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Mailed: January 23, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Aztar Corporation
and
Tropicana Entertainment, LLC[1]
v.
Recaredo Guitierrez

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Cancellation No. 92044788
to Registration No. 2939905
issued on April 12, 2005

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W. Mack Webner, Gary D. Krugman and Leigh Ann Lindquist of Sughrue, Mion, Zinn, Macpeak & Seas for Aztar Corporation and Tropicana Entertainment, LLC.

Edward S. Coleman and Jesus Sanchelima of Coleman Law Associates for Recaredo Guitierrez.

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Before Seeherman, Walters and Drost, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

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[1] The registrations pleaded and established by petitioner were assigned to Tropicana Entertainment, LLC on September 12, 2007 and the assignment was recorded with the USPTO on September 13, 2007. Therefore, the proceeding is amended, sua sponte, to add Tropicana Entertainment, LLC as a party plaintiff, and this change is reflected in the case heading. However, we refer to plaintiffs throughout the body of the opinion in the singular as "petitioner."

Aztar Corporation filed a petition to cancel the registration of Recaredo Guitierrez for the mark TROPICANA ALL STARS for "entertainment services in the nature of a live musical group," in International Class 41.[2]

As grounds for the petition, petitioners assert that respondent's mark, when applied to respondent's services, so resembles petitioner's previously used and registered mark TROPICANA for "casino services"[3] and "entertainment services, namely, presenting live musical, dance, drama and vocal shows and movie theatre services" and "hotel and restaurant services"[4] as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Respondent, in his answer, denied the salient allegations of the claim.[5]

The Record

The record consists of the pleadings; the file of the involved registration; certified status and title copies of Registration Nos. 1572514 and 1530186 and various specified responses of respondent to petitioner's interrogatories, all

[2] Registration No. 2939905, issued April 12, 2005.

[3] Registration No. 1572514, issued December 19, 1989, in International Class 41. Renewed. Section 15 affidavit acknowledged.

[4] Registration No. 1530186, issued March 14, 1989, in International Classes 41 and 42, respectively. Sections 8 and 15 affidavits accepted and acknowledged, respectively.

[5] Respondent requested an award of attorneys' fees and costs. However, not only has respondent not prevailed in this proceeding before the Board, but the Board is not authorized to grant monetary awards.

made of record by petitioner's notice of reliance; the testimony deposition by petitioner of Kathleen M. Bogen, vice president of property marketing at the Tropicana Resort Casino Las Vegas, a wholly-owned subsidiary of petitioner Aztar Corporation, with accompanying exhibits; the responses of petitioner to respondent's interrogatories, made of record by respondent's notice of reliance; and the testimony deposition by and of respondent, Recaredo Gutierrez. Both parties filed briefs on the case.

Factual Findings

Respondent admits that petitioner "does business across the United States, operating two casinos." (Brief, p. 4.) Petitioner has two Tropicana Resort & Hotel ("TROPICANA") locations, in Las Vegas, Nevada, and Atlantic City, New Jersey. The TROPICANA opened using this name in Las Vegas in 1957 and in Atlantic City in 1981. Use of the TROPICANA name has been continuous since the first use in connection with each of the properties. The Las Vegas property has 1800 rooms and the Atlantic City property has 2120 rooms. Clientele include people from all states within the United States and from outside the United States. The Las Vegas property and the Las Vegas Sahara Hotel, where respondent's orchestra has performed, are direct competitors with similar room rates and demographics.

Both of petitioner's locations offer hotel rooms, restaurants, nightclubs, lounges, spas, swimming pools, casinos, fitness facilities, retail establishments, exhibitions, production shows, and various types of entertainment, including musical entertainment in the form of karaoke and concerts by individual performers and bands. Entertainment includes Latin bands and salsa dancers. The musical entertainment is an important part of petitioner's resort business because it is intended to keep people on the property and, presumably, in the casinos.

Petitioner's resorts, as well as the scheduled entertainment offered at the resorts, are advertised in various print media, television (locally and nationally), radio and on the internet. Each of the resorts issues weekly press releases listing the coming week's scheduled entertainment. Both resorts do extensive advertising and promotions locally, both inside and outside of the resorts. Petitioner submitted, under a protective order, figures showing, for each of the properties, annual gross revenues, promotional revenues, and advertising expenses for the period 2001 through 2005. Suffice it to say, these figures are substantial.

Respondent, through his corporations, is the producer of, and performer in, an orchestra named the TROPICANA ALL STARS. Respondent often uses the phrase "Tropical Passions"

in connection with the orchestra name. The orchestra has a "big band" sound and performs Cuban music primarily from the 1950's. The orchestra's first public performance was May 18, 2003 at the Tropigala club of the Fontainebleau Hilton Hotel in Miami Beach, Florida. The majority of the orchestra's performances have been in the Miami/Miami Beach area; however, the orchestra performed in Los Angeles, California on October 11, 2003 and in Las Vegas at the Hilton Hotel for the last week in December 2004. The orchestra's last public performance prior to trial was in June 2005 at the Sahara Hotel in Las Vegas, Nevada. At the time of trial, Mr. Gutierrez testified that the orchestra was recording a CD for national distribution. In 2003, the orchestra received four American and Latin Grammy Award nominations. When performing in Las Vegas and in Miami, respondent has promoted the orchestra through many forms of advertising, including newspapers, magazines, radio, television and the internet. Mr. Gutierrez stated that he personally chose the name of the orchestra; that he chose TROPICANA to evoke the purportedly well known Tropicana Cabaret in Havana, Cuba, which he states is still in operation; and that, at the time he chose this name, he was aware of the Tropicana Resort and Casino in Las Vegas.

Analysis

Because petitioner has properly made its pleaded registrations of record, we find that petitioner has established its standing in this cancellation proceeding. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Next, we must determine the question of priority. In a cancellation, petitioner does not necessarily have priority simply because it owns a registration. *Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). In this case, petitioner first used TROPICANA in 1957, and the filing dates of the applications which matured into its pleaded registrations predate respondent's established date of first use of May 18, 2003, and the January 8, 2004 filing date of his service mark application which issued into the subject registration. Thus, petitioners have clearly established their priority.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company,*

Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods or services and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also In re Azteca Restaurant Enterprises, Inc.,* 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We consider, first, the respective services of the parties and, in connection therewith, the trade channels and classes of purchasers. The question of likelihood of confusion must be determined based on an analysis of the services recited in the subject registration vis-à-vis the services recited in petitioners' registrations, rather than what the evidence shows the services actually are. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). *See also, Octocom Systems, Inc. v. Houston Computer Services, Inc.,* 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that the services need not be identical or even competitive in order to support a finding

of likelihood of confusion. Rather, it is enough that the services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

There is no question that both parties' registrations recite musical entertainment services.[6] Furthermore, the evidence establishes that respondent's musical entertainment services include live musical performances by a Latin big band orchestra and that petitioner's musical entertainment services include live musical performances by a wide variety of performers. While petitioner's services identified in its registrations are much wider ranging than those of respondent, the parties' musical entertainment services are legally identical. Petitioner has also shown that its additional recited services, casino services and hotel and

[6] Only petitioner's Registration No. 1530186 includes musical entertainment services.

restaurant services, are closely related to musical entertainment services. The evidence establishes that both casinos and restaurants often offer live musical entertainment in connection therewith.

We are not persuaded otherwise by respondent's contention that the services of the parties are different because "petitioner is first and foremost a casino," "a venue," whereas, respondent is "an **actual** group," "a very specific *Latin* group, direct[ed] solely at the *Latin* community." (Brief, pp. 4-5, emphasis in original.) This is a distinction without a difference in the context of our likelihood of confusion analysis.

Regarding trade channels and classes of purchasers, respondent argues that the respective trade channels are different because petitioner operates its hotels and casinos in Las Vegas, Nevada, and Atlantic City, New Jersey, and respondent "does business almost exclusively in Miami, Florida, and caters almost exclusively to the Spanish/Cuban community performing orchestra style music." (Brief, p. 4.) However, neither party's identification of services is restricted as to the geographic scope of services, channels of trade or classes of purchasers; thus, we presume that the services would be offered in all ordinary trade channels for these goods and to all normal classes of purchasers for the services identified. *See Canadian Imperial Bank v. Wells*

Fargo, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). In fact, both parties render their services to the general consumer and have, on at least one occasion, rendered their identical entertainment services in Las Vegas in similar settings to similar audiences. In other words, we conclude that the channels of trade and class of purchasers of the parties' services are the same.

Petitioner states that its mark is famous and entitled to a broad scope of protection; and that the record contains no viable or relevant evidence of third-party use of TROPICANA. Respondent admits that "The Tropicana Hotel & Casino is a famous place, with fame within its marketplace" (brief, p. 6), but argues that use of the word "tropicana" is "extremely common" (id.) among various businesses, and, thus, no confusion as to source is likely among the general public when both parties continue to use their respective marks. Although respondent, in cross examining petitioner's witness, Ms. Bogen, referred to alleged third-party uses of the term TROPICANA, respondent did not properly make of record any evidence of third-party use or registration of this term. Beyond revenues and advertising expenditures, the record contains no evidence indicative of consumer awareness of petitioner's mark in connection with the identified services. However, in view of petitioner's

evidence of substantial revenues and sums spent in promoting its services, along with respondent's concession that petitioner's mark is famous "in its marketplace," we conclude that petitioner's TROPICANA mark is well known in connection with the identified services and, thus, entitled to a broad scope of protection.

Turning our consideration to the marks involved, while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.,* 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Respondent argues that the marks are different, suggesting that the Board should consider petitioner's mark to be THE TROPICANA HOTEL & CASINO, and that the marks are further distinguished because respondent always uses the phrase "Tropical Passions" above the name of the group "The Tropicana All-Stars Orchestra." Respondent contends that "the word tropicana has historically been associated with Latin music … [and it] is not as closely associated with

'hotel and casino' and all the services therewith, as petitioner would like this Board to believe." (Brief, p. 5.) However, petitioner's registrations are for the mark TROPICANA. Thus, this is the mark that we consider and it is a strong mark.[7] There is no evidence in the record that TROPICANA is a term that is particularly connected with Latin music. We agree with petitioner that respondent has merely taken its entire mark and added additional, less dominant, matter; and that the ALL STARS portion of respondent's mark is likely to be perceived as laudatory. The fact that respondent may use the phrase "tropical passions" in its advertising is not relevant herein as we must consider the mark that respondent has registered, i.e., TROPICANA ALL STARS. We find that the marks are sufficiently similar that, if used in connection with similar services, confusion as to source is likely.

Respondent complains that petitioner is improperly seeking a "monopoly" on the word "tropicana" for all "musical, entertainment, lodging, catering, fitness, spa or lounge business **anywhere in the United States**." (Id., emphasis in original.) We are concerned herein with determining likelihood of confusion in relation to

[7] Even if we consider petitioner's use of TROPICANA with the words "Hotel and Casino," these words are merely descriptive in connection with the identified services, whereas TROPICANA, in addition to being the first term in the phrase TROPICANA HOTEL AND CASINO, appears to be arbitrary in connection therewith. Therefore, TROPICANA is clearly the dominant term.

petitioner's mark TROPICANA for the services identified in its registrations. We remind respondent that these federal registrations are national in scope.

In a cancellation proceeding, "a presumption of validity attaches to a service mark registration, and the party seeking cancellation must rebut this presumption by a preponderance of the evidence." *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ 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) ("[I]n a [trademark registration] cancellation for abandonment, as for any other ground, the petitioner bears the burden of proof. Moreover, the petitioner's burden is to establish the case for cancellation by a preponderance of the evidence"). We hold that petitioner has met its burden. We conclude that in view of the substantial similarity in the commercial impressions of petitioner's well known mark, TROPICANA, and respondent's mark, TROPICANA ALL STARS, their contemporaneous use on the same and closely related services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

Decision: The petition to cancel is granted.