

THIS OPINION IS NOT A
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Mailed:
December 18, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Mark F. McInerney

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Serial No. 76704063

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Paul M. Denk for applicant.

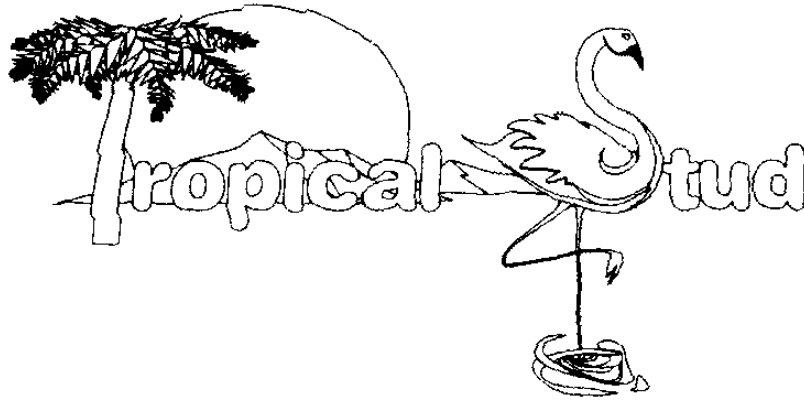
Melissa Vallillo, Trademark Examining Attorney, Law Office 113 (Odette Bonnet,
Managing Attorney).

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Before Quinn, Wolfson, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On August 9, 2010, Mark F. McInerney filed an intent-to-use application to register the mark TROPICAL HOLD EM (in standard characters). As amended, the phrase “HOLD EM” is disclaimed, and the goods are identified as “equipment sold as a unit for playing a card game within a casino,” in International Class 28.

The trademark examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that applicant’s mark, when used in connection with applicant’s goods, so resembles the previously registered mark TROPICAL STUD and design:



with “STUD” disclaimed, for “poker games” in International Class 28,¹ as to be likely to cause confusion.

When the refusal was made final, applicant timely appealed, and his request for reconsideration was denied. Applicant and the examining attorney filed briefs.

Analysis

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *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.”). We discuss each of the *du Pont* factors as to

¹ Registration No. 3042251, issued January 10, 2006. On February 27, 2012, registrant’s Sections 8 and 15 combined declaration of use and incontestability was accepted and acknowledged.

which applicant or the examining attorney submitted argument or evidence. To the extent that any other *du Pont* factors for which no evidence or argument was presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Marks

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of “the marks in their entirety as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d*, No. 92-1086 (Fed. Cir. June 5, 1992).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a

whole in determining likelihood of confusion.”). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, 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 a consideration of the marks in their entireties. *In re Nat’l Data Corp.*, 224 USPQ at 751.

Here, applicant’s mark is TROPICAL HOLD EM, with HOLD EM disclaimed, while the literal element of the prior registered mark is TROPICAL STUD, with STUD disclaimed. It is well-settled that disclaimed, descriptive or generic matter may have little or no significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 752); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

With her Office action of November 27, 2010 and final Office action of June 22, 2011, the examining attorney submitted screenshots from an online poker glossary, an online poker dictionary, and the online Encarta® World English

Dictionary (North Am. ed. 2009) defining “stud” and “hold ’em”² as the names of two poker games. Thus, applicant’s mark and the wording of the prior registered mark feature the same structure, that is, the identical arbitrary and distinctive word TROPICAL followed by the generic name of a poker game. The significance of the word “TROPICAL” as the dominant element of both marks is further reinforced by its location as the first part of each mark. *See Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (noting that “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *see also Palm Bay Imports Inc.*, 73 USPQ2d at 1692; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

We recognize that the prior registered mark incorporates a prominent design component. However, a number of our cases “reflect the principle that if a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services.” *M.C.I. Foods, Inc. v. Brady Bunte*, 96 USPQ2d 1544, 1551 (TTAB 2010). We find that the wording of the prior registered mark is the dominant part of that mark, particularly given that two of the largest design elements – the palm tree and flamingo – form the initial letters of the words TROPICAL and STUD, respectively, thus emphasizing the wording as the dominant portion of the mark. *See In re Strathmore Prods., Inc.*, 171 USPQ 766, 767 (TTAB 1971) (stating that for

² Sometimes spelled “hold em,” “hold’em,” or “holdem” in the record evidence.

composite marks including a word and a design, which of the two features dominates the mark is usually controlling in determining likelihood of confusion). Moreover, the palm tree and flamingo designs, being “tropical” in nature, serve to reinforce the word TROPICAL in the registered mark, which is the portion that is common in both marks.

For all of the reasons discussed above, we find applicant’s mark TROPICAL HOLD EM to be more similar than dissimilar to the cited mark TROPICAL STUD and design in appearance, sound, connotation, and commercial impression.³ Therefore, the first *du Pont* factor supports a conclusion that confusion is likely.

B. Similarity of the Goods and Channels of Trade

We turn next to the similarity of the goods and their channels of trade, the second and third *du Pont* factors, respectively. The goods need not be identical or even competitive in order to support a finding of a likelihood of confusion. Rather, it is enough that the goods 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

³ We have given no consideration to the third-party registrations mentioned in applicant’s appeal brief, to which the examining attorney objected. It is well-established that the Board does not take judicial notice of third-party registrations during the course of an appeal. *See* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1208.02 (3d ed. rev. 2012) and cases cited therein. To be made of record, a copy of any such registration must be submitted during prosecution/examination of the application; mere listings are insufficient. *Id.* In addition, Trademark Rule § 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal. We hasten to add, however, that such third-party registrations would not change our decision.

producers of each of the parties' goods. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978).

The goods in the prior registration are “poker games,” and the registration is unrestricted. Following final refusal, applicant amended his goods identification by adding the phrase “within a casino.” Applicant’s identified goods, “equipment sold as a unit for playing a card game within a casino,” encompass equipment for use in playing any type of card game within a casino, including equipment used for playing “poker games.” Indeed, applicant states that he uses his mark “in the promotion of the specific card game, the [sic] ‘Hold Em’, and markets the game specifically to casinos, under license, to use in its gambling business.” Appeal Brief at 6. As discussed above, the evidence establishes that “hold em” is a poker game.⁴ Applicant’s equipment thus is intended to be used to play a poker game.

⁴ In addition to the dictionary definitions already noted, the examining attorney submitted a Yahoo! dictionary definition of “poker” as: “Any of various card games played by two or more players who bet on the value of their hands.” The examining attorney also submitted screenshots from websites offering poker equipment, including poker sets featuring decks of cards, many of which reference casino-style games and equipment, particularly poker chips. This evidence demonstrates that poker is a card game, that some equipment for playing card games is used to play poker, and that poker is commonly played in casinos. The examining attorney also submitted four third-party registrations covering both “equipment sold as a unit for playing a card game” and poker equipment. These registrations show that applicant’s and the prior registrant’s goods are of a kind that may emanate from a single source under a single mark. *In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009). Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the identified goods are products which are produced and/or marketed by a single source under a single mark. *See Venture Out Props. LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1893 (TTAB 2007).

Registrant's goods, "poker games," are not limited and encompass poker games for playing within a casino. Thus, the goods are legally identical.

Applicant argues that the respective goods may travel in separate channels of trade because he attempts to license his equipment wholesale to casinos, which are sophisticated purchasers (*du Pont* factor four⁵), while the registrant's mark is used "to identify a card game" for customers at the retail level. *See* Appeal Brief at 7-9.

We are not persuaded by this argument. Because the identification in the cited registration contains no limitations, it is presumed to encompass all goods of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). We are bound by the identification as written in the registration and cannot limit registrant's goods, channels of trade, or classes of customers to what any evidence shows them to be. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986) ("It is well settled that in a proceeding such as this, the question of likelihood of confusion must be determined by an analysis of the marks as applied to the goods identified in the application vis-a-vis the goods recited in the registration, rather than what extrinsic evidence shows those goods to be.").

⁵ Even assuming that applicant's purchasers are sophisticated when it comes to their buying decisions, sophisticated purchasers are not immune from source confusion, especially in cases involving similar marks and closely related goods. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988).

The evidence demonstrates that casinos are a normal channel of trade for poker games. Marks used for such games may be encountered by those who buy poker equipment for casinos. The registrant's goods are unrestricted and therefore may be marketed to casinos and also used by casino patrons.

We find that the examining attorney has submitted persuasive evidence that the parties' goods move in the same channels of trade and are sufficiently similar or related that source confusion is likely. In our likelihood of confusion analysis, these findings under the second and third *du Pont* factors support a conclusion that confusion is likely.

C. Absence of Confusion

Finally, applicant argues that, although the application remains pending on an intent-to-use basis, he has been attempting to market his product for a number of years and there has been no actual confusion with the prior registered mark. Appeal Brief at 9. This argument pertains to the seventh and eighth *du Pont* factors, i.e., the nature and extent of any actual confusion and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. *Du Pont*, 177 USPQ at 567.

The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965), especially in this ex parte context. The record is devoid of probative evidence relating to the extent of use of applicant's and registrant's marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. *See Cunningham*, 55 USPQ2d at 1847; *Gillette Canada Inc. v.*

Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). Accordingly, the *du Pont* factor analyzing the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

Balancing the Factors

We have considered all of the evidence of record as it pertains to the relevant *du Pont* factors. We have carefully considered applicant's arguments and evidence, even if not specifically discussed herein, but have not found them persuasive. In view of our findings that the marks are highly similar and that the goods are related and move in the same or similar channels of trade, we find that applicant's mark TROPICAL HOLD EM for "equipment sold as a unit for playing a card game within a casino" is likely to cause confusion with the registered mark TROPICAL STUD and design for "poker games." We conclude that one familiar with TROPICAL STUD poker games who encounters TROPICAL HOLD EM equipment for playing a card game is likely to think that applicant's products are a line extension from the same source as the TROPICAL STUD products.

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act is affirmed.