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Subject: U.S. TRADEMARK APPLICATION NO. 79153067 - ULTRA STACK POSEIDON - 680-610.093- -
EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79153067

MARK: ULTRA STACK POSEIDON



CORRESPONDENT ADDRESS:

KEITH R OBERT

WARE FRESSOLA MAGUIRE & BARBER LLP

PO BOX 224755 MAIN STREET BLDG 5

MONROE, CT 06468

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Universal Entertainment Corporation

CORRESPONDENT'S REFERENCE/DOCKET NO:

680-610.093-

CORRESPONDENT E-MAIL ADDRESS:

kro@warefressola.com

EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1218562

Applicant has appealed the trademark examining attorney's final refusal to register the mark ULTRA STACK POSEIDON in standard characters for "Gaming machines; gaming machines with multi-terminals; home video game machines; magnetic card operated arcade video game machines; arcade video game machines with multi-terminals; arcade video game machines; slot machines; coin-operated arcade video game machines; hand-held games with liquid crystal displays" pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that the mark is likely to be confused with U.S. Registration Number 3823156 for the mark POSEIDON in standard characters for "Gaming machines, namely, devices which accept a wager," all on the Principal Register.

I. FACTS

On July 17, 2014, Universal Entertainment Corporation, ("applicant") filed a Request for an Extension of Protection to the United States for the mark ULTRA STACK POSEIDON in standard characters on the Principal Register, for use in connection with "Gaming machines; gaming machines with multi-terminals; home video game machines; magnetic card operated arcade video game machines; arcade video game machines with multi-terminals; arcade video game machines; slot machines; coin-operated arcade video game machines; hand-held games with liquid crystal displays."

On October 31, 2014, the examining attorney refused registration pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), because of the likelihood of confusion with the mark in U.S. Registration No. 3823156. The examining attorney also required a disclaimer of STACK and a claim of ownership of applicant's prior registrations.

On February 4, 2015, applicant presented arguments in response to the Trademark Act Section 2(d) refusal, submitted a disclaimer of STACK, and claimed ownership of its prior registrations. On February 19, 2015, the examining attorney accepted the amendments and issued a final refusal under Trademark Act Section 2(d).

On August 5, 2015, the applicant filed a Request for Reconsideration after Final Action and submitted additional arguments in response to the refusal. On August 27, 2015, the examining attorney denied the request for reconsideration.

Applicant filed the present appeal on November 6, 2015.

II. ISSUE ON APPEAL

The sole issue on appeal is whether applicant's mark, when used in connection with the identified goods, so resembles the mark in U.S. Registration No. 3823156 as to be likely to cause confusion, mistake, or deception under Trademark Act Section 2(d).

III. ARGUMENT

THE MARKS OF THE APPLICANT AND THE REGISTRANT ARE HIGHLY SIMILAR AND THE GOODS ARE SO RELATED THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis, and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Id.* at 1355.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); TMEP §§1207.01 *et seq.*

Ultimately, the overriding concern is not only to prevent buyer confusion as to the source of the goods, 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).

A. THE MARKS ARE CONFUSINGLY SIMILAR IN SOUND, APPEARANCE, AND COMMERCIAL IMPRESSION

In a likelihood of confusion determination, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

In this case, the applied-for mark ULTRA STACK POSEIDON in standard characters is similar in sound, appearance, and commercial impression to the registered mark POSEIDON in standard characters. Both marks include the identical wording POSEIDON. Although the applied-for mark includes the additional wording ULTRA STACK, incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, nor does it overcome a likelihood of confusion under Section

2(d). *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); TMEP §1207.01(b)(iii).

Applicant argues that the addition of the wording ULTRA STACK in the applied-for mark distinguishes the marks, and ULTRA STACK should be given greater weight in the comparison of the marks. (*See Applicant's Brief*, pp. 6-8). However, as demonstrated by the evidence of record, the wording ULTRA STACK is used by applicant as a house mark to identify a line of gaming machines. The following are examples of applicant's ULTRA STACK registrations:

ULTRA STACK MERMAID for "Gaming machines; gaming machines with multi-terminals; home video game machines; magnetic card operated arcade video game machines; arcade video game machines with multi-terminals; arcade video game machines; slot machines; coin-operated arcade video game machines; hand-held games with liquid crystal displays." (U.S. Registration No. 4527618)

ULTRA STACK DRAGON for "Gaming machines; gaming machines with multi-terminals; home video game machines; magnetic card operated arcade video game machines; arcade video game machines with multi-terminals; cabinets for arcade video game machines; arcade video game machines; slot machines; cabinets for slot machines; coin-operated arcade video game machines; hand-held games with liquid crystal displays." (U.S. Registration No. 4394440)

ULTRA STACK RISING DRAGON for "Gaming machines; gaming machines with multi-terminals; home video game machines; magnetic card operated arcade video game machines; arcade video game machines with multi-terminals; arcade video game machines; slot machines; coin-operated arcade video game machines; hand-held games with liquid crystal displays." (U.S. Registration No. 4562019)

ULTRA STACK BISON for "Slot machines and replacement parts therefor; video slot machines and replacement parts therefor; gaming machines and replacement parts therefor; gaming

machines with a liquid crystal display and replacement parts therefor; mechanical reel type slot machines with a liquid crystal display and replacement parts therefor” (U.S. Reg. No. 4503279)

(See October 31, 2014, Office action, pp. 17-34, Applicant’s February 4, 2015, response, pp. 3-16, Applicant’s August, 5, 2015, response, pp. 3-8).

Adding a house mark to an otherwise confusingly similar mark will not obviate a likelihood of confusion under Section 2(d). See *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007) (finding CLUB PALMS MVP and MVP confusingly similar); TMEP §1207.01(b)(iii). Rather, it is likely that goods sold under these marks would be attributed to the same source. See *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007).

Applicant has also argued that the marks differ in connotation. (See Applicant’s Brief, p. 9). However, applicant has not submitted any arguments or evidence to support this assertion. Rather, since both marks include the identical wording POSEIDON, and the addition of ULTRA STACK does not alter the significance of the word, the commercial impression of the marks is similar.

B. APPLICANT’S GOODS ARE RELATED TO REGISTRANT’S GOODS

It is well settled that the goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(i). The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012)); TMEP §1207.01(a)(i).

In the present case, applicant’s goods are "Gaming machines; gaming machines with multi-terminals; home video game machines; magnetic card operated arcade video game machines; arcade

video game machines with multi-terminals; arcade video game machines; slot machines; coin-operated arcade video game machines; hand-held games with liquid crystal displays" and the registrant's goods are "Gaming machines, namely, devices which accept a wager."

As a preliminary matter, the examining attorney notes that the applicant did not present any arguments with respect to the relatedness of the applicant's and registrant's goods.

(1) RELATEDNESS OF THE GOODS

The applicant's and registrant's goods are related because the goods of both parties include "gaming machines." Further, the applicant's broadly identified "gaming machines" encompass the registrant's more narrowly identified "gaming machines, namely, devices which accept a wager." Additionally, the applicant's "slot machines," identify a type of gaming machine which accepts a wager. Thus, the registrant's goods are legally equivalent to the applicant's "slot machines." Please see the evidence of record which establishes that a "slot machine" is defined as "a machine used for gambling that starts when you put coins into it and pull a handle or press a button." (See February 19, 2015, Office action, pp. 40-42 from the Merriam-Webster Online Dictionary, <http://www.merriam-webster.com> accessed on February 19, 2015).

(2) THE GOODS AND SERVICES MAY EMANATE FROM A SINGLE SOURCE

The applicant's and registrant's goods are also related because the goods are the kind that may emanate from a single source. Enclosed with the final Office action and the denial of the Request for Reconsideration were copies of printouts from the USPTO X-Search database, showing third-party registrations of marks used in connection with the same or similar goods as those of the applicant and registrant in this case. (See February 19, 2015, Office action, pp. 2-25, August 27, 2015, Denial of Request for Reconsideration, pp. 6-42.)

The following are examples of these registrations:

DRACULA for “Gaming devices, namely, gaming machines, slot machines, bingo machines, with or without video output; Gaming machines, namely, devices which accept a wager.” (U.S. Registration No. 4756057)

MR. MONEY BAGS BANKROLL BONUS for “Gaming machines, namely, machines for playing games of chance, devices which accept a wager, slot machines, video gaming machines and bingo related gambling machines; video based slot machines, reel based slot machines, and gaming machines in the nature of video lottery terminals.” (U.S. Registration No. 4435563)

DOCTOR BONEJANGLES for “Computer game programmes; Computer game programmes downloadable via the Internet; Computer game programs; Computer game software; Computer game software downloadable from a global computer network; Computer game software for gaming machines including slot machines or video lottery terminals; Computer game software for gaming machines, namely, slot machines and video lottery terminals; Computer game software for use on mobile and cellular phones; Computer game software for use with personal computers, home video game consoles used with televisions, and for arcade-based video game consoles; Downloadable computer game programs; Downloadable computer game software via a global computer network and wireless devices; Electronic game software; Electronic game software for cellular telephones; Electronic game software for handheld electronic devices; Electronic game software for wireless devices; Electronic gaming machines, namely, devices which accept a wager; Game software; Gaming devices, namely, gaming machines, slot machines, bingo machines, with or without video output; Gaming machines including slot machines or video lottery terminals; Gaming machines, namely slot machines and video lottery terminals; Video game software.” (U.S. Registration No. 4124016)

BIG-BOO BINGO for “Gaming devices, namely, gaming machines, slot machines, bingo machines, with or without video output; Bingo game playing equipment; Spin reel game playing equipment games, namely, reel slot machine games; Board games, card games; Stand-alone video game machines; Gaming machines, namely, devices which accept a wager; Gaming machines comprised of electric control panels, electronic display interfaces, electric control button panels and bolsters, namely, power amplifiers, electrical wires and computer hardware and operating software associated therewith, sold as a unit,” among other goods. (U.S. Registration No. 4791285)

LIGHTNING DRAGON for “Electronic gaming machines, namely, devices which accept a wager; Gaming devices, namely, gaming machines, slot machines, bingo machines, with or without video output; Gaming equipment, namely, slot machines with or without video output; Gaming machines; Gaming machines featuring a device that accepts wagers; Gaming machines for gambling; Gaming machines including slot machines or video lottery terminals; Gaming machines that generate or display wager outcomes; Gaming machines, namely, slot machines and video lottery terminals; Gaming machines, namely, devices which accept a wager; Gaming machines, namely, electronic slot and bingo machines; Machines for playing games of chance; Reconfigurable casino and lottery gaming equipment, namely, gaming machines and operational computer game software therefor sold as a unit; Slot machines.” (U.S. Registration No. 4760933)

MONSTER CATCH for “Electronic gaming machines, namely, devices which accept a wager; Gaming devices, namely, gaming machines, slot machines, bingo machines, with or without video output; Gaming equipment, namely, slot machines with or without video output; Gaming machines featuring a device that accepts wagers; Gaming machines including slot machines or video lottery terminals; Gaming machines that generate or display wager outcomes; Gaming machines, namely, slot machines and video lottery terminals; Gaming machines, namely, devices which accept a wager; Gaming machines, namely, electronic slot and bingo machines; Slot machines.” (U.S. Registration No. 4714110)

This evidence shows that the goods listed therein are of a kind that may emanate from a single source under a single mark. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); TMEP §1207.01(d)(iii).

(3) THE RESPECTIVE GOODS AND SERVICES MOVE IN THE SAME CHANNELS OF TRADE

The goods of the applicant and registrant are also related because they move in the same channels of trade to the same purchasers, including gaming facility operators. The Internet evidence of record establishes that the same entity commonly manufactures the relevant goods and markets the goods under the same mark. Therefore, applicant’s and registrant’s goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

The examining attorney notes the following examples:

- The evidence of record from www.igt.com demonstrates that IGT® manufactures various gaming machines including gaming devices which accept a wager, slot machines, and gaming machines with multi-terminals. (See February 19, 2015, Office action, pp. 26-30).
- The evidence of record from the Aristocrat® website, www.aristocrat-us.com, demonstrates that the company manufactures various gaming machines including slot machines, gaming machines with multi-terminals, and gaming devices which accept a wager. (See February 19, 2015, Office action, pp. 31-36).
- The evidence of record from www.VGT.net demonstrates that Video Gaming Technologies® manufactures various gaming machines including coin-operated arcade video game machines, slot machines, and gaming devices which accept a wager. (See February 19, 2015, Office action, pp. 37-39).
- The evidence of record from www.konami.co.jp establishes that KONAMI® manufactures various gaming machines including machines which accept a wager and gaming machines with multi-terminals. (See August 28, 2015, Office action, pp. 5, 43-47).

Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009).

Applicant did not present any arguments with respect to the trade channels within which the goods travel. In fact, applicant appears to concede that the goods travel in the same channels of trade by stating that the goods of the applicant and registrant “include gaming machines sold into the highly regulated gaming industry” and the goods of both parties are purchased by “properly licensed buyers” of gaming machines. (Applicant’s Brief, pp. 9-10).

(4) SOPHISTICATED PURCHASERS

Applicant has argued that the refusal should be withdrawn because the purchasers of the gaming machines at issue are highly trained, licensed professionals. However, as demonstrated by the evidence of record submitted by the applicant, the applicant's ULTRA STACK marks are prominently featured on the face of the gaming machines for the benefit of the game players. (See Applicant's February 4, 2015, response, p. 21). The Trademark Trial and Appeal Board has previously found with respect to gaming devices that even if the initial purchasers are highly trained and licensed professionals, the relevant class of purchasers in a likelihood of confusion analysis should include the ultimate end user, i.e., the players of the games including patrons of casinos. See *In re Aristocrat Technologies Australia PTY Limited*, Serial No. 76460411 (November 3, 2005) [non-precedential] citing *In re Artic Electronics Co., Ltd.* 220USPQ 836 (TTAB 1983) (although the initial purchasers, i.e., owners of arcades, are sophisticated and careful purchasers of arcade games and coin and bill changer equipment, in determining likelihood of confusion consideration must also be given to the ultimate users of the arcade games and coin and bill changers, i.e., the arcade's customers who are the end users of the goods.).

Thus, the relevant consumer includes ordinary consumers who do not exercise more than an ordinary degree of care in deciding to play or choosing gaming devices. 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 potential purchaser. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014).

Moreover, with respect to the licensed purchasers of the goods at issue, the fact that purchasers may be 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, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014).

IV. CONCLUSION

The marks are highly similar and the goods are related. Consumers encountering the applicant's mark and the cited registered mark in the marketplace are highly likely to mistakenly believe that the goods emanate from a common source. For the foregoing reasons, the refusal to registration under Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,

/Christine Martin/

Examining Attorney

Law Office 104

(571) 272-1630

christine.martin@uspto.gov

Dayna Browne

Managing Attorney

Law Office 104