

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 16, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re West Flagler Associates, Ltd.
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Serial No. 87921527
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Mark D. Passler and Victoria J.B. Doyle of Akerman LLP,
for West Flagler Associates, Ltd.


Raul Cordova, Trademark Examining Attorney, Law Office 114,
Nicole Nguyen, Managing Attorney.

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Before Rogers, Chief Administrative Trademark Judge, and
Coggins and Lebow, Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

West Flagler Associates, Ltd. (“Applicant”) seeks registration on the Principal Register of the mark , with a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), in part, as to MAGIC CITY, for “clothing, namely, shirts, hats, sweatshirts, shorts and sweatpants” in International Class 25.¹

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¹ Application Serial No. 87921527 was filed on May 15, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and in commerce since at least as early as October 9, 2009. The application contains the following

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 so resembles the mark  registered on the Principal Register for "shorts; sports caps and hats; sweat shirts; t-shirts" in International Class 25,² as to be likely to cause confusion, to cause mistake, or to deceive when used for Applicant's identified goods.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed and fully briefed. We affirm the refusal to register.

I. Applicant's Proposed Amendment to the Identification of Goods

Before proceeding to the merits of the refusal, we address a preliminary matter raised in Applicant's reply brief. Applicant, without requesting remand, seeks for the first time in its reply brief "to amend the identification of goods in [its] application to include the following express limitation: 'all in connection with a casino, jai alai stadium, and live concert venue in Miami, Florida.'" 9 TTABVUE 5.³ Applicant's Request for Reconsideration, filed along with its Notice of Appeal, argued against the

statement: "The mark consists of the words MAGIC CITY, with the letter 'T' in the word CITY depicting a palm tree."

² Registration No. 4338542, issued May 21, 2013; Sections 8 and 15 combined declaration accepted and acknowledged. The registration contains the following statement: "The mark consists of the word 'MAGIC' followed by a stylized silhouette of a nude woman followed by the word 'CITY.'" The registration also covers goods in Class 16 which are not at issue.

³ Citations to the briefs in the appeal record refer to the TTABVUE docket system.

refusal but did not raise the proposed amendment, which would have been preferable. *See In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *1-2 (TTAB 2020) (explaining, in descending order of preference, the timing for filing a proposed amendment in an attempt to obviate a refusal: (1) propose an amendment as early as possible during prosecution of the application; (2) make an amendment in a request for reconsideration soon after the issuance of a final Office action and before the deadline to file an appeal; and (3) after filing an appeal “file a separately captioned request for remand and suspension of proceedings with the Board, ideally prior to the deadline for filing an appeal brief, so that the Board can make a prompt ruling on the request and the examining attorney does not have to draft a potentially unnecessary appeal brief”).

Applicant’s proposed amendment is an attempt to overcome the presumption that the channels of trade and classes of purchasers are the same. *See* 9 TTABVUE 5 (Applicants’ reply brief), 8 TTABVUE 6 (Examining Attorney’s brief). However, the Examining Attorney’s position asserting that the trade channels and purchasers are the same due to the identity of the respective goods was raised in the first Office Action (*see* August 23, 2018 Office Action at 3)⁴ and reiterated in the final Office Action (*see* September 2, 2021 Office Action at 2). Applicant offers no explanation why it waited until filing its reply brief to propose an amendment to its original identification. Given the late stage of Applicant’s request without any explanation for

⁴ Citations to the prosecution record refer to the .pdf version of the TSDR system.

the reason for the delay, we deny the implied request for remand. *See, e.g., Ox Paperboard*, 2020 USPQ2d 10878, at *2-3.

Moreover, even if Applicant's proposed amendment was accepted, it would not obviate the Section 2(d) refusal. Where the goods in a cited registration are broadly identified as to their nature and type, and there is no restriction as to the channels of trade or limitation as to the classes of purchasers, it is presumed that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *see also In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

II. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that a proposed mark, for which application has been made, may be refused registration if it “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive” 15 U.S.C. § 1052(d).

Our determination under Section 2(d) involves an analysis of all probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”) *cited in B&B*

Hardware, Inc. v. Hargis Indus., Inc., 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Varying weights may be assigned to the *DuPont* factors depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks (the first *DuPont* factor) and the similarity of the goods (the second *DuPont* factor). *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent consumer confusion as to source and to protect registrants from damage caused by registration of similar marks likely to cause such confusion. *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

A. Identity of the Goods, Trade Channels, and Classes of Purchasers.

“We begin with the second and third *DuPont* factors, which respectively consider ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an

application or registration,’ and ‘the similarity or dissimilarity of established, likely-to-continue trade channels.’” *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *19 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) and *DuPont*, 177 USPQ at 567).

The identification of goods in the application and cited registration each list “hats,” “sweatshirts,” and “shorts.” In addition, the broadly-worded “shirts” and “hats” identified in Applicant’s identification encompass the more narrowly-worded “t-shirts” and “sports caps” in Registrant’s identification. The goods are therefore in-part identical, and in-part legally identical. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1518 (TTAB 2016) (“Inasmuch as Registrant’s goods are encompassed within the scope of Applicant’s goods, the respective goods are legally identical in part.”); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (Applicant’s broadly worded identification of goods necessarily encompasses Registrant’s narrowly identified goods).

In making our determination, we have looked to the goods as identified in Applicant’s application and the cited registration. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to

which the sales of goods are directed.”)). Because the goods are identical and legally identical in part, and without restriction, we must presume that the channels of trade and classes of purchasers for these goods are the same as well. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1906 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same). Thus, we consider Applicant’s and Registrant’s trade channels and classes of purchasers to be the same.

The second and third *DuPont* factors regarding the similarity of the goods, channels of trade, and classes of purchasers strongly favor a finding of a likelihood of confusion.

B. Conditions of Purchase

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *In re Embiid*, 2021 USPQ2d 577, at *31 (TTAB 2021) (quoting *DuPont*, 177 USPQ at 567).

Applicant argues that the purchasers of its and Registrant’s clothing goods are discerning due to the nature of Applicant’s and Registrant’s “core services.” 9 TTABVue 4. Specifically, Applicant posits that because it operates a casino, jai alai sports venue, and live music venue in Miami, Florida, while Registrant operates a

strip club in Atlanta, Georgia, “[t]he relevant consumers of the . . . respective services are deliberate consumers choosing their entertainment source with care, as well as the parties’ respective merchandise, particularly given the adult-only nature of Registrant’s services” *Id.* However, as we discussed, there are no restrictions or limitations in Applicant’s or Registrant’s identification of goods associating the identical clothing goods with any services. The absence of such restrictions vitiates Applicant’s discerning consumer argument.

Moreover, there is nothing in the nature of the identified hats, sweatshirts, shorts, and other common articles of clothing listed in the application (which have no limitation as to their type, price point, or intended consumers) to suggest their purchasers are particularly sophisticated or careful. *See In re I-Coat Co.*, 126 USPQ2d 1730, 1739 (TTAB 2018). In fact, the standard of care is that of the least sophisticated potential purchaser. *Stone Lion*, 110 USPQ2d at 1163, cited in *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (“Board precedent requires our decision to be based on the least sophisticated potential purchasers.”).

We find that the fourth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

C. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.’” *Embiid*, 2021 USPQ2d 577, at *11 (TTAB 2021) (quoting *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73

USPQ2d 1689, 1691 (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*, 126 USPQ2d 1742, 1746 (TTAB 2018) and *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

“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.’” *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted)). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than a specific impression of marks.” *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)).

The Examining Attorney argues that the literal portions of Applicant’s

MAGIC  mark and Registrant’s MAGIC  mark are identical.

He further argues that when evaluating composite word-and-design marks, such as the marks at issue in this appeal, 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. 8 TTABVUE 5.

It is undeniable that the marks are identical when pronounced. The only literal element of the marks is MAGIC CITY. Applicant does not contend otherwise. Instead, Applicant counters that the design elements of the marks are the most important portions to consider because they convey very different commercial impressions that are more likely to be impressed on the minds of consumers, particularly when the underlying “core businesses” and “core services” of Applicant and Registrant are considered. 6 TTABVUE 2, 7-8; 9 TTABVUE 3-4. However, as mentioned above, we must look to the goods as they are identified in the application and cited registration, *Stone Lion*, 110 USPQ2d at 1162, which here do not list any “core” businesses or services.

As to appearance, the marks differ slightly in stylization, and each mark contains a design element not present in the other. Neither design element detracts from the literal element MAGIC CITY, and we find that the marks are similar in appearance because the largest portions thereof are the words MAGIC CITY. We find that the design elements of the mark are not nearly as significant as the marks’ literal elements, and agree with the Examining Attorney, *see* 8 TTABVUE 5, that “[i]n marks ‘consisting of words and a design, the words are normally accorded 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.’” *Sabhnani*, 2021 USPQ2d 1241, at *31 (quoting *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 101 USPQ2d at 1908; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). ““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 *Aquitaine Wine USA*, 126 USPQ2d at 1184).

Applicant argues that the commercial impressions of the marks are different due to the “design components [that] communicate materially different messages.” 9 TTABVUE 3. Specifically, Applicant contends that its “palm tree design communicates a tropical place, which is suggestive of the commercial context in which Applicant[] uses its mark . . . in Miami, Florida,” while “Registrant’s [m]ark includes the design of a silhouette of a naked woman, which is suggestive of its . . . strip club in Atlanta, Georgia.” *Id.*

We do not ignore the design elements, on which Applicant focuses, and consider them when comparing the marks as a whole. We cannot, however, accept Applicant’s arguments that the “core services” of Applicant’s casino and entertainment venues and Registrant’s strip clubs meaningfully inform the commercial impressions of the marks in such a way as to affect “[t]he relevant consumers of the parties’ respective services.” 9 TTABVUE 4. As explained above, the identifications of goods list clothing without any limitation or connection to other “core services.” We agree that the palm and silhouette elements of the marks differ, but that difference does not outweigh the larger and dominating literal MAGIC CITY element of the respective marks. As a result, and particularly because of the dominant MAGIC CITY element of each mark, the marks convey essentially identical meanings and create similar commercial impressions.

Furthermore, when the goods identified by the respective marks are identical or identical in part, as is the case here, the degree of similarity between the marks required to support a finding of likelihood of confusion declines. *Cai*, 127 USPQ2d at 1801; *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

We find the marks identical in sound, and more similar than dissimilar in appearance, meaning, and commercial impression. The first *DuPont* factor thus weighs in favor of finding a likelihood of confusion.

D. Actual Confusion

The seventh *DuPont* factor is the “nature and extent of any actual confusion,” while the eighth *DuPont* factor considers the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567.

Applicant argues that its and Registrant’s “respective MAGIC CITY marks covering clothing goods . . . have co-existed in the marketplace without any actual confusion since 2009.” 6 TTABVUE 3. In support of this argument, Applicant submitted two declarations of its Chief Operations Officer Scott Savin, which collectively aver that Applicant has sold or distributed tens of thousands of items of apparel bearing both the involved MAGIC CITY mark and the mark MAGIC CITY CASINO; to Applicant’s knowledge there has been no evidence of consumer confusion; Applicant has never received misdirected telephone calls or mail for Registrant; no

customers have ever approached Applicant to indicate that they mistakenly believed that Applicant was Registrant; and Registrant has never contacted Applicant to complain about Applicant's use of the MAGIC CITY mark or to complain that confusion is likely or has actually occurred. December 19, 2018 Response to Office Action at 12; June 25, 2019 Response to Office Action at 8.

Applicant operates in Miami, Florida, and argues that Registrant operates solely in Atlanta, Georgia.⁵ However, there is no evidence of record as to the nature and extent of Registrant's actual use of the cited mark in the marketplace, including the extent of any geographical overlap. Even if we take Applicant's Miami-and-Atlanta argument as true, there would still be no geographic overlap and almost no opportunity for actual confusion to occur. *See In re Guild Mtg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020) ("The eighth *du Pont* factor . . . requires us to look at actual market conditions, to the extent there is evidence of such conditions of record."). *See also In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971).

Furthermore, the fact that an applicant in an *ex parte* proceeding is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis. There has been "no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story." *Guild Mtg.*, 2020 USPQ2d 10279, at *7

⁵ The only evidence of record to support Applicant's argument that Respondent operates in Atlanta, Georgia, is information about Registrant as shown on the cited registration: Registrant is a Georgia corporation with an address in Decatur, Georgia. *See* August 23, 2018 Office Action at 6.

(citing *In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) (“The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.”)) (citations omitted). *See also Detroit Athletic*, 128 USPQ2d at 1053 (“[T]he relevant test is likelihood of confusion, not actual confusion.”); *In re i.am.symbolic*, 123 USPQ2d at 1747 (“[A] showing of actual confusion is not necessary to establish a likelihood of confusion.”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).



The seventh and eighth *DuPont* factors are neutral.

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

The thirteenth *DuPont* factor examines “any other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. This 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), and is “highly fact specific.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *18 (TTAB 2019). Analysis under this factor can be necessary in cases involving prior registrations. *See, e.g., In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790 (TTAB 2017) (finding composite word-and-design mark USA WARRIORS ICE HOCKEY NONE TOUGHER likely to cause

confusion with composite word-and-design mark USA HOCKEY despite applicant's prior registration of another composite word-and-design mark including USA WARRIORS ICE HOCKEY NONE TOUGHER); *Strategic Partners*, 102 USPQ2d 1397 (no likelihood of confusion found with the registered word-and-design mark ANYWEAR BY JOSIE NATORI where the applicant's previously registered standard-character mark ANYWEARS was substantially similar to its proposed stylized mark ANYWEAR for identical goods and had been registered for over five years⁶).

Applicant argues that it owns the following six registrations, three of which are for marks identifying clothing goods, which already co-exist with the cited mark. 6 TTABVUE 3.

- Registration No. 3723955 on the Supplemental Register for the standard-character mark MAGIC CITY CASINO for “clothing, namely, shirts, hats, sweatshirts, shorts, and sweatpants” in Class 25;
- Registration No. 5998738 on the Supplemental Register for the standard-character mark MAGIC CITY RACING for “clothing, namely, shirts, hats, sweatshirts, shorts and sweatpants” in Class 25;
- Registration No. 6098770 on the Principal Register for the standard-character mark MAGIC CITY HUSTLE for “shirts; hats” in Class 25;
- Registration No. 5900985 on the Principal Register for the mark  for various casino and entertainment services in Classes 38 and 41;
- Registration No. 5878231 on the Principal Register for the mark  for various casino and entertainment services in Classes 38 and 41; and

⁶ The five year anniversary was important in *Strategic Partners* because the applicant's prior registration was “not subject to attack by the owner of the cited registration on a claim of priority and likelihood of confusion.” 102 USPQ2d at 1399. See Section 14 of the Trademark Act, 15 U.S.C. § 1064.

- Registration No. 5942547  for “casinos” in Class 41.

6 TTABVUE 4-5 (table in brief); *see also* March 2, 2022 Request for Reconsideration at 8-9.

Applicant failed to make of record documents which show the current status and title of its prior registrations. *See* TBMP § 1208.02 (for registrations that are not the subject of the appeal, a copy from the electronic records of the USPTO must be submitted); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations in a brief insufficient to make them of record). However, because the Examining Attorney did not object to Applicant’s reliance on its prior registrations, considered this argument when denying reconsideration, *see* March 17, 2022 Reconsideration Letter at 1-2, and discussed the registrations in his brief, *see* 8 TTABVUE 7-9, 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, we consider: (1) whether the applicant’s prior registered mark is the same as applicant’s proposed 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 be affirmed or reversed; 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 because the applicant's prior registration was less than five years old, making it still subject to a cancellation action by the registrant based on likelihood of confusion, the thirteenth factor did not outweigh the other relevant *DuPont* factors).

Applicant contends that its rights in the MAGIC CITY mark "are arguably broader than" Registrant's rights in the cited mark because Applicant owns prior registrations for three standard character marks (i.e., MAGIC CITY CASINO, MAGIC CITY RACING, and MAGIC CITY HUSTLE) for clothing while Registrant's cited mark contains a design element in addition to the wording MAGIC CITY. 6 TTABVUE 3. We are not persuaded, but instead agree with the Examining Attorney that Applicant's prior registrations do not obviate the Section 2(d) refusal. The facts presented by the subject application and prior registrations do not fit within the *Strategic Partners* exception because the marks and/or services in the prior registrations are different.⁷

⁷ The Examining Attorney makes another relevant argument, *see* 8 TTABVUE 9, noting that two of Applicant's prior registrations (Registration Nos. 3723955 and 5998738) are on the

Under the first consideration, we find that only one of Applicant's prior registrations, Registration No. 5900985, is for the same mark as the mark in the application subject to appeal. The five other prior registered marks (Registration Nos. 3723955, 5998738, 6098770, 5878231, and 5942547) all contain additional matter (e.g., CASINO, RACING, or HUSTLE) and are not the same as Applicant's mark on appeal. The mark in the application is more similar to the cited registered mark than any of these five other previously registered marks. Under the second consideration, Applicant's one prior similar registered mark in Registration No. 5900985 is unhelpful to Applicant because the services for which it is registered (i.e., various casino and entertainment services) are not identical to the clothing goods identified in the subject application.⁸

Because under the first and second considerations we find that none of Applicant's prior registrations meet the highly fact specific situation of *Strategic Partners*, we need not analyze the length of time Applicant's prior registrations have coexisted with the cited registration. Indeed, were we to take up this question we would be compelled to note that Applicant did not provide the dates on which any of its prior marks registered.

Supplemental Register and therefore remain "subject to attack by the owner of the cited registration on a claim of priority and likelihood of confusion." *Strategic Partners*, 102 USPQ2d at 1399.

⁸ Similarly, Registrations Nos. 5878231 and 5942547 also do not identify clothing goods, but casinos or various casino and entertainment services

Consideration of Applicant's prior registrations under this factor does not tip the balance away from finding a likelihood of confusion. In view thereof, the thirteenth *DuPont* factor is neutral.

F. Conclusion on Likelihood of Confusion

In view of the similar marks, and their identical in part and legally identical in part goods, which must be presumed to move through the same channels of trade to the same classes of ordinary consumers, confusion is likely between Registrant's mark and Applicant's mark when the marks are viewed in their entirety. The absence of evidence of actual confusion, and the existence of Applicant's prior registrations for marks that either are not substantially similar to the mark subject to this appeal or identify services not identical to the goods subject to this appeal, do not tip the balance away from our finding that confusion is likely.

III. Decision

The refusal to register Applicant's mark MAGIC CITY is affirmed.