

This Opinion is Not a
Precedent of the TTAB

Mailed: November 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Fiesta Hotels & Resorts, S.L.

v.

George Alvarez

Opposition No. 91245576

Cancellation No. 92070299

Michael J. Brown of Michael J. Brown Law Office LLC
for Fiesta Hotels & Resorts, S.L.

Christopher M. Verdini of K&L Gates LLP
for George Alvarez.

Before Bergsman, Shaw and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

A. Procedural Background

This consolidated proceeding¹ consists of an opposition to the application to register the mark TRSCORALHOTEL.COM in standard characters² and a cancellation against the registered mark TRSYUCATANHOTEL.COM,³ both for “Travel services, namely, making reservations and bookings for temporary lodging; making hotel and temporary lodging reservations for individuals and groups via a global computer network” in International Class 43, and both owned by George Alvarez (Alvarez). The opposition and cancellation were filed by Fiesta Hotels & Resorts, S.L. (“Fiesta”), based on likelihood of confusion.

Fiesta relies on alleged common law rights in TRS and THE ROYAL SUITES for:

a wide variety of hotel and travel related services, including travel services, namely, making reservations and bookings for temporary lodging; making hotel and temporary lodging reservations for individuals and groups via a global computer network.⁴

¹ The Board consolidated these proceedings on April 2, 2019, and designated Opposition No. 91245576 as the parent case. 6 TTABVUE 2. TTABVUE citations in this decision are to the record in the parent case unless otherwise indicated. “TTABVUE” refers to the Board’s online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

² Application Serial No. 87874585 was filed April 12, 2018 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleges June 23, 2017 as the date of first use and first use in commerce.

³ Registration No. 5524373 issued July 24, 2018 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleges June 13, 2017 as the date of first use and first use in commerce.

⁴ Cancellation No. 92070299, 1 TTABVUE 34 (Petition for Cancellation).

Fiesta also relies on alleged common law rights in TRS, TRS YUCATAN HOTEL and TRS CORAL HOTEL for:

Hotel services; Hotel accommodation services; Rental and reservation of hotel rooms; Hotel services and the providing of food and drink; Temporary accommodation; Booking agency services for hotel accommodation; Temporary accommodation rental and reservations; Rental of meeting rooms; Bar services; Cafes; Cafeterias; Snackbars; Appraisal of hotel accommodation.⁵

The Notice of Opposition also identified non-ownership and fraud as additional grounds, and referred to false suggestion of a connection. The Petition for Cancellation also identified non-ownership, fraud, and misrepresentation of source as additional grounds, and referred to false suggestion of a connection. However, Fiesta's opening Brief only addressed likelihood of confusion, and did not refer to or address any of these other grounds, and therefore they are waived.⁶ *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1348 (TTAB 2017) (opposer's failure in its main brief to argue likelihood of confusion claim based on one of two marks pleaded in its notice of opposition resulted in waiver of that claim as to that mark) (citing *Swatch AG v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015)); *Alcatraz Media, Inc. v.*

⁵ 1 TTABVUE 2-4 (ESTTA coversheet of Notice of Opposition and Notice of Opposition); Cancellation No. 92070299, 1 TTABVUE 2-4 (ESTTA coversheet of Petition for Cancellation and Petition for Cancellation).

⁶ After Alvarez's Brief pointed out Fiesta's waiver of the fraud claim, Fiesta briefly addressed fraud in its Reply Brief. To the extent this was an effort to resuscitate the claim, the effort fails. *Cf. Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1077 (TTAB 2011) (opposer's claim that its mark was famous, which was not discussed by applicant in its brief and which was raised for the first time in opposer's reply brief, was improper rebuttal argument).

Chesapeake Marine Tours, Inc., 107 USPQ2d 1750, 1753 (TTAB 2013), *aff'd*, 565 Fed. App'x 900 (Fed. Cir. 2014) (mem.) (petitioner's pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 801.01 (2022) ("If a party fails to reference a pleaded claim or affirmative defense in its brief, the Board will deem the claim or affirmative defense to have been waived").

In his Answers to the Notice of Opposition and Petition to Cancel, Alvarez denied the salient allegations, and included a sizable list of "Affirmative Defenses," many of which are not true affirmative defenses.⁷ Regardless, with the exception of acquiescence and estoppel, which we consider below, Alvarez did not pursue the other purported affirmative defenses at trial, and we therefore consider them waived. *See Alcatraz Media*, 107 USPQ2d at 1753 n.6.

The consolidated proceeding is fully briefed.

⁷ 4 TTABVUE (Answer); Alvarez listed essentially the same "affirmative defenses" in Cancellation No. 92070299, 4 TTABVUE (Answer). To the extent the matters raised are not true affirmative defenses, we would not consider them as such regardless. *See, e.g., DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *1 (TTAB 2020) (mere amplifications of the applicant's denials not considered as separate affirmative defenses); *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010) ("The asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer's claim rather than a statement of a defense to a properly pleaded claim.").

B. General Factual Background

Fiesta, previously Palladium Hotels (“Palladium”), operates resort hotels in various locations that include the Caribbean and provides related services. Before Fiesta rebranded its hotels to “TRS,” it used the mark “The Royal Suites.”⁸

Alvarez has no business history directly with Fiesta or Palladium.⁹ But Alvarez licenses certain marks, including the ones at issue in this case, to an online wholesale vacation package provider, Vacation Store, that previously contracted with Palladium to allow Vacation Store to book rooms for others at certain of Palladium’s resort hotels.¹⁰ Alvarez also holds the position of Vice President of Operations for Vacation Store.¹¹ To facilitate its business, Vacation Store operated numerous booking websites dedicated exclusively to making reservations for consumers at Fiesta’s hotels.¹² Alvarez’s marks at issue in this proceeding are the domains for two of these booking websites -- TRSYUCATANHOTEL.COM serves as the web address for a site used only for bookings at Fiesta’s hotels, featuring the TRS Yucatan Hotel, and TRSCORALHOTEL.COM is the web address for a site used only for bookings at Fiesta’s hotels, featuring the TRS Coral Hotel.¹³ Alvarez makes clear that the marks

⁸ 22 TTABVUE 2, 4 (Zertuche Declaration).

⁹ 22 TTABVUE 3 (Zertuche Declaration).

¹⁰ 44 TTABVUE 10 (Alvarez testimony) 28 TTABVUE 3 (Alvarez Declaration).

¹¹ 28 TTABVUE 2.

¹² 44 TTABVUE 10; *see, e.g.*, 28 TTABVUE 24-30 (screenshots from trsyucatanhotel.com that does not appear to refer to Vacation Store and trscoralhotel.com that displays the heading VACATION STORE MIAMI®TRS CORAL HOTEL.”).

¹³ 44 TTABVUE 10-11; *see also* 28 TTABVUE 24-30 (screenshots from trsyucatanhotel.com and trscoralhotel.com).

and websites used by Vacation Store are intended to refer to Fiesta's hotels.¹⁴ While Alvarez testified that Fiesta was aware of Vacation Store's use of the domains for some of its websites,¹⁵ and did not object to them,¹⁶ he acknowledged there was no direct authorization from Fiesta or any related company to register TRSYUCATANHOTEL.COM and TRSCORALHOTEL.COM as trademarks, or as domain names.¹⁷

Alvarez testified that "Vacation Store has used the Challenged Marks since June 2017 to offer rooms to those resorts [Fiesta's TRS Yucatan and TRS Coral] and has been authorized to sell those rooms through its contracts with Fiesta, its predecessors or through [unidentified] authorized resellers."¹⁸ However, according to Fiesta, its contractual relationship with Vacation Store terminated in 2016. Sergio Zertuche Valdes, Fiesta's Corporate Commercial and Marketing Director, stated that Fiesta ended its contractual relationship with Vacation Store "based on a breach by [this] compan[y] with respect to [its] positioning [its] own domain names above Fiesta's official websites."¹⁹ On cross-examination, Alvarez responded to the question whether in June 2017 "there was an active agreement between Vacation Store or you and

¹⁴ 28 TTABVUE 6 (Alvarez Declaration); 36 TTABVUE 30, 32-33, 41 (Interrogatory Answers).

¹⁵ 28 TTABVUE 3 (Alvarez Declaration).

¹⁶ 28 TTABVUE 4 (Alvarez Declaration).

¹⁷ 44 TTABVUE 13-15.

¹⁸ 28 TTABVUE 6.

¹⁹ 22 TTABVUE 3 (Zertuche Declaration).

Fiesta Palladium,” with “I can’t recall right now.”²⁰ Also on cross-examination, he noted “[a]ll our bookings are – now go through our affiliate programs....”²¹

II. Evidentiary Record

The file of the challenged registration and opposed application are part of the record pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). Fiesta submitted a testimony declaration from its Corporate Commercial and Marketing Director, Sergio Zertuche Valdes, with exhibits attached (22 TTABVUE), and a revised Notice of Reliance on certain discovery requests and responses (36 TTABVUE). Fiesta also submitted a transcript of the cross-examination deposition of Alvarez (44 & 45 TTABVUE).

Alvarez submitted the testimony declaration of George Alvarez, with exhibits attached (28 TTABVUE), a transcript of the cross-examination deposition on written questions of Mr. Zertuche, with exhibits attached (42 TTABVUE), and a Notice of Reliance on certain discovery requests and responses (43 TTABVUE).

The parties’ descriptions of the record in their briefing align, and neither party lodged or preserved objections in briefing the case. Alvarez included in his Brief a screenshot from the USPTO’s TESS database that was not submitted during his trial period.²² Evidence submitted outside of the trial periods, including that attached to briefs, is untimely, and will not be considered. *Life Zone Inc. v. Middleman Group*

²⁰ 45 TTABVUE 14.

²¹ 45 TTABVUE 16.

²² 47 TTABVUE 17 (Alvarez Brief).

Inc., 87 USPQ2d 1953, 1955 (TTAB 2008). *See also Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *2 (TTAB 2020) (“A brief may not be used as a vehicle for the introduction of evidence.’... The Board will not consider evidence and other evidentiary materials attached to the briefs unless they were properly made of record during the time assigned for taking testimony.”). Accordingly, we have given no consideration to the screenshot.

III. Entitlement to a Statutory Cause of Action²³

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 U.S. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark or petition to cancel a registration when it demonstrates an interest falling within the zone of interests protected by the statute, 15 U.S.C. §§ 1063 & 1064, and a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020).

²³ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Despite the change in nomenclature, the substance of our analysis of this issue in our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

Here, Fiesta must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies*, 2020 USPQ2d 10837 at *3; *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012). Fiesta has established its common law use of its pleaded marks in connection with services that overlap with, and are related to, Applicant's.²⁴ *See Lipton Indus., Inc. v. Ralston Purina Co.*, 607 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (plaintiff may establish standing by proving a real commercial interest in its own marks and a reasonable belief that it would be damaged (e.g., a claim of likelihood of confusion that is not wholly without merit)); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (common law use of similar mark sufficient to establish standing). Based on such common law use, Fiesta has asserted a plausible likelihood of confusion claim against the involved application and registration, thereby showing a real interest in this proceeding beyond that of a mere intermeddler, and a reasonable basis for its belief of damage. We therefore conclude that Fiesta has proven its entitlement to bring the opposition and cancellation proceeding.

IV. Priority

Priority is an issue in both the opposition and the cancellation proceeding. To establish priority on a likelihood of confusion claim under Section 2(d) of the Trademark Act, a party must prove by a preponderance of the evidence that, vis-à-

²⁴ *E.g.*, 22 TTABVUE 2-6 (Zertuche Declaration).

vis the adverse party, it owns proprietary rights in “a mark or trade name previously used in the United States . . . and not abandoned” *Threshold.TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1036-37 (TTAB 2010) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981)); *see also Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

In determining priority in the cancellation, under Section 7 of the Trademark Act, a registrant is entitled to rely on the filing date of the underlying application as a constructive use date. 15 U.S.C. § 1057(c); *Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840, 1844 (TTAB 1995) (parties may rely on the constructive use (filing) dates for purposes of priority). Thus, as to Alvarez’s involved registration, he can rely on the underlying application filing date of December 19, 2017. *See* 15 U.S.C. § 1057(b).

In both the cancellation and the opposition, however, Alvarez claims June 2017 as his priority date.²⁵ Specifically, he testified that his licensee, Vacation Store, began using TRSYUCATANHOTEL.COM on June 13, 2017, and began using TRSCORALHOTEL.COM on June 23, 2017.²⁶ These alleged priority dates are consistent with his claimed dates of first use in commerce in his registration and application.

²⁵ 28 TTABVUE 5.

²⁶ *Id.*

In answers to interrogatories, Alvarez stated that Vacation Store made such first uses on the claimed priority dates “in connection with promoting Fiesta Hotels and its resort[s].”²⁷ His declaration includes website screenshots dated December 19, 2017 that display the marks, and he testified that the website use is “the same [as] or substantially similar” to what has been in use since the respective dates in June 2017.²⁸ The declaration provides no other information about the nature and extent of the first use in commerce.²⁹

On cross-examination, when Fiesta’s counsel noted the July 31, 2017 creation date of the “domain name TRSYucatanHotel,” which appears as the URL on the screenshot, and asked Alvarez to “explain how you used the trademark before you registered the domain name,” Alvarez’s reply was unclear:

Again, remember, these are all abbreviated from Royal Suites Yucatan. So we had trademarks already with the Royal Suites Yucatan. Plus, this could have been, I don’t know, their other, how do you call them, domain names that we used as TRS and we probably registered way before that particular date.³⁰

In discovery, when Fiesta requested information regarding the timing, nature and volume of services rendered under Alvarez’s marks, he responded that he “does not have information relating to the total U.S. market and annual sales volume of any such service as that information is in the possession, custody and control of Fiesta

²⁷ 36 TTABVUE 34-35 (Answers to Interrogatories 10 & 11).

²⁸ *Id.*; see also 28 TTABVUE 24-30 (screenshots).

²⁹ 28 TTABVUE 5-6.

³⁰ 45 TTABVUE 17.

and/or third parties, including the booking agents.”³¹ Nonetheless, he identified himself as the person most knowledgeable about “past and/or current use” of the marks.³² Alvarez also indicated that “there are no annual expenditures for advertising or promotion for the services” offered under the challenged marks.³³ Along the same lines, in responding to document requests, Alvarez indicated that subject to his objections, he was “not aware” of any documents evidencing his adoption and earliest use of either challenged mark.³⁴

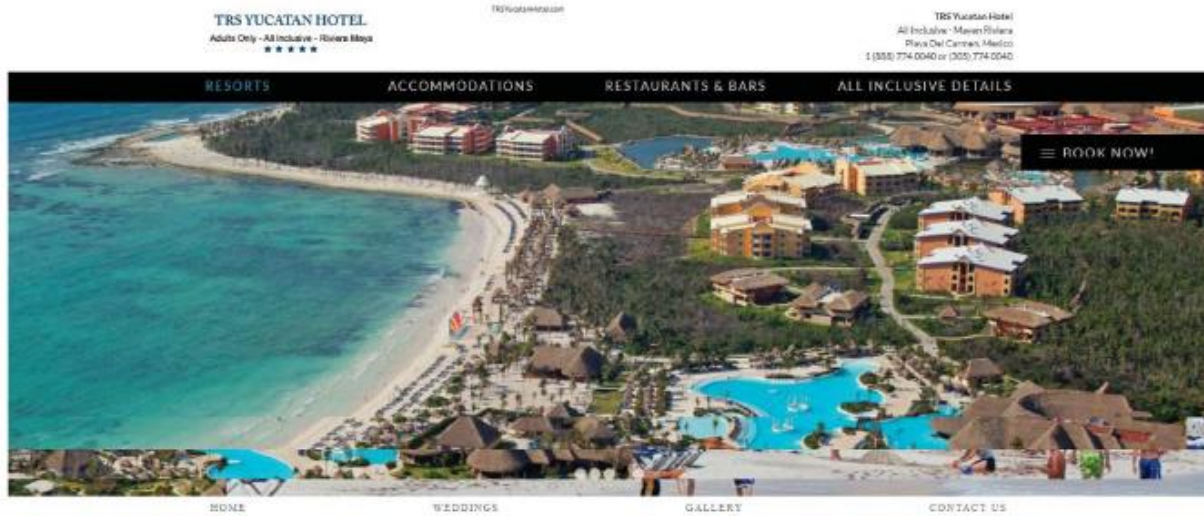
The screenshots from Vacation Store’s websites under the domains matching the challenged marks and featuring the challenged marks in their headings appear below. They exclusively feature and promote Fiesta’s TRS Yucatan and TRS Coral resort hotels, as the excerpts show. These are the only documents offered by Alvarez as support for alleged use in commerce of the challenged marks on the relevant dates.

³¹ 21 TTABVUE 32-33 (Answers to Interrogatories Nos. 4 & 5).

³² 21 TTABVUE 29 (Answer to Interrogatory No. 1).

³³ 21 TTABVUE 33-34 (Answers to Interrogatories Nos. 6 & 7).

³⁴ 21 TTABVUE 72-73 (Responses to Document Requests Nos. 5 & 6).



Welcome to TRSYucatanHotel.com

TRS Yucatan Hotel - All-Inclusive - Adults Only - Riviera Maya

TRS Yucatan Hotel are located in an exclusive area within the Grand Palladium Resorts of the Mayan Riviera. Designed exclusively for adult travelers, our Royal Suites offer guests a new concept in luxury and exclusivity that brings together the best of two worlds; the privacy and personalized service of a small VIP Resort and the unlimited access to the wide array of services available at the neighboring 5-star Grand Palladium Resorts. Let our butler service pamper you... Relax and free yourself from all worries while enjoying an exotic drink on the beach or an exquisite lobster dinner in our exclusive gourmet restaurant. The possibilities are endless at TRS Yucatan Hotel.



TRS Yucatan Hotel offer the facilities and services that will make your stay an unforgettable experience: personal and exclusive treatment, 24hrs private reception, check-in from 3:00pm, check-out by 12:00pm, fax and telephone service, lounge in the reception area offering free international digital and printed press, coffee, snacks, international and premium drinks, wake-up service, laundry service, luggage room, currency exchange, newspapers, outdoor parking, shuttle train connecting all 3 Resorts, ATM machine, ice machine, games room, reading lounge, 2 covered theaters, beauty salon, handicrafts market, doctor in hotel, shopping center, internet cafe, supermarket, photo shop, boutique, souvenir shop, crafts shop, tobacco shop, bookstore, jewelry shop, clothing store, Catholic mass at the GP Colonial Sundays, 5pm.

And close to the resorts, there's a hospital (20km), car rental offices and movie theaters (30km)! *Additional charges.

The All Inclusive Royal Suites Yucatan - Adults Only - All Inclusive

- 90 Royal Junior Suites, 16 Royal Suites and 22 Royal Mayan Suites
- Butler service and 24-hour room service.
- 1 Buffet-style and A la carte restaurant and 2 Bars for the exclusive use of guests staying at TRS Yucatan Hotel.
- 9 A la carte theme restaurants with a great selection of cuisines.
- 5 Buffet-style restaurants and other open-air services.
- 26 Bars located around the complex.
- VIP beach area with Bali beds and waiter service.
- 1 Private pool with built-in jacuzzi and waiter service.
- 7 Freshwater pools and 1 Seawater pool.
- Shuttle golf cart service within the complex.
- First-class Spa & Wellness Center.
- Events and meeting rooms
- Sunset Boulevard Discotheque.
- Free WiFi access for guests staying at the Royal SuitesTurquesa.

ACCOMMODATIONS

All 130 rooms at TRS Yucatan Hotel - All Inclusive Adults Only Resort boast private spa tubs and offer free WiFi and free minibar fees. Furnished balconies and iPod docks are standard, as are plasma TVs with cable channels.

... read more



4/10/2018

TRS Coral Hotel - Cancun, Costa Mujeres - Royal Suites Coral Adults Only All Inclusive

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TRS CORAL HOTEL

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Welcome to TRSCoralHotel.com

The Royal Suites Coral Hotel - Adults Only - All Inclusive - Cancun

The **Royal Suites Coral Hotel** is a new luxury 5-star beachfront hotel designed exclusively for adult escapes. Situated on the idyllic white sandy beach of Costa Mujeres, it offers an all-inclusive and adults-only heavenly getaway. **TRS Coral Hotel** is eco-friendly, made with building materials coming from sustainable resources and with a passionate commitment to the protection of the native species. Half an hour from the town of Cancun and its international airport, **The Royal Suites Coral Hotel** brings together the privacy of a small VIP boutique hotel and a reinvented all-inclusive concept, elevated to a new luxury level.

Guests at **TRS Coral Hotel** will enjoy a profound connection to nature and a special atmosphere of tranquility. Costa Mujeres, known for its idyllic beauty and for the ancient Mayan ruins, has some of the most beautiful beaches in the world. For those who want a little more action, **The Royal Suites Coral Hotel** offers a vibrant nightlife, rich gastronomic offerings, and a wide variety of cultural, leisure and entertainment options, due to its proximity to the city of Cancun and other points of interest in the region.

TRS Coral Hotel boasts 473 luxurious rooms, each with balcony or furnished terrace, hydro massages and stunning views. Dive into the numerous top services offered, like the exclusive swimming pool, spa and gym. Among many others, direct access to the swim-up pools of some suites, private check-in and check-out, national and international newspaper, international à la carte restaurant, a private beach club, transportation of guests inside the resort and free access to the hydrotherapy area are some of the 5-star premium benefits.


TRS Coral Hotel - Adults Only - All Inclusive - Cancun

- 473 luxurious rooms and suites.
- Exclusive international à la carte restaurants.
- 7 themed restaurants, two buffet restaurants and 3 bars.
- Sport Bar open 24 hours.
- Live gastronomic shows.
- Private Beach Club.
- VIP treatment.
- Amphitheatre with 360 degrees visibility.

ACCOMMODATIONS

TRS Coral Hotel - Adults Only - All Inclusive boasts 473 luxurious rooms, each with balcony or furnished terrace, hydro massages and stunning views.

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ACCOMMODATIONS

<http://www.trscoralhotel.com/>

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Fiesta, which alleges prior common law use, bears the burden of proving its claim of prior use by a preponderance of the evidence. *West Florida Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994); *see also Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). Fiesta offered testimony from Mr. Zertuche, its Corporate Commercial and Marketing Director, and Alvarez conducted cross-examination by written questions. In his declaration,³⁵ Mr. Zertuche's testimony included the following:

- Fiesta has marketed “THE ROYAL SUITES branded hotels and related services” in the U.S. since 2014.
- “In 2015, Fiesta began to use the abbreviation TRS in a stylized manner to refer to THE ROYAL SUITES hotels and used the TRS abbreviation on marketing materials consistently since 2015.”
- In connection with rebranding its hotels under the TRS mark, Fiesta filed European trademark applications for marks including TRS on June 7, 2017, Dominican Republic trademark applications for marks including TRS on June 9, 2017, and Mexican trademark applications for marks including TRS on June 8, 2017.³⁶
- In June 2017, Fiesta rebranded its THE ROYAL SUITES hotels under the TRS mark.

³⁵ 22 TTABVUE 2-7.

³⁶ 22 TTABVUE 8-46.

- “In 2017, Fiesta operated only the TRS Turquesa Hotel and TRS Yucatan Hotel properties. The TRS Coral Hotel property was opened in 2018 and was always identified with the TRS brand.”
- “Fiesta’s THE ROYAL SUITES branded hotels and related services are provided in a variety of locations throughout the world, with several locations in the Caribbean, including, hotels now known as TRS Coral Hotel, TRS Yucatan Hotel, TRS Turquesa Hotel, and TRS Cap Cana Hotel.” On cross-examination by written questions, Mr. Zertuche testified that “most of the guests of our Caribbean hotels come from the United States.”³⁷
- Fiesta’s U.S. advertising and promotional expenditures are \$3.8 million for TRS Yucatan 2017-2020 and \$2.4 million for TRS Coral 2018-2020.
- Fiesta registered the domain names trsyucatan.com and trscoral.com on May 30, 2017, trshotelyucatan.com and trshotelcoral.com on June 8, 2017, and trshotels.com on October 16, 2017.

On cross-examination, Mr. Zertuche also testified:

- Fiesta began using TRS in its marketing in 2015, including marketing in the U.S.³⁸

³⁷ 42 TTABVUE 8.

³⁸ 42 TTABVUE 7.

- Fiesta first booked a room at the TRS Yucatan Hotel on June 27, 2017, and first booked a room at that hotel for an individual with a U.S. address on August 3, 2017.³⁹
- Fiesta first booked a room at the TRS Coral Hotel on February 5, 2018, and first booked a room at that hotel for an individual with a U.S. address on February 7, 2018.⁴⁰

The Zertuche Declaration also introduced a number of exhibits that corroborate relevant dates of use. For example, screenshots from Opposer's website Theroyalsuites.com, as launched in June 2017, show Opposer's TRS logos in connection with its hotels.⁴¹ Screenshots from Opposer's website TRSHotels.com, as launched in January 2018, also feature the TRS logo in connection with hotel services.⁴² The declaration exhibits also include website analytics for 2018 to show web traffic from the United States.⁴³ An August 2017 marketing brochure prominently features the TRS logo, also highlights the TRS Yucatan Hotel and indicates that "2018 (Autumn) will see the launch of the Royal Suites Coral Hotel," and contains contact information for the "America Call Center" with a number for use "From USA."⁴⁴ The Zertuche Declaration includes a June 21, 2017 press release to

³⁹ 42 TTABVUE 11.

⁴⁰ 42 TTABVUE 11.

⁴¹ 22 TTABVUE 48.

⁴² 22 TTABVUE 49.

⁴³ 22 TTABVUE 50-51.

⁴⁴ 22 TTABVUE 57-85.

“National Hotel Executive (San Francisco, CA)” announcing the rebranding of The Royal Suites to TRS Hotels and mentioning the TRS Yucatan resort hotel.⁴⁵ Other exhibits feature online travel industry articles from June 2017 about Opposer’s rebranding to TRS Hotels, mentioning TRS Yucatan. For example, one such article is found on the Recommend website directed to travel agents, dated June 20, 2017.⁴⁶ Others are from the Travel Agent Central website,⁴⁷ the Travel and Tour World website,⁴⁸ the Travel Daily News website,⁴⁹ all dated June 20, 2017. A similar article from the Travel Pulse website is dated June 22, 2017.⁵⁰ On cross-examination, Mr. Zertuche also identified a similar publication by Hotel Online dated June 20, 2017,⁵¹ stating that “[i]t was provided by the media agencies we work with in the U.S. market.”⁵²

Ultimately, Fiesta contends that its use of its marks necessarily predates Alvarez’s because Alvarez has conceded his licensee’s **only** use is for booking Fiesta’s referenced hotels, and “without Fiesta offering the hotel services under its marks, there would be no way for Alvarez to offer hotel rooms at these Fiesta hotels, nor any

⁴⁵ 22 TTABVUE 89.

⁴⁶ 22 TTABVUE 98-99 (recommend.com).

⁴⁷ 22 TTABVUE 104-05 (travelagentcentral.com).

⁴⁸ 22 TTABVUE 107 (no URL).

⁴⁹ 22 TTABVUE 109 (no URL).

⁵⁰ 22 TTABVUE 111-12 (no URL).

⁵¹ 42 TTABVUE 126.

⁵² 42 TTABVUE 12.

possible *bona fide* use of the Challenged Marks.”⁵³ According to Fiesta, any prior use of the challenged marks merely constitutes the use of “domains that match the Challenged Marks.”⁵⁴

Alvarez argues that “Fiesta’s generic, non-specific assertions of first use, without more, are insufficient to carry Fiesta’s burden to prove prior use,” pointing to precedent for the proposition that oral testimony to establish priority should not be indefinite.⁵⁵

We find that Fiesta has established priority of use of its marks TRS, TRS YUCATAN, and TRS CORAL HOTEL. In considering the testimony and evidence of priority, “we look at the evidence as a whole, as if each piece of evidence were part of a puzzle which when fitted together, establishes prior use.” *See West Florida Seafood*, 31 USPQ2d at 1663. Fiesta’s testimony and evidence regarding its use is credible and reliable and indicates that at least some marketing of its resort hotel services under the TRS mark occurred in the U.S. prior to 2017, when its hotels still were named “The Royal Suites.”⁵⁶ The numerous press releases and third-party publications promoting the full rebranding from “The Royal Suites” to TRS in June 2017 indicate that Fiesta’s full rebranding, including renaming its hotels, already was underway at that time and was publicized in the U.S.

⁵³ 48 TTABVUE 6 (Fiesta’s Reply Brief).

⁵⁴ *Id.* at 7.

⁵⁵ 47 TTABVUE 11 (Alvarez’s Brief).

⁵⁶ 22 TTABVUE 2-7 (Zertuche Declaration) 42 TTABVUE 7 (Zertuche Deposition).

Meanwhile, Alvarez's declaration and cross-examination testimony, as well as his discovery responses, make clear that his **only** alleged use of the challenged marks, through Vacation Store's websites, has been to book rooms at Fiesta's hotels, now known as the TRS Yucatan Hotel and TRS Coral Hotel.⁵⁷ Alvarez provided screenshots from the Vacation Store websites as the **only** documentary evidence of use of the mark, indicating that the screenshots accurately reflect use the same as or substantially similar to what occurred on his alleged dates of first use (in June 2017).⁵⁸

On their face, the screenshots show that Fiesta's hotel services already were referred to under Fiesta's TRS mark. Specifically, the screenshots refer to Fiesta's "TRS Yucatan Hotel" under the challenged mark TRSYUCATANHOTEL.COM and refer to Fiesta's "TRS Coral Hotel" under the challenged mark TRSCORALHOTEL.COM. The Vacation Store screenshots identify Fiesta's resorts repeatedly by their "TRS" monikers. This further corroborates that Fiesta already was promoting and offering hotel-related services under the TRS marks at that time. And as Mr. Zertuche stated, most of Fiesta's resort hotel customers at its Caribbean locations, which include these properties, were from the U.S.⁵⁹

Ultimately, to the extent Alvarez relies on the Vacation Store website evidence, it does not support his prior use, and to the extent Alvarez relies on his own conclusory

⁵⁷ 28 TTABVUE 6 (Alvarez Declaration); 44 TTABVUE 10-11; *see also* 28 TTABVUE 24-30 (screenshots from trsyucatanhotel.com and trscoralhotel.com).

⁵⁸ 28 TTABVUE 5 (Alvarez Declaration).

⁵⁹ 42 TTABVUE 8.

testimony, we do not find it persuasive to support his prior use. Instead, we find Fiesta's testimony and documentary evidence convincing to demonstrate that its use of its pleaded marks predates use by Alvarez.

Accordingly, Fiesta has priority of use in its pleaded common law marks for its resort hotel services.

V. Likelihood of Confusion Claim

Our determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a 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, hereinafter referred to as "*DuPont* factors"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

If likelihood of confusion exists with respect to either of Alvarez's identified services in its single-class application and single-class registration, the opposition must be sustained and the petition to cancel must be granted. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

A. The Services, Trade Channels and Classes of Consumers

Fiesta's resort hotel services encompass booking rooms for the hotels. Mr. Zertuche testified that Fiesta books rooms for its hotels.⁶⁰ These booking services overlap with, at least, Alvarez's "travel services, namely, making reservations and bookings for temporary lodging," as recited in the opposed application and challenged registration. Because there is no restriction in Alvarez's recitation of "making reservations and bookings for temporary lodging," it is broad enough to encompass Fiesta's reservation services that are part of its resort hotel services. *See In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *4 (TTAB 2020) ("Collagen peptides for use as a nutritional supplement" are a type of "nutritional supplement," subsumed within the broad identification of "dietary and nutritional supplements" in the cited registration, making these goods legally identical); *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.'").

We also find Alvarez's booking services highly related to Fiesta's resort hotel services because the recited booking services are to secure temporary lodging at hotels such as Fiesta's (as the actual marketplace evidence bears out). In addition, Alvarez makes clear that the marks and websites used by his licensee, Vacation

⁶⁰ 42 TTABVUE 11.

Store, are intended exclusively for booking rooms at Fiesta's hotels.⁶¹ The second *DuPont* factor therefore weighs heavily in favor of a likelihood of confusion.

Under the third *DuPont* factor, because the services overlap, we presume as a matter of law that the trade channels also overlap, at least in part. *See Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, "the marketing channels of trade and targeted classes of consumers and donors are the same"); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (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 addition, because Vacation Store uses the marks for bookings at Fiesta's hotels, the channels of trade and classes of consumers necessarily overlap, as those who book reservations under Alvarez's marks would be consumers of Fiesta's resort hotels. While Alvarez suggests in his Brief that we should consider his trade channel to be "exclusively over the Internet,"⁶² one of his recited services is not so restricted, and we therefore cannot read in such a limitation. We cannot consider alleged marketplace realities not reflected in Alvarez's recitations of services. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, "we must

⁶¹ 28 TTABVUE 6 (Alvarez Declaration); 21 TTABVUE 30, 32-33, 41 (Interrogatory Answers).

⁶² 47 TTABVUE 16 (Alvarez Brief).

deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods”). The third *DuPont* factor also weighs heavily in favor of likely confusion.

B. Similarity of the Marks

With respect to the marks, we must compare Alvarez’s TRSYUCATANHOTEL.COM and TRSCORALHOTEL.COM to Fiesta’s TRS, TRS YUCATAN HOTEL and TRS CORAL HOTEL “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs.*, 101 USPQ2d at 1721; *see also Edom Labs. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

Similarity in any one of the elements of appearance, sound, meaning, or commercial impression suffices to support a determination of likelihood of confusion. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion”); *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019). We also bear in mind that, with respect to the legally identical services, when turning to the marks, “the degree of similarity necessary to

support a conclusion of likely confusion declines.” *Century 21 Real Estate v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); *see also Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018).

The marks share very similar wording – particularly comparing TRS YUCATAN HOTEL to TRSYUCATANHOTEL.COM, and TRS CORAL HOTEL to TRSCORALHOTEL.COM. Except for the spaces, the first portions of the respective marks are identical, and the first part of a mark “is most likely to be impressed upon the mind of a purchaser and remembered.” *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); *see also Palm Bay Imps.*, 73 USPQ2d at 1692. We find that the closeness of the wording contributes to the visual similarity of the marks, and even more so, to their similarity in sound and overall connotations, particularly because “the average customer ... retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).

While Alvarez’s marks include the “.COM” gTLD at the end, consumers would not rely on this to distinguish the marks, but instead would perceive it as a non-source-identifying gTLD that gives his marks overall the impression of domain addresses. As the reality of the record reflects, Alvarez’s marks likely would be perceived as website addresses and indicators for services relating to hotels named “TRS Yucatan Hotel” and “TRS Coral Hotel,” which are Fiesta’s marks. Contrary to Alvarez’s arguments, the inclusion or lack of spaces between terms does not distinguish the marks. *See In re Planalytics Inc.*, 70 USPQ2d 1453 (TTAB 2004) (the absence of the

space in GASBUYER does not create a different meaning or perception of the term); *Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEAGUARD and SEA GUARD “are, in contemplation of law, identical”); *Stockpot, Inc. v. Stock Pot Rest., Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff'd*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical”); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”).

As to commercial impression, Fiesta’s marks are effectively subsumed within Alvarez’s, so that Alvarez’s marks give the impression of website addresses and sites with services for Fiesta’s named hotels. The marks overall have similar connotations and commercial impressions because as noted above, consumers would perceive them as Fiesta’s hotel names, on the one hand, and website names and domains for the same hotels, on the other hand.

Given the strong similarity in sound, appearance, and connotation and commercial impression of the marks at issue, the first *DuPont* factor weighs in favor of likely confusion.

C. Conditions of Purchase

Fiesta refers to the fourth *DuPont* factor to argue that the actual conditions of purchase of Alvarez’s recited services involve visiting the Vacation Store websites

that Fiesta contend present themselves as if they were operated by Fiesta.⁶³ We consider this evidence under the thirteenth “catchall” *DuPont* factor, discussed below. The fourth *DuPont* factor is meant to refer to “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. We consider this factor neutral because of the lack of evidence regarding the degree of care of the relevant consumers.

D. Strength of Fiesta’s Marks

Fiesta acknowledges under the fifth *DuPont* factor that it “does not claim its marks are famous in the broad field of hotel services.”⁶⁴ Fiesta contends that the factor should be deemed irrelevant or neutral given the evidence that Alvarez concedes he uses the marks at issue “for the sole purpose” of bookings at Fiesta’s hotels. Alvarez deems this factor “irrelevant” based on Fiesta’s concession that its marks are not famous. We consider the factor neutral.

Fiesta contends that the sixth factor, the number and nature of similar marks in use on similar services, favors likely confusion because there is no evidence in the record of third-party use of any of Fiesta’s pleaded marks. In addressing a similar contention based on the absence of third-party use evidence in *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *15 (TTAB 2020), the Board deemed the sixth factor neutral. We find the factor neutral in this case.

⁶³ Fiesta points to the screenshots of the websites as evidentiary support under this factor.

⁶⁴ 46 TTABVUE 16 (Fiesta Brief).

E. Actual Confusion

Under the seventh and eighth factors, we have insufficient contextual evidence regarding the parties' respective use "such that we could make a finding as to the length of time during and conditions under which there has been concurrent use without evidence of actual confusion." *In re Guild Mortg. Co.*, 2020 USPQ2d 10279 *25 (TTAB 2020). While Fiesta conceded in discovery that it knows of no instances of actual confusion, it posits that the lack of instances may stem from Vacation Store's presentation of its booking websites as if they were Fiesta's, such that consumers would be unaware they dealt with a third party.⁶⁵ Fiesta also points to Alvarez's discovery responses stating that he had no information regarding his U.S. sales or marketing, and had not advertising or promotional expenditures under the marks.⁶⁶ Given the sparse evidentiary record regarding Alvarez's conditions of use under this factor, we consider it neutral.

F. Market Interface

The parties argue about the nature and weight of the market interface under the tenth *DuPont* factor, given the prior history between Alvarez's licensee, Vacation Store, and Fiesta. As noted previously, Alvarez does not have and has never had a direct relationship with Fiesta, and because Fiesta terminated its contractual relationship with Vacation Store in 2016, prior to the alleged first uses of the marks at issue, we find this factor neutral.

⁶⁵ 46 TTABVUE 17 (Fiesta Brief).

⁶⁶ 36 TTABVUE 32-34 (Interrogatory Answers).

G. Right to Exclude

Under the eleventh factor, Fiesta argued that its marks as a whole are distinctive and entitle Fiesta to exclude others. Alvarez argues that Fiesta misunderstands the factor. He claims that his challenged registration gives him “the presumptive and exclusive right to use the mark” and his challenged pending application gives him “a nationwide right of priority,” so that this *DuPont* factor should weigh in his favor.⁶⁷

In the few precedential Board cases discussing the eleventh *DuPont* factor (“the extent to which applicant has the right to exclude others from use of its mark on its goods [or services]”), applicants have failed to show sufficient use of their marks to establish a right to exclude others from use of their marks on their goods or services. *See McDonald’s Corp. v. McSweet LLC*, 112 USPQ2d 1268, 1284-85 (TTAB 2014) (“Applicant’s sales figures and Applicant’s advertising and promotional expenditures are not sufficient to establish an appreciable level of consumer recognition.”) (citing *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1205 (TTAB 2009) (the mere assertion of common-law use of its mark for ten years is not sufficient)). Given the absence in the record in this case of any such significant information about advertising and sales under the marks, we consider this factor neutral.

H. Other Evidence Probative of the Effect of Use

Under the thirteenth “catchall” factor considering any other evidence probative of the effect of use, we consider the testimony and evidence that Alvarez’s use of his

⁶⁷ 47 TTABVUE 15-16.

marks (through Vacation Store) is intended to refer to Fiesta's hotels.⁶⁸ We agree with Fiesta's assessment that consumers, when viewing the websites in the screenshots Alvarez provided as representative of use of his marks, likely would believe they are Fiesta's websites for its TRS Yucatan Hotel and TRS Coral Hotel. Without the need to reach Fiesta's assertion of bad faith, we find that the nature of Alvarez's use that deliberately points to and relates to Fiesta's hotels significantly increases likely consumer confusion.

I. Conclusion that Confusion Is Likely

Based on the similarity of the marks, the overlap in the services, trade channels and consumers, and Alvarez's intentional use of his marks to refer to Fiesta's similarly-named hotels, the relevant *DuPont* factors weigh in favor of likely confusion under Trademark Act Section 2(d) as to both of Alvarez's challenged marks.

VI. Defenses

Alvarez argues that acquiescence and equitable estoppel bar Fiesta's claims. Trademark Act Section 19, 15 U.S.C. § 1069, provides that "[i]n all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable, may be considered and applied." For the acquiescence defense, the following elements must be met: (1) that the claimant actively represented that it would not assert a right or a claim; (2) that the delay between the active representation and assertion of the right or claim was not excusable; and (3) that the

⁶⁸ *E.g.*, 28 TTABVUE 6 (Alvarez Declaration); 36 TTABVUE 30, 32-33, 41 (Interrogatory Answers).

delay caused the defendant undue prejudice. *Hitachi Metals Int'l, Ltd. v. Yamakyu Chain Kabushiki Kaisha*, 209 USPQ 1057 (TTAB 1981).

For the equitable estoppel defense, the following elements must be met: (1) misleading conduct, which may include not only statements and action but silence and inaction, leading another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted. *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992).

Both defenses therefore involve a plaintiff's delay in objecting to a defendant's conduct. However, because inter partes proceedings before the Board concern registration rights arising only through the registration process, the potential delay time can begin to run only when the application or underlying application in question was published for opposition, even when the plaintiff was aware of the defendant's use earlier. See *Brooklyn Brewery Corp. v. Brooklyn Brew Shop*, 17 F.4th 129, 2021 USPQ2d 1069, at **8 (Fed. Cir. 2021) ("Laches and acquiescence are generally not available as defenses in an opposition proceeding, given that the clock for laches begins to run from the date the application is published for opposition"); *Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1580 (TTAB 2015) ("If there is actual knowledge of a defendant and its mark prior to publication for opposition, the date of publication is the operative date for laches."); *Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789 (TTAB 2009) (Laches begins to

run when the mark is published for opposition; because opposer timely filed opposition, there can be no laches defense, even assuming that opposer knew of applicant for 20 years); *see also Lincoln Logs, Ltd.*, 23 USPQ2d 1701 (same principle applies to the defense of equitable estoppel). This rule effectively eliminates the defenses in opposition proceedings, except where the defense is based on the opposer's failure to object to an applicant's earlier "registration of substantially the same mark." *Brooklyn Brewery Corp.*, 2021 USPQ2d 1069, at **8.

Alvarez's Brief vaguely asserts that "Fiesta and its predecessors have been aware of Vacation Store's use of websites and trademarks in connection with advertising and selling rooms at Fiesta's and its predecessors' hotels and resorts" over a couple of decades,⁶⁹ but Alvarez makes no assertion that the other marks are "substantially the same mark" as either of the marks at issue in this proceeding. He testified about and provided evidence of his ownership of trademark registrations for RoyalSuitesTurquesaResort.com and RoyalSuitesYucatanResort.com that he licenses to Vacation Store "in connection with offering to sell rooms to those Palladium resorts."⁷⁰ He attached to his declaration a June 23, 2017 communication from Palladium to Vacation Store that refers to those website addresses,⁷¹ which Alvarez contends "reflects Palladium's knowledge of and consent to Vacation Store's

⁶⁹ 47 TTABVUE 19 (Alvarez Brief).

⁷⁰ 28 TTABVUE 3-4, 8-18.

⁷¹ 28 TTABVUE 20-22.

use of RoyalSuitesTurquesaResort.com and RoyalSuitesYucatanResort.com to sell rooms to [sic] those resorts.”⁷²

On cross-examination, Mr. Zertuche agreed that “Fiesta and its predecessor Palladium have been aware of the use [by Vacation Store] of websites at www.RoyalSuitesTurquesaResort.com and www.RoyalSuitesYucatanResort.com since in or around August 2008.”⁷³ However, we find that these marks are not substantially the same as the marks at issue in this proceeding.

Mr. Zertuche testified that Fiesta’s contractual relationship with Vacation Store ended in 2016, and it never received a request from Alvarez to register the marks at issue in this proceeding. According to Mr. Zertuche, Fiesta sent the June 2017 communication to Vacation Store as a notification of rebranding because its “email addresses were left on Fiesta’s travel partner list even though there was no longer a contract with Vacation Store after 2016.”⁷⁴ The communication does not contain or refer to an authorization to use any marks.⁷⁵

Ultimately, conduct in relation to other marks does not form the basis for acquiescence or equitable estoppel with respect to the marks before us, and we find no basis for deeming the other marks substantially the same as those at issue here. Thus, as to Fiesta’s timely-filed opposition proceeding, no exception to the general

⁷² 28 TTABVUE 4.

⁷³ 42 TTABVUE 7.

⁷⁴ 28 TTABVUE 4.

⁷⁵ 28 TTABVUE 20-22.

rule applies, and Alvarez's acquiescence and equitable estoppel defenses fail in the opposition.

Turning to the cancellation, and again measuring the potential delay based on the registration process, the mark in the subject registration published for opposition on May 8, 2018, and Fiesta filed its Petition for Cancellation on January 7, 2019. This seven months of delay is minimal, and does not rise to the level of unfair delay that would give rise to acquiescence or equitable estoppel. *See, e.g., Charrette Corp. v. Bowater Comm'n Papers, Inc.*, 13 USPQ2d 2040 (TTAB 1989) (14 months of delay held not sufficient for defense of laches).

In addition, the defenses would fail regardless, because Alvarez makes only a conclusory statement that he "will be materially prejudiced"⁷⁶ and points to no evidentiary support for the requisite prejudice under either defense. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) ("Attorney argument is no substitute for evidence.") (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005)); *In re Simulations Pubs., Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) ("Statements in a brief cannot take the place of evidence."). The mere continued use of the marks, even if true, does not suffice to show undue or material prejudice. *Schiedmayer Celesta GmbH v. Piano Factory Grp., Inc.*, 2019 USPQ2d 341894, *11-12 (TTAB 2019) (rejecting laches defense despite 7.5 years of delay where "[t]he entirety of [Respondent's] argument that they have suffered material prejudice is 'the Respondent sold and rented

⁷⁶ 47 TTABVUE 21 (Alvarez Brief).

SCHIEDMAYER branded pianos continuously for seven years,” finding that “Respondents have not shown any meaningful economic or other damage resulting from Petitioner’s delay....”), *aff’d*. 11 F.4th 1363, 2021 USPQ2d 913 (Fed. Cir. 2021); *Hornby v. Tjx Cos.*, 87 USPQ2d 1411, 1419 (TTAB 2008) (unsupported claim that during the five-year period of delay respondent invested in and built up goodwill in its mark was not sufficient to support a laches defense).

Thus, Alvarez’s acquiescence and equitable estoppel defenses fail in both the opposition and cancellation proceeding.

VII. Conclusion

Fiesta has proven its likelihood of confusion claims in the opposition and the cancellation. Alvarez has not established his asserted affirmative defenses.

Decision: The opposition to Application Serial No. 87874585 is sustained. The petition to cancel Registration No. 5524373 is granted.