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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 11
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Eldorado Resorts LLC**

Serial No. 75/876,193

Bonnie Drinkwater of McDonald Carano Wilson McCune Bergin Frankovich & Hicks LLP for Eldorado Resorts LLC.

Brett Toplin, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Cissel, Bucher and Drost, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 21, 1999, applicant filed the above-referenced application to register the mark "BUBINGA" on the Principal Register for "Casino services," in Class 41, and "nightclub services and bar and restaurant services," in Class 42. The application was based on applicant's assertion of its intention to use the mark in commerce in connection with these services.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that the mark applicant seeks to register so resembles the identical mark "BUBINGA," which is registered¹ for "clothing, namely, shirts, sweat shirts, pants, sweaters, jackets and shorts; headwear, namely, hats, beanies and caps; footwear, namely, tennis shoes, sneakers and boots," in Class 25, that confusion would be likely if applicant were to use the mark it seeks to register in connection with the services specified in the application.

Submitted in support of the refusal to register were copies of five third-party federal trademark registrations, all on the Principal register and all based on use. One lists both "restaurant services" and "retail store services in the field of clothing." Each of the other four third-party registrations lists both restaurant services and specific clothing items as the goods and services with which the particular mark is used. For example, one lists "restaurant, bar and cocktail lounge services" along with "clothing, namely, caps, jackets, t-shirts, and shirts." Another lists "restaurant and bar services" along with "clothing, namely t-shirts, pants, shorts and sweat

¹ Reg. No. 2,343,555, issued on the Principal Register to Ronald H. Gilchrist on April 18, 2000.

shirts." The Examining Attorney argued that this evidence shows that restaurants and bars also market collateral clothing products under the same marks they use for their primary services.

Applicant amended the application to allege use of the mark in commerce on December 24, 1999. Applicant also argued that confusion with the cited registered mark is not likely. Included with applicant's argument were copies of pages from the website of the owner of the cited registration. From this evidence, applicant deduced that registrant uses the mark in connection with skateboards, skateboard accessories and clothing related to skateboarding, and concluded that confusion is not likely because registrant's goods are not related to the services applicant renders under the mark it seeks to register, and because the customers and trade channels for applicant's services are not the same as those for registrant's skateboard-related apparel.

The Examining Attorney was not persuaded by applicant's arguments, and in the second Office Action, the refusal to register was made final. Applicant timely filed a Notice of Appeal, and both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before this Board.

Based on careful consideration of the record in this application and in view of established legal precedent, we conclude that the Examining Attorney has met his burden of proof in establishing that confusion is likely.

In the case of *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among those factors are the similarity of the marks and the similarity of the goods or services as set forth in the application and the cited registration, respectively.

In the case at hand, the record before us shows that the marks are virtually the same, and services specified in the application are related to the goods set forth in the cited registration in such a way that the use of identical marks in connection with both is likely to cause confusion.

When the marks in question are the same, the goods or services with which they are used ordinarily do not have to be as closely related in order to find confusion likely as would be a case if there were differences between the marks. *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70 (TTAB 1981). In the instant case, however, the record establishes that the services set forth in the application and the goods identified in the registration can be

expected to emanate from a common source when the same mark is used in connection with both. The third-party registrations made of record by the Examining Attorney show that restaurant and bar businesses have registered their marks for a variety of clothing items. The third-party registrations made of record by the Examining Attorney have probative value to the extent that they serve to suggest that such goods and services emanate from the same source. See: *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Co.*, 6 USPQ2d 1467 (TTAB 1988). Applicant acknowledges (appeal brief, p.5) that some restaurants and night clubs sell clothing in connection with their services. That casinos also do so is an equally reasonable conclusion. In the instant case, just as in *Mucky Duck*, supra., the fact that the mark is "unique and memorable" bolsters the likelihood of confusion. Plainly, the use of the identical mark in connection with these related goods and services is likely to cause confusion.

Applicant makes several unpersuasive arguments to the contrary. One is that the marks create different commercial impressions because the registered mark is shown in highly stylized form on registrant's website. It is well settled, however, that unless the registration presents the mark of the registrant in special form, the

rights of the registrant are not limited to any particular presentation of the registered mark. In the case at hand, the cited registration shows "BUBINGA" in all capital letters in an ordinary type font which is very similar to the presentation of applicant's mark in the drawing applicant submitted with the application. Applicant's mark is virtually identical to the registered mark, notwithstanding the fact that registrant may use his mark in a very stylized form.

Another unpersuasive argument made by applicant is that we should consider the clothing items specified in the registration to relate to skateboards, skateboard accessories and clothing related to skateboarding. As the Examining Attorney points out, however, whether confusion is likely must be determined based on the goods or services the as they are identified in the application and the cited registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Restrictions or limitations which are not reflected in the registration or application cannot be considered. *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340 (TTAB 1983).

Applicant's argument that confusion is not likely because there is no evidence that actual confusion has occurred is also not well taken. Such evidence is

notoriously difficult to obtain, and is not required in order to sustain the Examining Attorney's burden of establishing that confusion is likely. We have no idea whether there has even been a realistic opportunity for confusion to have occurred. *Cunningham v. Laser Golf Corp.*, 222 F.3rd 943, 55 USPQ2d 1842, (Fed. Cir. 2000); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

In summary, the third-party registrations made of record by the Examining Attorney establish that consumers of applicant's "BUBINGA" restaurant and bar services have a reasonable basis upon which to assume that the use of the same distinctive, arbitrary mark in connection with the clothing items set forth in the cited registration is an indication that both the goods and services emanate from the same source. If we had any doubt as to this conclusion, such doubt would necessarily be resolved in favor of the registrant and prior user. *J & J Snack Foods v. McDonalds Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).

Accordingly, the refusal to register based on Section 2(d) the Lanham Act is affirmed.