

From: Castro, Giancarlo

Sent: 1/19/2012 11:51:44 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77753502 - BUFFALO - N/A -
EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 77753502.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77753502

MARK: BUFFALO



CORRESPONDENT ADDRESS:

LAUREN KRUPKA
ARISTOCRAT TECHNOLOGIES INC
LEGAL DEPT 7230 AMIGO STREET
LAS VEGAS, NV 89119

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Aristocrat Technologies Australia Pty
Lt ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

uspto.mail@aristocrat-inc.com

EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

On June 5, 2009, Applicant applied to register the mark "BUFFALO" based on use of the mark in commerce under Section 1(a) of the Trademark Act in connection with "gaming machines, namely, devices which accept a wager."

In an Office Action dated September 9, 2009, the Examining Attorney refused registration under Section 2(d) of the Trademark Act based upon the mark "BUFFALO BUCKS" in U.S. Registration No. 2765289 used in connection with "gaming machines and operating software that runs thereon."

The Examining Attorney also required a claim of ownership for prior registration No. 3279483 for the mark "BUFFALO MOUNTAIN" for "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.” U.S. Registration No. 2765289, which is the basis for the Section 2(d) refusal, was registered on the Principal Register on September 16, 2003.

On April 7, 2010 the application was abandoned for failure to respond to the Office Action dated September 9, 2009 and on May 6, 2010 Applicant’s Petition to Revive was received and granted. On May 31, 2010 a second non-final Office Action was issued with the same Section 2(d) refusal that appeared in the September 9, 2009 Office Action. On November 30, 2010, Applicant responded to the second non-final Office Action with arguments seeking to withdraw the Section 2(d) Likelihood of Confusion refusal.

The Examining Attorney filed a Final Office Action on December 22, 2010. Applicant filed a Request for Reconsideration on June 22, 2011 and submitted a Section 2(f) claim of acquired distinctiveness based on five years of continuous use of the mark in commerce and based on ownership of U.S. Registration No. 3279483. On August 22, 2011 the Request for Reconsideration was denied. Applicant filed an Appeal Brief on November 14, 2011 which was forwarded to the Examining Attorney on November 21, 2011.

ARGUMENTS

Applicant’s mark is “BUFFALO” and the cited mark is “BUFFALO BUCKS.” Both marks are presented in a standard/typed drawing format and the marks share the same dominant feature, namely, “BUFFALO.” Applicant’s central argument regarding the likelihood of confusion refusal is that the term “BUFFALO” has extensive third-party

usage in connection with gaming related goods and services such as gaming devices.[1] Applicant also argues that the appearance and overall commercial impression of Applicant's mark and Registrant's mark are significantly different.[2] Additionally, applicant argues that Applicant's goods are unlikely to appear in same marketplace as Registrant's goods and that the consumer, namely, slot players, are unlikely to confuse Applicant's and Registrant's marks.[3] Finally, Applicant argues that the Section 2(f) claim of acquired distinctiveness based on Applicant's ownership of prior Registration No. 3279483 – ["BUFFALO MOUNTAIN" for 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] creates a brand identify that would "...defuse any potential likelihood of confusion." [4] This argument is irrelevant to the Section 2(d) analysis and the Examining Attorney did not consider this argument in denying the Request for Reconsideration.

Comparison of the Marks

Applicant points to the existence of several third-party Registrations that also contain the term "Buffalo" in connection with gaming type goods and services. Applicant has submitted printouts of third-party registrations for marks containing the wording "Buffalo" in connection with gaming type goods and services to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad

1 Applicant's Response to Office Action dated November 30, 2010.

2 Applicant's Response to Office Action dated November 30, 2010.

3 Applicant's Response to Office Action dated November 30, 2010.

4 Applicant's Request for Reconsideration dated June 22, 2011.

scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods and/or services. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

Furthermore, the goods and/or services listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the goods and/or services at issue. Third-party registrations are entitled to little weight on the question of likelihood of confusion because they are “not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); see *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(d)(iii). Moreover, the existence on the register of other

seemingly similar marks does not provide a basis for registrability for the applied-for mark. *AMF*, 474 F.2d at 1406, 177 USPQ at 269; *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999). Additionally, evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. American Leisure Prods., Inc.*, 47 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Ultimately, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

Applicant also argues that Applicant's mark has a different appearance from Registrant's mark and cites differences in style, font and additional design elements that appear in both marks. However, as has already been noted, Applicant's and Registrant's marks, as submitted, are standard character/typed format drawings. The marks are compared based upon the drawings submitted with the application and the registration. Although some

differences in presentation exist in the specimens of record, the specimens of record are not at issue. The marks at issue for comparison in a 2(d) analysis are those submitted on the drawing page, not those submitted on the specimens of record. Additionally, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

The sole difference between Applicant's and Registrant's mark is the term "Bucks" in Registrant's mark. In a likelihood of confusion analysis, the marks are compared in their entireties under a Trademark Act Section 2(d) analysis. *See* TMEP §1207.01(b).

Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression; greater weight is given to that dominant feature in determining whether the marks are confusingly similar. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); TMEP §1207.01(b)(viii), (c)(ii). The mere addition of a term to a

registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii).

The dominant portion of Registrant's mark is the term "Buffalo" which is the only term in Applicant's mark. "Buffalo" is the dominant portion of Registrant's mark because consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

Finally, if the goods of the respective parties are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); see Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Applicant’s and Registrant’s goods are closely related in that they are both in International Class 9, and both are gaming machines.

Comparison of the Goods

Applicant’s primary argument regarding the comparison of the goods centers around their statement that Applicant’s and Registrant’s goods are unlikely to appear in the same marketplace and supports this argument by submitting evidence that establishes different classes for different types of gambling machines.[5] The following statement was provided by Applicant: “Applicant solely operates in the U.S. under Class III gaming, manufacturing only traditional “Las Vegas style” slot machines. In contrast, the owner of the cited Registration, Rocket Gaming, primarily operates primarily in Class II gaming, which includes only bingo machines. Applicant’s Class III products are not even permitted under U.S. regulation to appear in Class II locations.”[6]

In a likelihood of confusion analysis, the comparison of the parties’ goods and/or services is based on the goods and/or services as they are identified in the application and

5 Applicant’s Response to Office Action dated November 30, 2011.

6 Applicant’s Response to Office Action dated November 30, 2011.

registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii). In this case, the identification set forth in the cited registration uses broad wording to describe Registrant's goods and does not contain any limitations as to nature, type, channels of trade or classes of purchasers, including whether Registrant's machines are available at Class II or Class III casinos. Therefore, it is presumed that the registration encompasses all goods and/or services of the type described, including those in applicant's more specific identification, that the goods and/or services move in all normal channels of trade, and that they are available to all potential customers. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 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); TMEP §1207.01(a)(iii).

Applicant argues that the average consumer, specifically, a knowledgeable or occasional slot player, who encounters Applicant's and Registrant's marks would not be confused as to the source of the goods. However, when the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). Additionally, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009); *In re*

Decombe, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

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).

Ultimately, the overriding concern in any likelihood of confusion analysis 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).

CONCLUSION

The sole issue under Section 2(d) of the Trademark Act, is whether Applicant's mark and the cited mark as applied to the respective goods and services would present a likelihood of confusion to consumers. The Examining Attorney must resolve any doubt as to the issue of likelihood of confusion in favor of Registrant and against Applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome CO. V. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979). For the above reasons, a finding of likelihood of confusion is proper. It is respectfully requested that the refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d) be affirmed.

Respectfully submitted,

Giancarlo Castro
/Giancarlo Castro/
Trademark Attorney
Law Office 110
571-272-9357
giancarlo.castro@uspto.gov

Chris A. F. Pedersen
Managing Attorney
Law Office 110