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Mailed:
February 9, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Eolith Co., Ltd.

Serial No. 78139104

James H. Walters of Dellett & Walters for Eolith Co., Ltd.

Tricia Sonneborn, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Walters and Grendel, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Eolith Co., Ltd. seeks registration on the Principal
Register of the mark EL DORADO, in standard character form,
for "computer electronic games; automatic slot machines,"
in International Class 9.¹

¹ Serial No. 78139104, filed June 26, 2002. The application is based on use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), alleging first use as of June 13, 2001, and use in commerce as of February 21, 2002. As filed, the application also included goods in International Class 28 for which a bona fide intention to use the mark was alleged; although

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the specimens of record do not show use of the mark in connection with the goods specified in the application. See Trademark Rule 2.56(a), 37 C.F.R. §2.56(a). The appeal is fully briefed. After careful consideration of the evidence and arguments of record, we reverse.

The application included a specimen for the goods in International Class 9, shown below, described as "a photograph of one of the goods with the mark thereon."

ORIGINAL SPECIMEN
Internet Transmission Date:
2002/06/26
Filing Date:
2002/06/26

Serial Number:
78139104



The applicant has submitted required color specimen.
The USPTO has printed only one copy of the specimen,
and extra copies can be produced in-house as needed.

applicant subsequently deleted the International Class 28 goods from the application following a Section 2(d) refusal in relation thereto. Applicant also limited the goods in International Class 9 to those identified herein.

In her June 25, 2003, non-final office action, the examining attorney contended that the specimen of record does not show use of the mark in connection with the goods identified in International Class 9; rather, the examining attorney stated that the specimen shows use of the mark on an arcade game. Applicant disagreed in its response of December 24, 2003, and, in support of its position that the specimen shows use of the mark on the identified goods, applicant submitted a definition of "slot machine" from *Webster's Third New International Dictionary of the English Language Unabridged* (1981) as "(1) a machine (as a vending machine) whose operation is started by dropping a coin into a slot (2) a coin-operated gambling machine that pays off according to the matching of symbols on wheels spun by a handle - called also a *one-armed bandit*." Applicant made the following argument:

The device shown [in the specimen] is computer software driven and therefore should qualify as a computer game program. The program is sold as an integral part of the goods. Further, the automatic slot machine designation is believed to apply to the illustrated goods. The device shown operates with coins and employs a mound of coin-like medals that the player rakes off of the central pile of medals to win prizes.

The examining attorney issued a final refusal to register on the ground that the specimen does not show use

of the mark for the specified goods and made the following statement:

Here, the specimen does not show use of the mark on "computer electronic game programs" or "automatic slot machines." It shows use on a stand-alone arcade type game in Class 028. The applicant submits that "the device shown is computer software driven and therefore should qualify as a computer game program." However, given the number of goods today that contain computer software, this is not a practical reality, nor is it acceptable for classification purposes. Using this flawed reasoning, the examining attorney could then accept a picture of a computer for computer electronic game programs.

In its request for reconsideration, applicant argued that its original specimen is acceptable and submitted the following three additional specimens, supported by the required declaration: (1) an instruction manual for the machine depicted in the original specimen, (2) photographs of a circuit board with the mark EL DORADO stamped thereon, and (3) an alleged display associated with the goods that depicts the machine shown in the original specimen, refers to El Dorado as "a new type medal prize game," includes simple instructions for operating the game machine, and describes the characteristics of the game.

The examining attorney denied the request for reconsideration, making the following statement²:

² The examining attorney attached a picture of a third party's slot machine that would be characterized as a "one-armed bandit."

Applicant submitted three different specimens in its request for reconsideration. The specimens submitted are unacceptable because they do not show use on the goods. Rather, they show use for circuit boards and an arcade game. They do not show use for a slot machine, see picture of a slot machine attached hereto.

The first specimen is an instruction manual, which states "Thank you very much for purchasing our product 'El Dorado,' despite the recent economic recession sweeping the arcade game market" (emphasis added).

The second specimen is "a photograph of the boards in which the computer programs are carried and stored." This does not show use on the labeling or packaging for the computer game programs but, rather, for use on circuit boards.

The third specimen is a display associated with the goods, but does not show the goods in relation to the display.

In her brief, the examining attorney argues that accepting applicant's argument that the displayed product is a slot machine would require the USPTO to accept "slot machine," in International Class 9, as an identification for any machine that operates via a coin slot, noting several coin operated machines that are quite different from the goods herein and from the slot machines referred to as "one-armed bandits," for example, "coin operated washing machines," in International Class 7, "coin operated public telephones," in international Class 9, and "coin operated vibrating beds," in International Class 20. The examining attorney contends that the goods identified by the specimens

of record are most appropriately identified as "arcade games," in International Class 28. The examining attorney also submitted three additional dictionary definitions of "slot machine,"³ two of which have been considered and are shown below:

Bartleby.com: *American Heritage Dictionary of the English Language*, 4th ed. 2000. "1. a gambling machine operated by inserting coins into a slot and often by pulling down on a long handle. 2. A vending machine operated by inserting coins into a slot."

Encarta.msn.com⁴: *Encarta World English Dictionary*, 2006. "1. gambling machine: a gambling machine in which a player inserts coins or bills in a slot and pulls a lever that spins symbols on a dial to generate combinations that determine winnings; 2. vending machine: a coin operated vending machine.

³ Ordinarily, we would not consider these definitions because they were submitted with the examining attorney's brief and are untimely. However, applicant did not object to their consideration. Therefore, we exercise our discretion and take judicial notice of the definitions from the Encarta and Bartlesby websites. See, e.g., *Hancock v. American Steel and Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We have not considered the definition from the Wordsmyth website as there is no indication that it is available in any form other than from the Internet website. *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999) (Board will not take judicial notice of online dictionaries submitted with brief that otherwise do not exist in printed format).

⁴ Regarding the *Encarta Dictionary*, "while it may not be available as a print publication, it is a widely-known reference that is readily available in specifically denoted editions via the Internet and CD-Rom. Thus, it is the electronic equivalent of a print publication and applicant may easily verify the excerpt." *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

The question before us in this case is whether the specimens of record show use of the mark EL DORADO in connection with "computer electronic games" and/or "automatic slot machines." First, we agree with the examining attorney and find that the photograph of a circuit board with EL DORADO imprinted thereon is not a good specimen of use for the goods as identified; rather, it shows use of the mark on circuit boards.

The remaining specimens - a photograph of the product, an owner's manual therefore, and an alleged display associated with the product - all pertain to the same product. Thus, before we consider the acceptability of these three specimens, we must answer the threshold question of whether this product fits within the identification of goods in the application.

In addition to considering the definitions noted above, we take judicial notice of the following definitions in *Merriam Webster's Collegiate Dictionary*, 11th ed. 2003:

"slot machine" is defined as, inter alia, "a machine whose operation is begun by dropping a coin into a slot";

"vending machine" is defined as "a coin operated machine for selling merchandise";

"computer" is defined as "a programmable usu[ally] electronic device that can store, retrieve and process data";

"electronic" is defined as, inter alia, "implemented on or by means of a computer"; and

"game" is defined as, inter alia, "activity engaged in for diversion or amusement."

We also take judicial notice of the definition of "slot machine" from the website Dictionary.com, based on *Random House Unabridged Dictionary*, Random House, Inc. 2006: "1. a gambling machine operated by inserting coins into a slot and pulling a handle that activates a set of spinning symbols on wheels, the final alignment of which determines the payoff that is released into a receptacle at the bottom, 2. any machine operated by inserting coins into a slot, as a vending machine."

The owner's manual gives us further insight into the nature of the product pictured in the original specimen. On p. 16 of applicant's August 5, 2004, submission, the manual pictures the product, characterizes it as "a machine," and names each of its parts, including LED timer, LED coin slot, and joy stick. Further, it is clear from the manual that the machine is marketed to "game centers," and is referred to as an "arcade game." The manual (at p. 12 of applicant's submission) describes the game as follows: "El Dorado is a

unique game in which users can control cranes built in the machine to scratch down medals. If users scratch off all the medals needed, they are given gifts." The specimen identified by applicant as a display associated with the goods appears to be a brochure and reinforces this characterization of the product.

The machine pictured in the original specimen and pictured and described in the owner's manual and display is clearly not a "computer electronic game." While this machine has some electronic components and may include some computer software, its operation by gamers appears to be primarily mechanical in nature. While it is certainly a game, and it has electronic components such as the LED timer and LED coin slot, it is neither a "computer" nor a "computer electronic game."

Additionally, the machine pictured may be an arcade game, but, since "arcade game" is not among the goods identified in the application, the question before us is whether the pictured and described machine may also be correctly identified as an "automatic slot machine." Clearly, it is not the "one-armed bandit" type of slot machine described in each dictionary entry of record.

The two dictionary definitions submitted by the examining attorney restrict "slot machines" that are not one-armed-bandits to "vending machines" that are coin operated. The dictionary definition submitted by applicant and the two judicially noticed definitions define "slot machines" more broadly as encompassing all machines operated by dropping a coin into a slot. Applicant's machine is not a "vending machine" because, while a gamer may win a "gift," it is not a machine that dispenses goods upon placing the appropriate coinage in the slot - it is a game.

The majority of definitions herein do not restrict "slot machines" to only "vending machines," and the machine pictured in the specimen fits the broad definition of a slot machine.⁵ Therefore, we conclude that the specimen originally submitted, i.e., a picture of the product with the mark affixed thereto, is sufficient evidence of use of the mark for the identified goods, i.e., "automatic slot machines." It is unnecessary to consider the manual and

⁵ The examining attorney argues that "the Trademark Office does not use broad definitions to identify products but, rather, uses the common understanding of words taken from a dictionary if necessary" (brief unnumbered p. 4); and that accepting the designation "slot machine" for the product shown will essentially eviscerate the *Trademark Acceptable Identification of Goods and Services Manual*. We do not find these arguments either accurate or persuasive based on the record in this case.

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alleged display subsequently submitted except as literature indicating the nature of the goods.

Decision: The refusal to register is reversed.