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#### UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Aristocrat Technologies Australia Pty Ltd

Serial No. 77753502

Abiola Shobola of Aristocrat Technologies, Inc. for Aristocrat Technologies Australia Pty Ltd.

Giancarlo Castro, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Grendel, Bergsman, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On June 5, 2009, applicant Aristocrat Technologies Australia Pty Ltd applied to register the mark BUFFALO, in standard characters, for "gaming machines, namely, devices which accept a wager" in International Class 009.<sup>1</sup> The Trademark Examining Attorney has issued a final refusal to register applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). Specifically, registration has been refused on the ground that applicant's mark, as applied to the goods identified in

<sup>&</sup>lt;sup>1</sup> Application Serial No. 77753502, alleging first use and first use in commerce at least as early as November 6, 2003.

the application, so resembles the mark BUFFALO BUCKS, previously registered in typeset form on the Principal Register for "gaming machines and operating software that runs thereon" in International Class 009,<sup>2</sup> as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant has appealed the final refusal. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register.

#### Record

The examining attorney made of record printouts of the cited registration and Registration No. 3279483 for BUFFALO MOUNTAIN (in standard characters) for the following goods in International Class 009: "gaming devices, namely gaming machines and computer software used therewith to enable the gaming machine to run; downloadable computer software for use in connection with gaming machines." In the initial Office action, the examining attorney required applicant to submit a claim of ownership of the latter registration, for BUFFALO MOUNTAIN, and applicant claimed ownership of Registration No. 3279483 in its request for reconsideration.

Applicant submitted the following evidence:

• a summary list of 19 third-party registrations for gaming equipment incorporating the terms PRINCESS, TIGER, or JADE;<sup>3</sup>

<sup>&</sup>lt;sup>2</sup> Registration No. 2765289, issued September 16, 2003; renewed.

<sup>&</sup>lt;sup>3</sup> November 30, 2010 response to Office action at 8-10, Exhibit A.

- printouts from what appears to be the website of a previous owner of the cited registration;<sup>4</sup>
- a printout from Wikipedia.com titled "Buffalo nickel";<sup>5</sup>
- printouts from the online message board "slot machines forum";6 and
- pictures of applicant's BUFFALO gaming machine.

The examining attorney did not object to applicant's summary list of third-party registrations in the December 22, 2010 final Office action. The examining attorney's failure to advise applicant during examination that such lists are insufficient to make the listed registrations of record constituted a waiver of any objection to consideration of the list. In re City of Houston, 101 USPQ2d 1534, 1536 (TTAB 2012), aff'd, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 1207.03, 1208.02 (3d ed. rev. 2 June 2013). Therefore, we will consider the summary list of third-party registrations "for whatever limited probative value such evidence may have." In re Broyhill Furniture Indus. Inc., 60 USPQ2d 1511, 1513 n.3 (TTAB 2001).8

Applicant also included in the text of its appeal brief a chart of eight registrations – including the cited registration – and one pending application

<sup>&</sup>lt;sup>4</sup> *Id.* at 11 and 21, Exhibits C and E, from rocketgaming.com. Assignment of Registration No. 2765289 from Rocket Gaming Systems, LLC to the Miami Tribe of Oklahoma Business Development Authority was recorded November 12, 2013 at Reel 5152/Frame 5030.

<sup>&</sup>lt;sup>5</sup> *Id.* at 12-20, Exhibit D.

<sup>&</sup>lt;sup>6</sup> *Id.* at 22-31, Exhibit F, from slotmachinesforum.com.

<sup>&</sup>lt;sup>7</sup> *Id.* at 32-34, Exhibit B.

<sup>&</sup>lt;sup>8</sup> We note, however, that the mere submission of a list of registrations does not make the listed registrations of record and the Board does not consider any information regarding those registrations other than that provided in the lists. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006); *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP § 1208.02.

incorporating the term BUFFALO; applicant is listed as the owner of the pending application and one of the registrations shown in the chart. Four of the registrations also were referenced in the text of applicant's November 30, 2010 response to Office action. Applicant did not make the underlying registrations of record. However, the examining attorney did not object to the references to the registrations in applicant's chart in the December 22, 2010 final Office action or in his appeal brief. Therefore, we will also consider the list of these eight registrations for whatever limited probative value they may have. Pending applications, however, are evidence only that they were filed on a certain date. *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8, 1201 (TTAB 2007).

Finally, applicant attached a different version of Exhibit A – its summary list of third-party registrations incorporating terms other than BUFFALO – to its appeal brief. Applicant also attached several new pages of printouts from third-party websites to its reply brief. Evidence submitted with appeal briefs is untimely. Therefore, the revised summary list and the Internet printouts submitted for the first time with the appeal brief have been given no consideration. Trademark Rule § 2.142(d), 37 C.F.R. § 2.142(d); In re Fitch IBCA Inc., 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); In re Trans Cont'l Records Inc., 62 USPQ2d 1541, 1541 n.2 (TTAB 2002); TBMP §§ 1203.02(e), 1207.01. See also In re Max Capital Group Ltd., 93 USPQ2d 1243, 1244 n.4 (TTAB 2010) (noting that an applicant may request remand if it wishes to make additional evidence of record).

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<sup>&</sup>lt;sup>9</sup> November 30, 2010 response to Office action at 3.

#### Likelihood of Confusion

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

## A. <u>Similarity of the Goods and Channels of Trade</u>

We first address the similarity of the goods and channels of trade, the second and third du Pont factors, respectively.

Applicant's goods are "gaming machines, namely, devices which accept a wager." The goods recited in the cited registration are "gaming machines and operating software that runs thereon," not limited as to nature, type, channels of trade, or classes of purchasers.

We find that applicant's goods are a type of gaming machines, that is, a subset of the broader "gaming machines" identified in the cited registration.

Therefore, we presume that the prior registration encompasses applicant's more specific goods, the goods move in all normal channels of trade, and they are available to all potential classes of ordinary consumers. See Citigroup Inc. v. Capital City Bank Group, 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). Moreover, because the gaming machines described in the application and the cited registration are legally identical, we presume that the channels of trade and classes of purchasers are the same. See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst., 101 USPQ2d 1022, 1028 (TTAB 2011); see also In re Viterra Inc., 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

Applicant attempts to distinguish the channels of trade for its goods from those in the cited registration by arguing that applicant manufactures slot machines while the previous owner of the cited registration operates primarily in a different class of gaming that includes only bingo machines. It is well-established, however, that 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. See In re Dixie Rests., Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); Octocom Sys. Inc. v. Houston Computer Servs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); In re Bercut-

 $<sup>^{10}</sup>$  See Appeal Brief at 7-8.

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 visavis the goods recited in the registration, rather than what extrinsic evidence shows those goods to be."). Applicant's argument that confusion is unlikely because gaming machines bear copyright notices is similarly unpersuasive.<sup>11</sup>

In our likelihood of confusion analysis, these findings under the second and third du Pont factors strongly support a conclusion that confusion is likely.

## B. <u>Similarity of the Marks</u>

We turn next to the *du Pont* likelihood of confusion factor focusing on "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Because the similarity or dissimilarity of the marks is determined on the marks in their entireties, our analysis cannot be predicated on dissecting the marks

<sup>&</sup>lt;sup>11</sup> See *id*. at 10.

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, 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.

We also keep in mind that when, as here, marks would appear on legally identical goods or services, "the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); Jansen Enters. Inc. v. Rind, 85 USPQ2d 1104, 1108 (TTAB 2007). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. Joel Gott Wines LLC v. Rehoboth Von Gott Inc., 107 USPQ2d 1424, 1430 (TTAB 2013).

Applicant's mark is BUFFALO, while the cited registered mark is BUFFALO BUCKS. We find BUFFALO to be the dominant term in BUFFALO BUCKS, given both its place of prominence as the first word in the cited mark and the apparently descriptive nature of the term "bucks" in association with gaming machines. *See*,

e.g., Century 21 Real Estate Corp., 23 USPQ2d at 1700 (stating that consumers will first notice the identical lead word on encountering the marks); Presto Prods. Inc. v. Nice-Pak Prods. Inc., 9 USPQ2d 1895, 1896 (TTAB 1988) (stating 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"). The applicant's single-word mark is thus identical to the first, and dominant, term in the cited two-word mark.

Registrant's mark, moreover, incorporates applicant's mark in its entirety, increasing the similarity between the two. See, e.g., In re Mighty Leaf Tea, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant's mark ML is similar to registrant's mark ML MARK LEES); Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses); In re U.S. Shoe Corp., 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). Indeed, in the latter case, the Board observed that "Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark." In re U.S. Shoe Corp., 229 USPQ at 709.

We are not persuaded by applicant's argument that the marks differ as actually currently used by it and the owner of the cited registration on their gaming

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<sup>&</sup>lt;sup>12</sup> See also Reply Brief at 5 (stating that the cited registration "is a classic slot machine name whereby the mark references money that a player can win, e.g., BUCKS, CASH, LOOT, JACKPOT, etc.").

machines. Both the application and the cited registration are in standard character form, and standard character marks are not limited to any particular font, size, style, or color. *In re Viterra Inc.*, 101 USPQ2d at 1909.

For all of the reasons discussed above, we find applicant's mark BUFFALO to be similar in sight, sound, connotation, and overall commercial impression to the cited mark BUFFALO BUCKS. Therefore, the first *du Pont* factor supports a conclusion that confusion is likely.

## C. Conditions of Sale and Consumer Sophistication

The fourth *du Pont* factor considers the conditions under which and buyers to whom sales are made. Applicant argues, without evidentiary support, that some of the end users of its products are regular and knowledgeable slot players who are unlikely to experience confusion, while other consumers are only occasional slot players. The standard of care is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). As we have often noted, furthermore, "even consumers who exercise a higher degree of care are not necessarily knowledgeable regarding the trademarks at issue, and therefore immune from source confusion." *Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1552 (TTAB 2012); *see also Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers . . . are not infallible."). We therefore find the fourth factor to be neutral.

<sup>&</sup>lt;sup>13</sup> See Appeal Brief at 9.

# D. The Number and Nature of Similar Marks in Use on Similar Goods

We next consider du Pont factor six, the number and nature of similar marks in use on similar goods. Applicant argues that:

Competitors within the gaming industry very often utilize similar or even the same game themes in their products. It is generally accepted within [] the industry and unless game names are so similar as to be confusing or infringing, competing products with similar themes/names tend to peacefully coexist.<sup>14</sup>

With respect to the term BUFFALO specifically, applicant included in its appeal brief a chart listing seven registrations (plus the pending application discussed *supra* and the cited registration); the following chart shows some of the information as provided by applicant:<sup>15</sup>

Mark	Registration No.	Class of Goods / Services	Owner
BUFFALO BILL'S RESORT & CASINO	3270691	41	Affinity Gaming, LLC
BUFFALO BILL'S RESORT CASINO and design	2015414	41	Affinity Gaming, LLC
BUFFALO MOUNTAIN	3279483	9	Applicant
BUFFALO THUNDER RESORT & CASINO and design	3985905	21, 25, 41, 43	Buffalo Thunder, Inc.
PRIMM VALLEY CASINO RESORTS BUFFALO BILL'S PRIMM VALLEY WHISKEY PETE'S and design	3753480	41	Affinity Gaming, LLC
SENECA BUFFALO CREEK CASINO	3596671	41	Seneca Gaming Corp.

<sup>&</sup>lt;sup>14</sup> *Id*. at 2-3.

<sup>&</sup>lt;sup>15</sup> *Id.* at 3-4.

Mark		Class of Goods /	Owner
	No.	Services	
THUNDERING BUFFALO	3967823	9	IGT

Applicant's list is not persuasive, for several reasons. Initially, each of these marks makes a commercial impression less similar to the cited registration, BUFFALO BUCKS, than does applicant's single-word mark BUFFALO because all the listed marks contain terms in addition to BUFFALO.

Third-party registrations can be used in the manner of dictionary definitions, to show that a term has a significance in a particular industry, and therefore that the inclusion of the common element is not a sufficient basis on which to find that confusion is likely. *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 592 (TTAB 1975), aff'd, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). The third-party registrations submitted by applicant do not show that BUFFALO marks have been adopted because BUFFALO has a particular significance in the gaming industry. Rather, in three of the marks, BUFFALO is part of the name BUFFALO BILL, and in another mark it appears to relate to a geographic name, BUFFALO CREEK. We cannot conclude that, as used in connection with the cited registrant's goods, BUFFALO has a suggestive significance such that the registration is entitled to a limited scope of protection.

Most important, the third-party registrations incorporating the term BUFFALO listed by applicant are not evidence that the marks therein have been used at all, let alone used so extensively that consumers have become sufficiently conditioned by their usage that they can distinguish between such marks on the

basis of minor differences. The probative value of third-party trademarks depends entirely on their usage. Palm Bay Imports, Inc., 73 USPQ2d at 1693. Where, as here, the record includes no evidence about the extent of third-party uses, the probative value of this evidence is minimal. Han Beauty, Inc. v. Alberto-Culver Co., 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001); see also Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) ("As to strength of a mark, however, registration evidence may not be given any weight."). "The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive." AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); see also In re Max Capital Group Ltd., 93 USPQ2d at 1248 (third-party registrations cannot justify registration of another confusingly similar mark).

Finally, each case must be decided on its own merits. We are not privy to the records (or even copies) of the other registrations, and the determination of the registrability of different marks by a trademark examining attorney cannot control the results in the case now before us. *In re Nett Designs Inc.*, 236 F.3d 139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court.").

# E. Applicant's Claim of Acquired Distinctiveness

In its request for reconsideration, applicant sought to avoid the likelihood of confusion refusal by amending its application to assert a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). Whether applicant's mark has acquired distinctiveness is not controlling on the issue of likelihood of confusion. *In re Bissett-Berman Corp.*, 476 F.2d 640, <u>177 USPQ 528, 529</u> (CCPA 1973); *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.7 (TTAB 2008).

#### Conclusion

We have considered all of the evidence of record as it pertains to the relevant du Pont factors. To the extent that any other du Pont factors for which no evidence was presented by applicant or the examining attorney may nonetheless be applicable, we treat them as neutral. In view of our findings that the marks are similar and the goods are in part legally identical and move in the same channels of trade and to the same customers, we find that applicant's mark is likely to cause confusion with the mark in cited Registration No. 2765289 when used in association with applicant's goods.

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