

From: Corwin, Charlotte K.

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Subject: U.S. TRADEMARK APPLICATION NO. 76518748 - 5 WISHES - N/A -  
Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

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Files: 76518748.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76518748

**MARK:** 5 WISHES



**CORRESPONDENT ADDRESS:**

RYAN GILE  
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7251 W LAKE MEAD BLVD SUITE 530  
LAS VEGAS, NV 89128

**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** Miami Tribe of Oklahoma Business  
Develop ETC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:**

Applicant is requesting reconsideration of a final refusal issued/mailed February 16, 2010.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Attached to its request, applicant submitted a list of registrations for various other gaming machine marks. However, the mere submission of a list of registrations or a copy of a private company search report does not make such registrations part of the record. *See, e.g., In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996).

To make third party registrations part of the record, an applicant must submit copies of registrations from USPTO records only. *E.g., In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); TBMP §1208.02; TMEP §710.03.

Notwithstanding this, evidence of numerous gaming mark applications and registrations is irrelevant. The voluminous filings for marks in connection with gaming machines, including marks incorporating numbers and the word “WISH” only highlights how few “WISHES” marks exist for these goods and demonstrates that the term “WISHES” is strong and not dilute for such goods. Note that the “WISHES” marks attached to the request for reconsideration all have a very distinct commercial impression and are not at all similar to applicant’s mark and the cited registrations. With the request, applicant presents a brief argument regarding registrant’s failure to oppose such “WISHES” registrations. This argument is irrelevant to an ex parte determination of likelihood of confusion between applicant’s mark and the registered marks.

Applicant’s added argument regarding an absence of actual confusion is also not compelling. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); e.g., *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant’s assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

*In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

Applicant lastly argues that the extent of possible confusion is “*de minimus*.” Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Accordingly, applicant’s request for reconsideration is *denied*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. §2.64(b); TMEP §715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

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**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.