent that they serve to suggest that the listed goods or services are of a type that may emanate from the same source. *See, e.g., Country Oven, Inc.*, 2019 TTAB LEXIS 381, at *9-10; *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 2013 TTAB LEXIS 314, at *27-28 (TTAB 2013).

The registration evidence is supplemented by website evidence of three additional third parties which offer both restaurant and wine tasting services.¹⁹ *E.g., Charger Ventures*, 64 F.4th, at 1382 (“Because the record shows that companies are known to offer both residential and commercial [real estate] services under the same mark and, often, on the same website, we find that substantial evidence supports the Board’s finding on [the second and third *DuPont*] factors.”); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) (evidence that “a single company

¹⁷ Examining Attorney’s Brief, 8 TTABVUE 7-8.

¹⁸ May 19, 2023 Final Office Act at TSDR 88-97 (Montaluce Estate & Winery, LLC; Chenault Vineyards, LLC; The Culinary Institute of America; Pacific Hospitality Group Ventures, Inc.; Silver Sun Partners, LLC; JUSTIN Vineyards & Winery LLC; FREIXENET, S.A.; Terravant Wine Company, LLC; Opus One Winery LLC; and Wollersheim Winery, Inc.).

¹⁹ *Id.* at TSDR 108-29 (Tenuta Torciano Estate; The Inn at Opolo; and The Wine Room). We note that the Examining Attorney failed to indicate language on specific third-party website evidence which she contends supports the relationship of specific services in the respective identifications, and instead grouped and summarized the evidence and identifications in vague terms. *See generally* Examining Attorney’s Brief, 8 TTABVUE 6-7. We have done our best to understand the arguments and purportedly supporting evidence.

sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”). Together, the ten registrations and three third-party websites demonstrate that restaurant and wine tasting services are closely related.²⁰

Moreover, because there are no limitations as to channels of trade or target purchasers in the cited registration or the subject application, it is presumed that the respective services would move in all normal channels of trade, and that they are available to all usual purchasers for these services. *In re FCA US LLC*, 2018 TTAB LEXIS 116, at *12 (TTAB 2018) (“where an application contains no such restrictions, examining attorneys and the Board must read the application to cover all goods of the type identified, to be marketed through all normal trade channels, and to be offered to all normal customers therefor.”). Here, the third-party evidence shows that the same consumers regularly purchase both wine tasting and restaurant services in the same location. Thus, the second and third *DuPont* factors weigh in favor of likelihood of confusion with respect to Applicant’s Class 41 services.

2. Applicant’s Class 43 Services

Applicant’s Class 43 services are:

Hotel accomodation [sic] services; providing and arranging hotel accommodations; resort hotel accomodation [sic] services; health resort services, namely providing food and lodging that specialize in promoting patrons’ general health and well-being; restaurant and bar services; catering services; provision of conference, exhibition and meeting facilities; providing banquet and social function facilities for special occasions; making restaurant reservations for others; hotel accommodation, restaurant, bar, and catering services; rental of banquet and social

²⁰ *Id.* at TSDR 108-29.

function facilities for special occasions, namely wedding receptions, social receptions, civic functions.

The Examining Attorney argues, and we agree, that Applicant's broader "restaurant and bar services" overlaps with Registrant's "restaurant services," and thus the services are legally identical in part.²¹ *In re Medline Indus.*, 2020 TTAB LEXIS 16, at *13 (TTAB 2020) (goods are legally identical in part where "gloves for medical use" and "protective gloves for medical use" encompass "medical examination gloves"); *In re Info. Builders Inc.*, 2020 TTAB LEXIS 20, at *9-11 (TTAB 2020) (finding services legally identical in part where registrant's services encompassed by applicant's services).

Because the services are legally identical in part, and there are no limitations in the respective identifications as to the channels of trade or classes of consumers, we must also presume that the channels of trade and classes of consumers are identical. *Medline Indus.*, 2020 TTAB LEXIS 16, at *13 (citing *In re FabFitFun, Inc.*, 2018 TTAB LEXIS 297, at *6-7 (TTAB 2018)).

Thus, the second and third *DuPont* factors weigh heavily in favor of likelihood of confusion with respect to Applicant's Class 43 services.


B. Similarity or Dissimilarity of the Marks

"Under the first *DuPont* factor, we consider 'the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.'" *Sabhnani v. Mirage Brands, LLC*, 2021 TTAB LEXIS 464, at *33 (TTAB

²¹ Examining Attorney's Brief, 8 TTABVUE 5.

2021) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005)). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quoting *In re Inn at St. John’s, LLC*, 2018 TTAB LEXIS 170, (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019)) (internal quotation omitted).

We do not predicate our analysis on a dissection of the respective marks; we consider them in their entirety. *Stone Lion*, 746 F.3d at 1318; *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (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.”) (citation omitted). Moreover, the proper test regarding similarity “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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018) (quoting *Coach Servs.*, 668 F.3d at 1368 (internal quotation marks and citation omitted)). “Similarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014). Generally speaking, the more similar the services are at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *See e.g., Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992) (“when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”) (citations omitted).

Applicant's mark is ROYAL PARK HOTEL ("hotel" disclaimed) in standard characters. Registrant's mark is  ("hotels and resorts" disclaimed). Applicant devotes most of its argument to this factor, contending that the transposition of the terms "park" and "royal," as well as the addition of terms "& resorts" in the composite mark results in marks that are different in sight, sound, and overall commercial impression.²²

Applicant cites to two recent nonprecedential Board decisions, namely, *In re Truong*, Ser. No. 90612249, 2023 TTAB LEXIS 144 (TTAB 2023), and *In re Laxamentum Techs., LLC*, Ser. No. 90441532 (TTAB 2023).²³ In *Truong*, the Board found that Applicant's mark BEAUTY POPS for its cosmetic kits in the shape of a lollipop conveyed the commercial impression of lollipops, whereas the cited marks POPBEAUTY and POP BEAUTY for goods and services involving cosmetics and skin care preparations shares the same grammatical structure as common adjectival phrases such as "pop culture," "pop music" and "pop art" and therefore is more akin to those terms. In *Laxamentum Techs.*, the Board found that Applicant's mark GAMEGUARDIAN for website services regarding video games connotes a person or thing that "guards, watches over, or protects" a game, whereas the cited GUARDIAN GAMES mark for retail game stores connotes "a brand of retail stores selling multiple

²² Applicant's Brief, 6 TTABVUE 7-13 (bold text appears in italics in original); *see also* Applicant's Reply Brief, 9 TTABVUE 3-6.

²³ This decision does not appear in the LEXIS database, but it is attached to Applicant's Brief, *see* 6 TTABVUE 57-77.

games, or the ‘family’ name of the games.” Applicant argues these cases support the proposition that “two marks containing transposed words would not create a likelihood of confusion, **even when there were overlapping goods and services.**”²⁴

Applicant also argues that the phrase “royal park” creates the connotation of a “regal garden” and the subject mark ROYAL PARK HOTEL “has a connotation of a luxurious hotel venue surrounded by the aforementioned ‘regal garden.’”²⁵ By contrast, Applicant contends the word “royal” in the literal portion of Registrant’s mark, PARK ROYAL HOTELS & RESORTS, intuitively describes “hotel & resorts” and not the word “park,” and implies that Registrant’s “hotel & resorts” are “regal or prestigious in nature.”²⁶

The Examining Attorney counters that the marks have the same dominant terms, “park” and “royal,” in reverse order, and “consumers are likely to confuse two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions.”²⁷ She argues that the nonprecedential cases relied upon by Applicant are distinguishable, because “the Board emphasized in each case that when the marks were viewed in their entirety,

²⁴ Applicant’s Brief, 6 TTABVUE 11-13 (bold text appears in italics in original); *see also* Applicant’s Reply Brief, 9 TTABVUE 4-5. We note also that in *Truong*, the Board found that the goods were legally identical in that they overlapped; in *Laxamentum Techs.*, the Board found only that the services were related.

²⁵ Applicant’s Brief, 6 TTABVUE 12.

²⁶ *Id.* at 13.

²⁷ Examining Attorney’s Brief, 8 TTABVUE 10-11 (citing cases).

they were each more than simple transpositions of virtually the same terms, and created distinguishable commercial impressions.”²⁸

The Examining Attorney also provided definitions of “royal” including the following: “of kingly ancestry,” “of, relating to, or subject to the crown,” and “of superior size, magnitude, or quality,” “of or relating to a sovereign: regal.”²⁹ Definitions of “park” include “a piece of ground in or near a city or town kept for ornament and recreation,” “an area maintained in its natural state as a public property.”³⁰ She argues that “despite the transposition of terms between the marks, [they] create the same overall commercial impression of a recreational piece of ground or enclosed land that is regal or prestigious in nature”³¹



Applicant’s mark ROYAL PARK HOTEL and Registrant’s mark share the terms “park” and “royal,” in reverse order. Both marks share the disclaimed term “hotel” (but for the pluralization in the cited mark).³² In this case, we find that the reversal of the core literal terms in the marks creates strong similarities in connotation and commercial impression. *See Royal Crown Cola Co. v. Bakers*

²⁸ *Id.* at 11-12.

²⁹ May 19, 2023 Final Office Action at TSDR 20, 23.

³⁰ *Id.* at TSDR 25.

³¹ *Id.* at TSDR 12.

³² There is no evidence that consumers for the services at issue herein would notice or accord any import to the “S” appearing at the end of the term HOTEL in Registrant’s mark. *See In re Strategic Partners*, 2012 TTAB LEXIS 80, at *7 (“the difference between the singular form ANYWEAR depicted in the applied-for mark and the plural form ANYWEARS in applicant’s existing registration is not meaningful.”) (citation omitted).


Franchise Corp., 1966 TTAB LEXIS 115, at *5 (TTAB 1966) (“[T]he applicant’s compound mark includes the same words which make up opposer’s mark, that is to say ‘RITE DIET’ is merely ‘DIETRITE’ transposed. The marks of the parties create substantially the same commercial impressions ...”), *aff’d*, 404 F.2d 98 (CCPA 1969); *Made in Nature, LLC v. Pharmavite LLC*, 2022 TTAB LEXIS 228 (TTAB 2022) (NATURE MADE for various foods and beverages, including snack bars containing dried fruits and fruit juice, likely to be confused with MADE IN NATURE for dried fruits and vegetables, snack products, and fresh fruit); *In re Wine Soc’y of Am. Inc.*, 1989 TTAB LEXIS 29 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design likely to be confused with AMERICAN WINE SOCIETY 1967 and design).

This is not a situation, as Applicant advances based on the nonprecedential cases cited above, where reversal of the terms creates a different meaning or commercial impression. PARK ROYAL and ROYAL PARK for both convey the same meaning as applied to the relevant services: that is, a recreation area that is of superior quality. *See e.g., In re Hartz Hotel Servs., Inc.*, 2012 TTAB LEXIS 75, at *5 (TTAB 2012) (considering the dictionary definition of GRAND and finding that “when ‘grand’ is used in connection with ‘hotel,’ the resulting mark GRAND HOTEL indicates an impressive, stately, magnificent or first-rate hotel”). Moreover, there is no evidence of record that supports Applicant’s argument that the relevant public would view the term “royal” as denoting only the diminutive “hotels & resorts” in Registrant’s

composite mark. As noted above, attorney argument is not evidence. *Cai*, 901 F.3d at 1371.

Registrant’s composite mark presents “park royal” in larger font, and much more prominently, than the smaller “hotels and resorts.” The addition of “& resorts” in Registrant’s mark is insufficient to distinguish the marks. Much like the shared term “hotel,” a “resort” is “a place designed to provide recreation, entertainment, and accommodation especially to vacationers : a community or establishment whose purpose or main industry is catering to vacationers.”³³ So the commercial impression is similar to that created by the shared word “hotel” in the marks. In addition, “resorts” (like “hotels”) is generic or highly descriptive of Registrant’s online reservation and booking services for temporary lodging and accommodations, and is entitled to less weight in comparing the similarity of the marks. *Charger Ventures*, 64 F.4th at 1382 (“Disclaimer of a word in an application to register a mark has ‘no legal effect on the issue of likelihood of confusion’ because the public is unaware what words have been disclaimed” so “the Board must consider the mark in its entirety.”) (citations omitted).

The color and “arch” design element in Registrant’s composite mark also are not so distinctive so as to distinguish the marks. “In the case of marks, such as

[], consisting of words and a design, the words are normally accorded

³³ MERRIAM-WEBSTER DICTIONARY (www.merriam-webster.com/dictionary/resort, accessed June 18, 2024). No definitions of “hotel” or “resort” were made of record.

greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *Aquitaine Wine USA*, 2018 TTAB LEXIS 108, at *6 (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012)); *see also Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165 (Fed. Cir. 2002) (“Because the impact of the design in the overall commercial impression is minor when compared with the words, a consumer viewing Herbko’s mark would attach greater significance to the words CROSSWORD COMPANION than to the crossword puzzle design.”). Moreover, Applicant’s mark is displayed in standard character form, and is not limited to any special stylization or colors, so it could be displayed in a font style and grey color similar to Registrant’s cited composite mark. *See* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a) (“Standard character” marks are registered “without claim to any particular font style, size, or color.”); *see also Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display”).

In sum, we find that Applicant’s mark ROYAL PARK HOTEL and the cited mark



are similar in sight, sound, connotation, and overall commercial impression. The first *DuPont* factor favors a finding of likelihood of confusion.

C. Purchasing Conditions and Sophistication of Consumers

The fourth *DuPont* factor considers “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *In re*

Embiid, 2021 TTAB LEXIS 168, at *43 (TTAB 2021) (quoting *DuPont*, 476 F.2d at 1361). Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imps.*, 396 F.3d at 1376 (citing *Recot*, 214 F.3d at 1329).

Applicant contends that “[t]he nature of Applicant’s services increases the degree of care of the purchasing consumer and minimizes the likelihood of confusion. Specifically, consumers tend to research and exercise great care in selecting hotels, event spaces, and meeting rooms before booking, due to the high cost of these services, usually spanning from hundreds to thousands of dollars.”³⁴ Although these assertions (which pertain only to certain of Applicant’s services) may be correct, we have no evidence to support them. Applicant submitted no pricing sheets, testimony or other evidence that we could use to determine if the services are expensive. *Cai v. Diamond Hong, Inc.*, 901 F.3d at 1371 (“Attorney argument is no substitute for evidence.”).

Conversely, the argument and evidence supplied by the Examining Attorney to show that consumers often make mistakes in choosing hotels is not persuasive, as it mostly concerns confusion as to selection of the wrong date when booking a hotel reservation and not the wrong provider.³⁵

The fourth *DuPont* factor looks to the least sophisticated purchaser. *See Stone Lion*, 746 F.3d at 1325 (“Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’”) (internal quotation omitted); *Giersch v.*

³⁴ Applicant’s Brief, 6 TTABVUE 14.

³⁵ *See* Examining Attorney’s Brief at 8-9 (citing August 31, 2023 Second Request for Reconsideration Denial at TSDR 6-23).

Scripps Networks Inc., 2009 TTAB LEXIS 72, at *25-26 (TTAB 2009) (the applicable standard of care is least sophisticated consumer) (citation omitted). Based on the broad services identified in the subject application and cited registration, we cannot make any determinations concerning the likely cost of these services. Neither identification of services in the application nor the cited registration includes any restriction regarding channels of trade, consumer or price; we must therefore presume that the identified services are sold in the ordinary or normal trade channels for such services, to all consumers for such services and without any limitation as to price. *Packard Press*, 227 F.3d at 1361 (“When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade.”). We cannot determine, without evidence, how sophisticated or careful such a purchaser will be. To the extent we can rely on general knowledge, it is known that consumers of various hospitality and travel services recited in the subject application or cited registration may be sophisticated or unsophisticated.

For all these reasons, we treat the fourth *DuPont* factor as neutral.

D. Applicant’s Prior Registration

Finally, we turn to one of Applicant’s principal arguments under the thirteenth *DuPont* factor, which examines “any other established fact probative of the effect of use.” *DuPont*, 476 F.2d at 1361. Rarely invoked, the thirteenth factor is intended to accommodate “the need for flexibility in assessing each unique set of facts.” *See In re Strategic Partners*, 2012 TTAB LEXIS 80, at *6. This includes the coexistence of an

applicant's prior-registered mark with a cited registration: "Where an applicant owns a prior registration and the mark is 'substantially the same' as in the applied-for application, this can weigh against finding that there is a likelihood of confusion." *Country Oven*, 2019 TTAB LEXIS 381, at *19 (citing *in Inn at St. John's*, 2018 TTAB LEXIS 170, at *18).

Applicant argues that its predecessor-in-interest owned the Prior Registration for the identical mark, ROYAL PARK HOTEL ("hotel" disclaimed), now cancelled, for services that are highly similar to the services identified in the subject application.³⁶ Applicant represents, without evidence, that the Prior Registration was not cited in the prosecution of any of the cited registrations.³⁷ Moreover, Applicant contends that the USPTO significantly delayed in issuing an office action on the post-registration filing in the Prior Registration, and a timelier action "could have prevented or limited

³⁶ See Applicant's Brief, 6 TTABVUE 5-6; Applicant's Reply Brief, 9 TTABVUE 2-4. Registration No. 3095714 issued on May 23, 2006 and was cancelled on September 23, 2022. The TSDR record indicates that the registration was assigned to Applicant on July 1, 2022, which assignment was recorded by the Assignment Division of the USPTO on December 13, 2022 at Reel/Frame: 8008/0884. See *id.* at TSDR 31-32.

³⁷ Applicant's Brief, 6 TTABVUE 5; Applicant's Reply Brief, 9 TTABVUE 2-3. Applicant did not submit any of the filings relating to the underlying post-registration actions so that we may understand the bases for any delay, or the file histories of the cited registrations to support Applicant's argument that no office actions were issued in Registrant's underlying applications. The Board does not take judicial notice of records residing within the USPTO. See, e.g., *Flame & Wax, Inc. v. Laguna Candles, LLC*, 2022 TTAB LEXIS 272, at *42-43 n.57 (TTAB 2022) ("The Board's well-established practice is not to take judicial notice of USPTO records"; refusing to take notice of filings in prior applications). The Examining Attorney, however, not only does not dispute these basic facts asserted by Applicant, she also addresses them in her brief. See Examiner's Brief, 8 TTABVUE 14-17. We have, therefore, considered Applicant's arguments based on the alleged file histories. Cf. *In re Litehouse, Inc.*, 2007 TTAB LEXIS 20, at *12 n.2 (TTAB 2007) (third-party registrations submitted with applicant's appeal brief considered because examining attorney did not object in her brief and instead presented arguments in rebuttal of this evidence).

the basis for a Section 2(d) likelihood of confusion refusal . . . [and] from an equitable perspective” favors Applicant.³⁸

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, we 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*, 2012 TTAB LEXIS 80, at *9; *see also* TMEP § 1207.01.

Even if we considered the cancelled Prior Registration, the situation present in *Strategic Partners* is not applicable here. The marks in the subject application and Prior Registration are the same, and the services are identical in part. However, unlike *Strategic Partners*, the cited composite registration (as with the other cited composite registrations) co-existed with the Prior Registration for only two and one half years.³⁹

³⁸ Applicant’s Brief, 6 TTABVUE 6-7.

³⁹ The Prior Registration coexisted with the cited Registration No. 3146797 for the standard character mark PARK ROYAL for more than five years. That registration, however, identified far narrower services than the newer composite registrations; most significantly, it does not include the “restaurant services” we have focused on in this decision. In this way, this case is distinguishable from *In re Allegiance Staffing*, 2015 TTAB LEXIS 180 (TTAB 2015), in which the Board found the coexistence of the applicant’s prior (but expired) registration with eight registrations for nearly the same services, all registered by a single entity over an eleven-year period and allowed by multiple examiners, weighed against finding a likelihood of confusion. *Id.* at *7-9. *Allegiance Staffing* also is distinguishable because,

Furthermore, prior decisions and actions of other trademark examining attorneys in allowing the cited registrations are not binding on the USPTO or the Board. *See In re Int'l Watchman, Inc.*, 2021 TTAB LEXIS 446, *35 (TTAB 2021) (citing *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016)). Trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *Id.* (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (CCPA 1982) and *In re Thunderbird Prods. Corp.*, 406 F.2d 1389 (CCPA 1969)).

Finally, the “equities” do not favor Applicant under the thirteenth *DuPont* factor merely in light of the Office’s delay in acting on the post-registration response. It was incumbent upon Applicant’s predecessor to contact the USPTO when it did not receive a response to a post-registration filing, particularly because the delay in this case was substantial. *See* Trademark Rule 2.23(d), 37 C.F.R. § 2.23(d); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §§ 108.03 and 1705.05 (June 2024) (“A party who has not received a notice or action from the USPTO within [six months] is responsible for checking the matter’s status and requesting corrective action, if necessary.”). Moreover, Applicant – which claims to have owned the Prior Registration by the time it was cancelled – did not file a petition with the Director to challenge the decision to cancel the registration. *See* Trademark Rules 2.146(a)(2) and 2.165, 37 C.F.R. §§ 2.146(a)(2), 2.165.

unlike here, the Board found “differences in the meaning and commercial impression of the marks” and that the relevant consumers exercised a degree of care in purchasing the services. *Id.* at *17-18.


Furthermore, Applicant was not without other remedies against the refusal of its pending application in this case. For example, Applicant could have sought a suspension of the prosecution of its application or this appeal to pursue cancellation of the cited registration(s), if appropriate.⁴⁰ *See* Trademark Rule 2.67, 37 C.F.R. § 2.67 (the Office has the discretion to suspend an action “for a reasonable time for good and sufficient cause”); *see also* TMEP § 716.02. The record does not demonstrate that Applicant sought any suspension or other remedies.

Overall, this is not a case in which “unique factors” outweigh the impact of the other *DuPont* factors on the issue of a likelihood of confusion, particularly because the Examining Attorney’s refusal is justified on the record in this case. The thirteenth *DuPont* factor is neutral.

E. Weighing and Balancing the *DuPont* Factors


We have carefully considered, weighed, and balanced all of the evidence made of record, and the arguments related thereto. *Charger Ventures*, 64 F.4th at 1384 (“[I]t is important . . . that the Board . . . weigh the *DuPont* factors used in its analysis and explain the results of that weighing.”).

Because we have found that Applicant’s mark ROYAL PARK HOTEL and the

composite mark  are similar; Registrant’s “restaurant services” are

⁴⁰ The cited composite registrations, as noted above, have been registered less than five years and are subject to cancellation on all grounds, including likelihood of confusion. The cited standard character registration, having been registered since 2006, is subject to cancellation on limited grounds. *See* Trademark Act Section 14, 15 U.S.C. § 1064.

related to Applicant's "entertainment services, namely, wine tastings" in Class 41 and legally identical in part to Applicant's "restaurant and bar services" in Class 43; the services move in the same or overlapping trade channels and are offered to the same classes of purchasers; and the other factors are neutral, we conclude that

confusion between Applicants' mark and the cited mark  in Registration No. 5968660 is likely.

Decision

The refusal to register Applicant's mark ROYAL PARK HOTEL is **affirmed** on the basis of likelihood of confusion with Registration No. 5968660.⁴¹

⁴¹ In view thereof, we need not address the remaining cited composite marks. *See Max Cap. Grp.*, 2010 TTAB LEXIS 1, at *5.