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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78420207
Applicant	Konami Gaming, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Konami Gaming, Inc.)
Serial No.: 78420207) Law Office: 114
Filed: May 17, 2004) Examining Attorney: Regina Hines
Mark: RAWHIDE)

APPLICANT'S APPEAL BRIEF

I. INTRODUCTION

Pursuant to a Notice of Appeal (under 15 U.S.C. § 1070 and 37 CFR § 2.141) filed on September 8, 2005 Applicant Konami Gaming, Inc. (hereinafter Applicant) has appealed the Examining Attorney's refusal to register the mark RAWHIDE on the ground that it creates a likelihood of confusion with RAWHIDE SOFTWARE Registration No. 1,411,114 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). As will be fully shown below, there is no likelihood of confusion between the two marks. Therefore, Applicant respectfully requests that the Trademark Trial and Appeal Board (hereinafter the T.T.A.B) reverse the Examining Attorney's decision and approve the captioned application for publication.

II. PROSECUTION HISTORY

On May 17, 2004, Applicant filed a Federal Trademark Application with the United States Patent and Trademark Office for the mark RAWHIDE for use in conjunction with gaming equipment, namely, slot machines, gaming machines, and game software used therewith in International Class 009.

In an Office Action dated July 2, 2004, the Examiner initially refused registration of Applicant's mark under 15 U.S.C. § 1052(d) on the grounds that the mark is allegedly confusingly similar to the Registration No. 1,411,114 (hereinafter the Cited Mark). The Cited Mark is RAWHIDE SOFTWARE for use in conjunction with computer software programs and program manuals all sold as a unit.

On January 3, 2005, Applicant filed a Response to the Examiner's refusal and argued that Applicant's mark is not likely to be confused with the Cited Mark. Applicant argued that when the marks are taken as a whole, they are distinguishable in sight, sound, and connotation. Applicant further argued that the consumers are highly sophisticated purchasers and are not likely to be confused as to the source of the two marks.

The Examiner was unconvinced by Applicant's arguments and issued a Final Refusal on March 8, 2005. The Examining Attorney found that despite Applicant's arguments and evidence that there is no likelihood of confusion between the marks that the 2(d) refusal should stand. Therefore, the Examiner issued a final refusal based on her 2(d) refusal.

On September 8, 2005, Applicant filed a Response to the Examiner's Final Refusal and amended the list of goods associated with the mark to read as follows: gaming equipment, namely, slot machines, gaming machines. Thereby deleting any reference to software of any kind. Applicant also requested reconsideration of the Examiner's 2(d) refusal and offered additional arguments supporting the position that the two marks were dissimilar while filing its Notice of Appeal.

However, the Examining attorney was un-persuaded by Applicants arguments and denied Applicant's request for reconsideration of the 2(d) refusal. Yet, the Examiner did appear to accept

Applicant's amendment of goods. As a result, the only outstanding objection to this application is the claim that Applicant's mark creates a purported likelihood of confusion with the Cited Mark.

Therefore, Applicant seeks this appeal against the background described above. Specifically, Applicant respectfully requests that the Examining Attorney's final refusal to register the above mark be reversed.

III. ARGUMENTS

The Examining Attorney has refused registration of the mark RAWHIDE on the grounds that it is allegedly confusingly similar to the Cited Mark. The issue of likelihood of confusion is determined by evaluating the following factors:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-confuse trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
5. The fame of the prior mark.
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used.
10. The market interface between applicant and the owner of a prior mark.

In re E.I. Dupont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973). Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), warrants refusal of registration only where confusion is

probable, not merely possible. *See, Witco Chemical Co. v. Whitfield Chemical Col, Inc.* 164 U.S.P.Q. 43, 44 (C.C.P.A. 1969)(“We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimus situations but with the practicalities of the commercial world, with which the trademark laws deal.”); *see also, Triumph Machinery Co. v. Kentmaster Mfg. Co., Inc.* 1 U.S.P.Q.2d 1826, (T.T.A.B. 1987)(“The Trademark Act, however, does not talk in terms of remote possibilities of confusion but, rather, the likelihood of such confusion occurring in the marketplace.”). In testing for likelihood of confusion under Section 2(d), the DuPont court set forth thirteen factors to be considered. *Id* at 1361. However, pursuant to TMEP §1207.01, only the first two factors are to be considered unless relevant evidence with respect to the remaining factors is contained in the record. Here, in addition to the first two factors, other factors should be considered based on relevant evidence submitted in Applicant’s response, specifically, Applicant respectfully submits that there is no likelihood of confusion because (A) Applicant’s mark and the Cited Mark differ in appearance, sound, meaning and commercial impression; (B) the goods associated with the marks are vastly different; (C) the channels of trade are dissimilar; and (D) the goods offered are purchased by sophisticated consumers.

A. Applicant’s Mark is Unique in Sight, Sound, and Connotation

Applicant’s mark and the Cited Mark are not similar in sight, sound or connotation. Consumer confusion, therefore, is not likely. “The points of comparison for a word mark are appearance, sound, and meaning or connotation. Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related.” Trademark Manual of Examining Procedure (“TMEP”) §1207.01(b). *See e.g. Estee Lauder, Inc. v. Gap, Inc.*, 108 F.3d 1503, 42 U.S.P.Q.2d 1228(2d Cir.

1997); *First Savs. Bank. F.S.B. v. First Bank Sys., Inc.* 101 F.3d 645, 40 U.S.P.Q.2d 1865 (10th Cir. 1996).

In *First Savings Bank*, the United States Court of Appeals for the Tenth Circuit compared the marks FIRST BANK and FIRST BANK SYSTEM and concluded that there were “minimal” similarities between the two. *See First Savings Bank*, 101 F.3d at 653. The court considered the visual differences between the marks, the addition of other words to the mark, and the marks’ respective meanings. The court reached the conclusion that even though the marks contained some identical terms, the marks, when compared in their entireties were not confusingly similar. *Id.*

Applicant’s mark and the Cited Mark are more distinct than the marks in the cases discussed above as was shown in Applicant’s responses to the Examiner’s Office Actions. The USPTO has already ruled in a similar matter, when it granted registrations for both DRAGON’S LUCK and DRAGON’S GOLD for gaming equipment (please see Applicant’s Response to Office Action). These marks shared the term DRAGON, but that was found to be insufficient to support an assertion that there was a likelihood of confusion between the marks when used in the gaming industry.

B. The Marks are used with entirely different goods

The other central aspect to consider in determining a likelihood of confusion is the similarity of goods associated with the marks. In the case at hand, Applicant’s mark is very limited, it is for use with slot machines, whereas, the Cited Mark is for computer software programs. There have been many marks used in conjunction with computer software (Lotus for example) and yet have also been allowed for slot machines (Golden Lotus). Historically, there has often been a high degree of similarity between gaming marks. As cited in Applicant’s responses, marks used in the gaming industry often share a like term (be it Dragon, Aztec, etc.). The case at

hand is further distinguished in that the marks are used in conjunction with extremely different goods. Applicant's mark and the Cited Mark are for vastly different goods which do not overlap in any form, including, in any natural expansion. There is no possibility of confusion much less any probability of confusion between the sources of these two marks. Therefore, this factor also greatly favors Applicant.

C. The Channels of Trade are Unique

While both Applicant's mark and the Cited Mark are in International Class 009, the channels of trade are significantly different. The Cited Mark is used in conjunction with computer software programs, which are sold to the general public while Applicant's mark is used in the gaming industry. This is a significant difference. The gaming industry is highly regulated and creates an enormous distinction between even different classes (for example Class 2 gaming is separated from Class 3 gaming). Each class has their own operators and purchasers who purchase different regulated games. The operators do not under any circumstance purchase machines from sources who do not have the required regulatory approval. In addition, due to the strict regulations, slot machine manufacturers cannot sell their machines to the general public. Therefore, Applicant's goods and those associated with the Cited Mark will never be purchased by the same individuals. *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.* 952 F. Supp. 1084 (D.NJ 1997) is instructive in the case at hand. In *Harlem Wizards Entertainment Basketball, Inc.*, even though plaintiff used its mark for "show" basketball and defendant used its mark for professional basketball, the court explained that "even when two products or services fall within the same general field, it does not mean that the two products or services are sufficiently similar to create a likelihood of confusion." *Id.*; see, e.g. *Sunenblick v. Harrell*, 895 F. Supp. 616, 624, 629 (SDNY 1995), *aff'd*, 101 F.3d 684 (2nd Cir. 1996), *cert. denied*, 519 U.S. 964, 117 S.Ct. 386, 136

L.Ed.2d 303 (1996)(finding no confusion between jazz records and hip-hop records sold under the identical mark UPTOWN RECORDS because although the recordings were both musical products, they were marketed to different consumers and sold in separate sections of records stores); *Swanson v. Georgetown Collection, Inc.*, No 940CV-1283 WL 72717, *1, *12 (NDNY Feb. 14, 1995)(holding no confusion between the mark FARAWAY FRIENDS for porcelain dolls and FARAWAY FRIENDS for cloth dolls). Accordingly, “[a]ny similarity between the two teams is superficial and the result of creating over inclusive categories that are irrelevant to the likelihood of confusion.” *Id.* At 1095. Just as “show” basketball is different from professional basketball and jazz records are different from hip-hop records, so are computer software programs and slot machines. In addition, in *Sunenblick, supra*, 895 F. Supp. at 616, the court found it significant that the two parties using the mark UPTOWN RECORDS in connection with musical products, did not compete for the same customers. *Id.* At 629. The court found that even though both products were sold in record stores, they were not sold side-by-side; rather, they were separated by genre. *Id.* In the case at hand, since the games are for entirely different consumers and industries, the games would not even be sold in the same establishments. Therefore, it follows that the channels of trade here are completely different for these marks, which again weighs in favor of Applicant.

D. Sophisticated Purchasers

Applicant’s mark and the Cited Mark cover goods purchased by discriminating consumers. It is reasonable to impose a higher standard of care when professional buyers or commercial buyers are the typical consumers for the product. *See CMM Cable Rep. v. Ocean Coast Props.*, 888 F. Supp. 192, 36 U.S.P.Q.2d 1458 (D. Me. 1995)(finding that sophisticated, professional buyers “are less likely to be confused as to the source or origin of a product than ordinary consumers of inexpensive goods or services”).

Applicant's gaming machines are purchased after careful consideration by highly knowledgeable persons with advance expertise and experience. Specifically, the purchasers of the goods are sophisticated, professional casino operators who regularly distinguish between gaming machines in the casino industry. Considering the experience and sophistication of these consumers, the purchasers are unlikely to be confused as to the source of the goods. Moreover, gaming machines are not necessities and the casino operators may consider their own personal preferences when selecting the machines. Likewise, the purchasers of computer software programs are normally highly informed and pay very close attention to the source of the software. As Applicant argued in its responses, gaming machines are extremely expensive and highly regulated; therefore, there is little likelihood of confusion. Again, this factor weighs in favor of a finding of no likelihood of confusion between these marks.

In addition, the ultimate users of the goods are also not likely to be confused. Slot players have one thing on their mind when they sit down at a machine . . . to win money. The players are very conscious of the fact that they have to spend money to win, thus the players are likely to exercise care and consideration of a different type. Many players will only use a specific machine based on who else has played it just before them, how many times it has been played, how many times it has paid out, or if it gave them a "good feeling." Each player has a specific system for selecting a "lucky machine" and pays close attention to the actual mark. However, they are not likely to discriminate based on a manufacture as most know that the casino operator sets the payout, not the manufacturer. Contrarily, users of computer software programs pay particular attention to the manufacturer in order to determine things such as graphics, novelty, and structure.

In consideration of the fact that the purchasers and end users are very discriminating, they are not likely to be confused. Therefore, Applicant respectfully requests reversal of the Examiner's 2(d) refusal.

IV. CONCLUSION

For the foregoing reasons set forth herein, Applicant respectfully requests that the Examining Attorney's final refusal to register Applicant's mark be reversed and that the captioned application be approved for publication.

Respectfully Submitted,
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CASES CITED

CMM Cable Rep. v. Ocean Coast Props., 888 F. Supp. 192, 36 U.S.P.Q.2d 1458 (D. Me. 1995)

Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc. 952 F. Supp. 1084 (D.NJ 1997)

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Swanson v. Georgetown Collection, Inc., No 940CV-1283 WL 72717, *1, *12 (NDNY Feb. 14, 1995)

Triumph Machinery Co. v. Kentmaster Mfg. Co., Inc. 1 U.S.P.Q.2d 1826, (T.T.A.B. 1987)

Witco Chemical Co. v. Whitfield Chemical Col, Inc. 164 U.S.P.Q. 43, 44 (C.C.P.A. 1969)