

This Opinion is Not a
Precedent of the TTAB

Mailed: March 19, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Adrenalin Attractions, LLC
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Serial No. 87419581
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Rob L. Phillips of FisherBroyles, LLP,
for Adrenalin Attractions, LLC.

Hanno Rittner, Trademark Examining Attorney, Law Office 119,
Brett J. Golden, Managing Attorney.

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Before Bergsman, Shaw, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Adrenalin Attractions, LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark MYSTIC MOTEL (MOTEL disclaimed) for “resort hotel services,” in International Class 43.¹

¹ Application Serial No. 87419581 was filed on April 21, 2017 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark shown below



for various services, including "hotel services," in International Class 42,² as to be likely, when used in connection with the services identified in Applicant's application, to cause confusion, to cause mistake, or to deceive.

Applicant appealed after the Examining Attorney made the refusal final. The case is fully briefed. We affirm the refusal to register.

I. Evidentiary Matters

Before proceeding to the merits of the refusal, we address two evidentiary matters. Applicant attached exhibits to its main brief consisting of what it describes as webpages pertaining to a Mystic Hotel in San Francisco, California, a Mystic Dunes Resort & Golf Club in Celebration, Florida, Registrant's Mystic Lake Casino Hotel in Minnesota, and a page from Google Maps regarding the area where Registrant's hotel

² Registration No. 2799696 issued on December 30, 2003 and was last renewed on December 20, 2013. The registrant is the Shakopee Mdewakanton Sioux Community ("Registrant"), which is described in the registration as a federally recognized Indian tribe. July 12, 2017 Office Action at 2. The registration covers services in Classes 35, 39, 41, and 42, but the refusal to register is based solely on the Class 42 hotel services. 6 TTABVUE 2.

is located. 4 TTABVUE 7-8, 10-16.³ Applicant also listed nine registrations in its main brief that it claims are owned by Registrant as part of “a family of Mystic trademarks.” *Id.* at 8.

The Examining Attorney objects in his brief to the attachments and the list of registrations on the ground that they are untimely, and to the list of registrations on the additional ground that merely listing registrations does not make them of record. 6 TTABVUE 3-4. He requests that the Board disregard all of this putative evidence. *Id.* at 4.

In its reply brief, Applicant does not address the list of registrations, but argues that it referred to the websites of the California hotel and the Florida resort and golf club during prosecution, and that “such references were part of the record and should be considered.” 7 TTABVUE 2.

As a general matter, the record in an application should be complete prior to the filing of an appeal. 37 C.F.R. § 2.142(d). With respect to the webpages, Applicant provided links to the websites of the California hotel and the Florida resort and golf club during prosecution, which did not make information or pages from the websites of record.⁴ *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017). The Examining Attorney, however, did not advise Applicant that providing links alone was insufficient, but instead expressly acknowledged in the Final Office Action that

³ These webpages are identified in the body of Applicant’s main brief as Exhibits A-D. 4 TTABVUE 7-8. There is no attachment labelled Exhibit A, but Exhibits B and C, *id.* at 14-15, appear to correspond to what is described in the brief as Exhibits A and B.

⁴ March 1 Petition to Revive Abandoned Application at 7.

Applicant had “provided allegations of evidence of competing hotels, like that of the evidence attached, which show *in the marketplace* that ‘Mystic’ hotels are relatively common.”⁵ If the Examining Attorney had advised Applicant in the Final Office Action that the links were insufficient to make the webpages of record, Applicant could have cured that deficiency on a request for reconsideration. Under the circumstances, we deem the Examining Attorney to have waived any objection to the websites of the California hotel and the Florida resort and golf club attached to Applicant’s main brief. *Cf. In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1587 (TTAB 2018) (“Examining Attorneys have a responsibility to make sure that applicants properly submit Internet evidence . . . [T]he examining attorney must object to the evidence in the first Office Action following the response and advise the applicant as to the proper way to make the Internet evidence of record. Otherwise the Board may consider the objection to have been waived.”). We overrule the Examining Attorney’s objections to these two webpages, and will consider them for whatever probative value they may have.

The webpages from Registrant’s website and from Google Maps are a different matter. They were neither submitted nor mentioned by Applicant during prosecution, and they are untimely when submitted for the first time on appeal. *In re Fiat Grp. Mktg. & Corporate Commc’ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014). We sustain the Examining Attorney’s objection to these webpages.

⁵ April 4, 2018 Final Office Action at 1. The Examining Attorney himself made of record third-party hotel webpages, *id.* at 41-59, including different versions of the webpages of the California hotel. *Id.* at 41-44. We discuss these webpages below.

The same general principles of untimeliness and failure to make evidence properly of record apply to the list of registrations,⁶ but the analysis of the Examining Attorney's objection to the list is complicated by the fact that some of these registrations were brought to the Examining Attorney's attention through the granting of a letter of protest. After the Examining Attorney conducted a search of the records of the Patent and Trademark Office and found no conflicting marks that would bar registration under Section 2(d),⁷ the Office of the Deputy Commissioner for Trademark Examination Policy forwarded a Letter of Protest Memorandum to the Examining Attorney.⁸ The Memorandum advised the Examining Attorney that a letter of protest had been granted, and directed him to "consider the following and make an independent determination whether to issue a requirement or refusal based on the objections raised in the letter of protest,"⁹ specifically, "[p]ossible likelihood of confusion with the registered marks identified by the protestor," which were identified as Registration Nos. 2799696, 2726584, 4878819, 2699711, 2760867, 2998124, and 2111108.¹⁰ The registrations identified in the Memorandum included the cited registration on this appeal and four of the registrations listed in Applicant's main brief. 6 TTABVUE 8.

⁶ Merely listing registrations does not make them of record, *see, e.g., In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012), and Applicant did not refer to any of the registrations during prosecution.

⁷ June 7, 2017 Examiner's Amendment at 1.

⁸ July 11, 2017 Letter of Protest Memorandum.

⁹ *Id.* at 1.

¹⁰ *Id.* at 1.

The Memorandum attached “evidence in the nature of screenshots from an online dictionary,” which were definitions of the words “hotel,” “resort,” and “resort hotel,”¹¹ and stated that “[c]opies of the listed registrations are available in the x-search database.”¹² Under Section 1715.02(b) of the TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) (Oct. 2018), which provides that the “prosecution history of an application will reflect the acceptance of a letter of protest and a memorandum accepting the letter of protest and all relevant evidence will be added to the electronic file record,” the dictionary definitions were automatically made of record via the Memorandum. *See also In re Urbano*, 51 USPQ2d 1776, 1778 n.5. (TTAB 1999).

The Examining Attorney subsequently issued a first Office Action refusing registration under Section 2(d) on the basis of Registration No. 2799696 only, which was the first of the registrations listed in the Memorandum.¹³ We will consider information regarding the four other registrations that were listed in both the Memorandum and in Applicant’s main brief for whatever probative value it may have because the Examining Attorney was required to consider the other four registrations as well as the cited registration. We sustain the Examining Attorney’s objections to the list of registrations except as to the four registrations listed in both the Memorandum and Applicant’s main brief. *Cf. In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2009).

¹¹ July 11, 2017 Letter of Protest Memorandum at 1-10.

¹² *Id.* at 1.

¹³ July 12, 2017 Office Action at 1.

II. Record on Appeal

In addition to the dictionary definitions and the information regarding the four registrations noted above, the record on appeal consists of the following evidence made of record by the Examining Attorney:

1. A Wikipedia entry, articles, and social media pages regarding a Mystic Motel “haunted maze” and “dark theme park ride” developed by Scott D’Avanzo, who is identified in the involved application as Applicant’s Chief Executive Officer, in his family’s garage in southern California;¹⁴
2. Mr. D’Avanzo’s Registration No. 4579186 of the mark MYSTIC MOTEL in standard characters for “entertainment services in the nature of an amusement park attraction;”¹⁵
3. Applicant’s pending Application Serial No. 87673993 to register MYSTIC MOTEL STAY AND SCARE and design for “motel services;”¹⁶
4. Pages from the websites at mysticlake.com and expedia.com regarding the Mystic Lake Casino Hotel operated by Registrant in Prior Lake, Minnesota;¹⁷

¹⁴ April 4, 2018 Final Office Action at 2-11, 16-23. The Wikipedia entry states that the name “Mystic Motel” and the theme of the ride were derived from a motel along US Route 66 that was built in 1955. *Id.* at 3.

¹⁵ *Id.* at 12-13.

¹⁶ *Id.* at 14-15.

¹⁷ *Id.* at 24-40.

5. Pages from the websites at mystichotel.com and tripadvisor.com regarding the Mystic Hotel in San Francisco, California;¹⁸ and
6. Pages from the websites at hilton.com and tripadvisor.com regarding a Hilton Mystic Hotel in Mystic, Connecticut and other hotels in that city.¹⁹

III. Analysis of Likelihood of Confusion Refusal

Section 2(d) of 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, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) 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, 177 USPQ 563, 567 (CCPA 1973). We must consider each *du Pont* factor for which there is evidence and argument. *See, e.g., In re Guild Mtg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *compare 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 which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). Two key factors in every Section 2(d) case are the first and second *du Pont* factors, the similarity or dissimilarity of the marks and the similarity or dissimilarity

¹⁸ April 4, 2018 Final Office Action at 41-52.

¹⁹ *Id.* at 53-59.

of goods or services, respectively, because the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Applicant argues that the relevant *du Pont* factors in this case are the first factor, the fourth factor regarding the conditions under which consumers encounter the marks, the sixth factor regarding the number and nature of similar marks in use, and the twelfth factor regarding the extent of the potential for confusion. 4 TTABVUE 5-6. The Examining Attorney argues that the most relevant factors are the first and second factors, and the third factor regarding the similarity or dissimilarity of the channels of trade. 6 TTABVUE 5. We will begin with the second and third factors, which Applicant does not address in its briefs.

A. Similarity or Dissimilarity of the Services and Channels of Trade

The second *du Pont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *du Pont*, 177 USPQ at 567), while the third *du Pont* factor “considers ‘[t]he similarity or dissimilarity of established, likely-to-continue trade channels.’” *Id.* at 1052 (quoting *du Pont*, 177 USPQ at 567). Our analysis under these factors is based on the identifications of services in the application and the cited registration. *Id.*; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014).

The services identified in the application are “resort hotel services.” The services in the cited registration include “hotel services.” Where services are broadly identified in an application or registration, “we must presume that the services encompass all services of the type identified.” *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015); *see also In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1893 (TTAB 2007). The “hotel services” broadly identified in the cited registration are thus presumed to encompass Applicant’s more narrowly identified “resort hotel services,”²⁰ and the services are deemed to be legally identical. *See Sw. Mgmt.*, 115 USPQ2d at 1025 (“restaurant services” in application encompassed all types of restaurants, including those of concurrent use defendants); *In re Binion*, 93 USPQ2d 1531, 1535 (TTAB 2009) (“restaurant services” included all types of restaurants, including restaurants located within a hotel or casino). The second *du Pont* factor supports a finding of a likelihood of confusion.

With respect to the third *du Pont* factor, “[b]ecause the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018) (citing *In re Viterra, Inc.*, 671 F.3d 1358, 101

²⁰ Registrant describes its hotel on its website as “the premier resort destination in Minnesota.” April 4, 2018 Final Office Action at 27.

USPQ2d 1905, 1908 (Fed. Cir. 2012)). The third *du Pont* factor also supports a finding of a likelihood of confusion.

B. The Similarity or Dissimilarity of the Marks

The first *du Pont* factor is “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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 White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). “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). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).²¹

²¹ Applicant and the Examining Attorney do not specifically identify the “average customer” of hotel services, including resort hotel services. The record shows that hotel services are offered at various price points to consumers seeking temporary lodging for business or pleasure. April 4, 2018 Final Office Action at 39-59. We find that hotel services, including resort hotel services, are used by members of the general public.

“[S]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)). Where, as here, the involved goods or services are identical, “the degree of similarity between the marks necessary to support a determination that confusion is likely declines.” *i.am.symbolic*, 127 USPQ2d at 1630 (citing *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); and *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

Applicant’s mark is MYSTIC MOTEL in standard characters, while Registrant’s mark consists of the word MYSTIC in the stylized lettering displayed below:

The word "Mystic" is written in a bold, black, handwritten-style font. The letters are thick and slightly irregular, with a casual, artistic feel. The 'M' is particularly large and prominent, and the 'i' at the end has a small dot.

The word MYSTIC in Registrant’s mark is entirely subsumed within Applicant’s mark MYSTIC MOTEL, and “[l]ikelihood of confusion often has been found where the entirety of one mark is incorporated within another.” *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2015) (finding PRECISION and PRECISION DISTRIBUTION CONTROL to be confusingly similar). *See also Stone Lion*, 110 USPQ2d at 1160-61; TMEP Section 1207.01(b)(iii) (collecting such cases).

The marks must be considered in their entireties, but “in articulating reasons for reaching a conclusion on the issue of confusion, 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 consideration of the marks in their entireties.” *Detroit Athletic*, 128 USPQ2d at 1051 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)). We will first determine the dominant portions of the marks because Applicant and the Examining Attorney disagree on that issue with respect to the cited mark.

Applicant argues that the “most distinctive element of the Cited mark is not the literal word Msytic [sic] but instead the stylized design,” 4 TTABVUE 6, which Applicant claims “is not simply a font change but a customize[d] design which serves to visually distinguish the Cited Mark from Applicant’s Mark.” *Id.* Applicant argues that this case is similar to *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014), in which the Board compared the applicant’s REDNECK RACEGIRL composite mark shown below:



to the cited standard character mark RACEGIRL, and found “that the overall commercial impression of Applicant’s mark is dominated by its design features, particularly the large double-letter RR configuration,” *id.* at 1169, which made the mark “so different from the registered mark that even when used on in-part identical goods, confusion is unlikely.” *Id.*

The Examining Attorney responds that “registrant’s mark ‘MYSTIC’ is minimally stylized -- in font style only,” 6 TTABVUE 6, and that Applicant’s argument is meritless in any event because Applicant’s mark is a standard character mark that “could be presented in the same manner of display.” *Id.* at 7. We agree with the Examining Attorney on both points.

“In the case of a composite mark containing both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods [or services] to which it is affixed.’” *Viterra*, 101 USPQ2d at 1908 (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)); *see also In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018). “The verbal portion of a word and design mark ‘likely will appear alone when used in text and will be spoken when requested by consumers,’” *id.* (quoting *Viterra*, 101 USPQ2d at 1911), and it “is normally accorded greater weight because it would be used by purchasers to request the goods [or services].” *Id.* (quoting *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008)).

In *Covalinski*, the Board acknowledged the general rule discussed in *Viterra*, but stated that “[w]hile it is often true that the words in a composite word and design mark are considered to be dominant, that is not always the case.” 113 USPQ2d at 1168. The decision displayed examples of several composite marks from previous cases that were found to be exceptions to the general rule. *Id.* at 1168-69.²²

²² *Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 148 USPQ 497 (CCPA 1966) (FERRO-GARD and design for rust preventative oils not confusingly similar to various FERRO-formative marks for industrial compounds); *In re White Rock Distilleries, Inc.*, 97 USPQ2d 1282 (TTAB 2009) (VOLTA in standard characters for caffeine-infused drink not confusingly similar to

We find that the cited mark in this case is not one of those exceptions. We agree with the Examining Attorney that the stylization of the word “Mystic” in the cited mark is minimal, particularly in comparison to the composite marks discussed and displayed in *Covalinski*. Consumers would read and speak the cited mark simply as the word “Mystic” and would use that word to refer to Registrant’s hotel when booking rooms or recommending it to others. The general rule discussed in *Viterra* thus applies here, and we find that the word Mystic is the dominant element of the cited mark.

Applicant does not dispute that the word MYSTIC is also the dominant element of its standard character mark MYSTIC MOTEL. MYSTIC is the first word in the mark and the word MOTEL that follows MYSTIC has little or no source-identifying significance because it is at least highly descriptive of the “resort hotel services” identified in the application, and has been disclaimed.²³ *See, e.g., Detroit Athletic*, 128 USPQ2d at 1049-50 (Board properly focused on the words DETROIT ATHLETIC as the dominant portions of the marks DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB because DETROIT ATHLETIC were the first words in the marks and the words CO. and CLUB were non-source identifying and had been disclaimed).

TERZA VOLTA and design for wine); *Parfums de Couer Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (BODYMAN and design for a television series not confusingly similar to BODMAN and BOD for fragrances); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987) (STEVE’S and design for restaurant services not confusingly similar to STEVE’S for ice cream).

²³ June 7, 2017 Examiner’s Amendment at 1.

We turn now to the comparison of the marks in their entireties, giving greater weight in that comparison to the shared dominant word MYSTIC.

With respect to sound, Applicant does not argue, and there is nothing in the record to suggest, that the shared word MYSTIC would be pronounced differently in each mark. While there are differences in the number of syllables in the marks when they are spoken due to the presence of the word MOTEL in Applicant's mark, the aural identity of the word MYSTIC in the marks makes them similar in sound when considered in their entireties.

As to appearance, as discussed above, the stylization of the cited mark is relatively minor, and the standard character and stylized marks per se are visually similar due to the presence of the shared dominant word MYSTIC, particularly taking into account that "marks 'must be considered . . . in light of the fallibility of memory' and 'not on the basis of side-by-side comparison.'" *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977)). Moreover, as the Examining Attorney correctly argues, Applicant's standard character mark "may be displayed in any lettering style," 6 TTABVUE 6, including "in the same manner of display" as the cited mark. *Id.* at 7. The words MYSTIC MOTEL thus "could be used in any typeface, color, or size, including in the same stylization" as the cited mark. *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015); *see also Aquitaine Wine USA*, 126 USPQ2d at 1186-87. The display of Applicant's mark in the stylized font of the cited mark would make the marks even more similar in appearance.

Finally, with respect to connotation and commercial impression, Applicant argues that “the inclusion of ‘Motel’ in the Applicant’s mark immediately infers a property distinct from a Hotel,” 4 TTABVUE 6, and that “hotels tend to be viewed as higher-end properties while motels tend to be viewed as lower-end properties.” *Id.* at 6-7. According to Applicant, “[w]hile hotels and motels each provide lodging, consumers perceive the terms differently which shall mitigate any consumer confusion.” 7 TTABVUE 2. The Examining Attorney responds that Applicant “fails to explain why that distinction is at all meaningful, where the marks are otherwise identical, and, where ‘motel’ fails to provide any source indicating significance for either hotel, or motel, services.” 6 TTABVUE 6.

Applicant offers no evidence supporting its argument that “hotels tend to be viewed as higher-end properties while motels tend to be viewed as lower-end properties,” 4 TTABVUE 6-7, and the record casts doubt on the different perceptions claimed by Applicant because the evidence suggests that the words “hotel” and “motel” are often used interchangeably, that facilities that could be described as “motels,” defined as “establishment[s] which provide[] lodging and parking and in which the rooms are usually accessible from an outdoor parking area,”²⁴ may instead be described as “hotels,” and that some facilities identified as “hotels” offer budget

²⁴ MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, last accessed on March 13, 2019). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed form or regular fixed editions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

daily room rates that, in comparison to rates for other nearby facilities, are consistent with a perception that these hotels are “lower-end properties.” 4 TTABVUE 7.²⁵

Moreover, we must consider the meaning of Applicant’s mark in the context of the identified services with which Applicant intends to use it. *Coach Servs.*, 101 USPQ2d at 1721-22. The application covers a subset of “hotel services,” specifically “resort hotel services.” Applicant’s claim that “the inclusion of ‘Motel’ in the Applicant’s Mark immediately infers a property distinct from a Hotel,” 7 TTABVUE 2, is belied by the fact that when consumers encounter the mark, it will be used with a “resort hotel.”²⁶ The use of Applicant’s MYSTIC MOTEL mark in connection with a lodging facility expressly identified as a “resort hotel” seems at least as likely to connote a “higher-end” property as a “lower-end” property.

In any event, because we give greater weight to the dominant word MYSTIC in Applicant’s mark in our comparison of the marks in their entireties, any slight difference between the connotation and commercial impression of the marks resulting from the presence of the non-source identifying word MOTEL in Applicant’s mark is outweighed by the similarity of the meaning of the mark resulting from the presence of the shared word MYSTIC. Indeed, given the interchangeability of the words “hotel”

²⁵ April 4, 2018 Final Office Action at 56-59 (tripadvisor.com pages describing and displaying “Mystic Hotels” in and around Mystic, Connecticut, including a number with daily room rates as low as \$47).

²⁶ The term “resort hotel” means, inter alia, “a fashionable hotel usually in a resort area.” July 11, 2017 Letter of Protest Memorandum at 9 (THE FREE DICTIONARY). As noted above, Registrant describes its hotel as a “resort destination” that offers “luxurious accommodations, modern amenities and perks including complimentary Wi-Fi, valet parking, indoor pool and access to Dakotah! Sport and Fitness.” April 4, 2018 Final Office Action at 27.

and “motel” suggested by the record, to the extent that the word MOTEL in the MYSTIC MOTEL mark signals a different form of resort hotel services, as Applicant claims, a consumer familiar with Registrant’s stylized MYSTIC mark for hotel services could readily believe that the owner of that mark had expanded its business into a different form of hotel under the MYSTIC MOTEL mark.

The marks are similar in appearance, sound, connotation, and commercial impression when considered in their entireties, and the first *du Pont* factor supports a finding of a likelihood of confusion, especially given the lower degree of similarity required for confusion to be likely arising from the legal identity of the services.

C. Purchase Conditions

“The fourth *DuPont* factor considers ‘[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse vs. careful sophisticated purchasing.’” *Stone Lion*, 110 USPQ2d at 1162 (quoting *du Pont*, 177 USPQ at 567). Applicant argues that “[c]onsumers looking to visit or stay in hotels and motels are not impulse purchasers,” 4 TTABVUE 7, that “[s]electing a place to lodge is something undertaken with significant research,” 7 TATBVUE 3, and that “consumers are going to spend time determining which property to visit or stay in before doing so.” 4 TTABVUE 7. Applicant concludes that the differences in the marks “provide sufficient information to allow their sophisticated consumers to not be confused.” *Id.* The Examining Attorney responds that “Applicant offers no evidence, just argument, how consumers might be affected by confusingly similar names used by competing resorts when determining which property to visit,” 6 TTABVUE 8, and that “even if consumers of

the services could be considered sophisticated and discriminating,” *id.* at 9, they are not immune from source confusion. *Id.* We agree with the Examining Attorney.

Our primary reviewing court recently reminded us that “[a]ttorney argument is no substitute for evidence.” *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)). Applicant offers no evidence that purchasers of hotel services, including resort hotel services, exercise any heightened degree of care in selecting lodging, and the record suggests that price savings may be a more significant factor in selecting hotel services than the identity of the provider of those services.²⁷ Even assuming, however, that some purchasers of hotel services, including resort hotel services, exercise significant care, “Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’” *Stone Lion*, 110 USPQ2d at 1163 (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014)). As discussed above, members of the general public consume hotel services, including resort hotel services, and there is no evidence that the least sophisticated purchasers in the general public will exercise anything other than ordinary care. We find that the fourth *du Pont* factor is neutral in our analysis.

²⁷ April 4, 2018 Final Office Action at 56-59.

D. The Number and Nature of Similar Marks in Use

The sixth *du Pont* factor “considers ‘[t]he number and nature of similar marks in use on similar goods [or services].’” *Omaha Steaks Int’l Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *du Pont*, 177 USPQ at 567). “The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Id.* (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694) (internal quotation omitted).²⁸

Applicant argues that there is no likelihood of confusion because of the number of similar marks in use. 4 TTABVUE 7. Applicant relies solely on the webpages of the California hotel and the Florida resort and golf club discussed above, but other webpages regarding the California hotel,²⁹ as well as webpages regarding hotels in and around Mystic, Connecticut,³⁰ were made of record by the Examining Attorney, and we will consider all of this evidence for whatever probative value it may have under the sixth *du Pont* factor.

The webpages regarding “Mystic Hotels” in Mystic, Connecticut reflect the use of “Mystic” in a purely geographic sense to identify hotels located in or around that city (e.g., “Hilton Mystic,” “Inn at Mystic,” and “Howard Johnson Inn Mystic”). These non-

²⁸ Applicant does not expressly offer the third-party uses for this purpose, but rather to show that “no evidence exists to show any consumer confusion has arisen based on the concurrent use.” 4 TTABVUE 7.

²⁹ April 4, 2018 Final Office Action at 41-52.

³⁰ *Id.* at 53-59.

trademark uses are not probative of whether the cited mark is entitled to only to a narrow scope of protection, or whether consumers are able to distinguish between the subject marks here.³¹

The uses of MYSTIC as a service mark for the California hotel and the Florida resort and golf club discussed and displayed in Applicant's main brief fall far short of the sort of voluminous or extensive evidence of third-party use and registration that the Federal Circuit has held to be probative under the sixth *du Pont* factor of the weakness of a mark, or the ability of consumers to distinguish between two marks containing common weak elements. *See Inn at St. John's*, 126 USPQ2d at 1746 (four third-party registrations and no third-party uses were "a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant" in the Federal Circuit's decisions in *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116

³¹ Applicant also argues, under the twelfth *du Pont* factor discussed below, that the cited mark itself "is geographically descriptive" because "the term Mystic is based on Mystic Lake located about 10 miles from the Mystic Lake Casino (owned by the Shakopee Mdewakanton Sioux Community) and the location of the services for which the Cited Mark is used." 4 TTABVUE 8. Applicant cites Registrant's alleged "family of Mystic trademarks" based on the information contained in the list of registrations in Applicant's main brief, and argues that the "Mystic brand is based on the proximity of the Mystic Lake Casino to the Mystic Lake in Minnesota (both on the tribal lands of [Registrant])." *Id.* Applicant claims that "this geographic descriptiveness . . . dramatically limits any potential confusion since the Cited Mark is entitled to a narrower protection than a strong mark." *Id.* As discussed above, we acknowledge that Registrant owns four registrations of other MYSTIC-formative marks, as described in Applicant's main brief, but Applicant's argument constitutes an impermissible collateral attack on the cited registration, which we cannot entertain on this *ex parte* appeal. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1053; *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (applicant's claim that the cited mark was merely descriptive and weak was an impermissible collateral attack on the cited registration).

USPQ2d 1129, 1136 (Fed. Cir. 2015) and *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 Fed. Cir. 2015)).³² On this record, we find that the sixth *du Pont* factor is neutral in our analysis.

E. Twelfth *du Pont* Factor

Applicant invokes the twelfth *du Pont* factor, which is the “extent of potential confusion, i.e., whether *de minimis* or substantial.” *du Pont*, 177 USPQ at 567. Applicant argues that Registrant is identified in the cited registration as a federally recognized Indian tribe,³³ and operates a hotel under the cited mark on tribal land in Minnesota under the Indian Gaming Regulatory Act of 1998, which Applicant claims makes any expansion of use of the cited mark “outside of the tribal lands . . . remote at best and possibly impossible.” 4 TTABVue 7-8. According to Applicant, “[s]uch limits of expansion dramatically limit any potential for confusion.” *Id.* at 8.

Applicant’s argument is unavailing. Applicant “seeks a geographically unrestricted registration under which it might expand throughout the United States.” *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 393 (Fed. Cir. 1983). The cited registration is also geographically unrestricted, which presumptively gives Registrant “the exclusive right to use its mark throughout the United States.” *Id.* See also *In re Appetito Provisions, Inc.*, 3 USPQ2d 1553, 1554 n.4

³² In *Jack Wolfskin*, there were at least 14 third-party registrations and uses of paw print marks that showed the weakness of that design element in the opposer’s mark, 116 USPQ2d at 1136 n.2, while in *Juice Generation*, there were approximately 26 third-party registrations and uses of marks containing the words “Peace” and “Love” that showed the weakness of those words in the opposer’s marks. 115 USPQ2d at 1673 n.1.

³³ July 12, 2017 Office Action at 2.

(TTAB 1987). This is not a concurrent use proceeding, and in analyzing the *du Pont* factors, we cannot consider the possible geographically separate uses of the subject marks by Applicant and Registrant. *Id.*

F. Conclusion

All of the relevant *du Pont* factors either support a finding of a likelihood of confusion, or are neutral. The services, channels of trade, and classes of consumers are legally identical, the marks are quite similar in appearance, sound, connotation, and commercial impression when considered in their entirety, the least sophisticated purchasers of resort hotel services are likely to exercise only ordinary care, and there is insufficient evidence of third-party use of similar marks for similar services to show that the cited mark is weak or that the two marks can be distinguished on the basis of the minor differences between them. We find, on the basis of the record as a whole, that consumers of hotel services who are familiar with the cited stylized MYSTIC mark are likely to believe mistakenly that resort hotel services offered under the standard character MYSTIC MOTEL mark originate with, or are licensed, authorized, or sponsored by, the owner of the stylized MYSTIC mark.

Decision: The refusal to register is affirmed.