

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DEQ Systèmes Corp.

Serial No. 85315739

James R. Menker of Holley & Menker, P.A. for DEQ Systèmes Corp.

Cory Boone, Trademark Examining Attorney, Law Office 104 (Chris Doninger,
Managing Attorney).

Before Cataldo, Bergsman and Lykos,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On May 9, 2011, DEQ Systèmes Corp. (“Applicant”) filed an application to
register the mark displayed below on the Principal Register,



for, as amended, “Card games; Card games for use in casinos; Card game
accessories, namely, tables specially adapted for casino games; Gaming tables;

Gaming table felt layouts for betting and instructions for playing card games, sold as a unit” in International Class 28.¹ The application alleges July 1, 2009 as the date of first use anywhere and in commerce. Applicant has disclaimed the wording “NO COMMISSION” and “PAI GOW” apart from the mark as shown.

Registration has been finally refused in light of Applicant’s failure to comply with the Examining Attorney’s requirement for a disclaimer of “EZ” pursuant to Trademark Act § 6(a), 15 U.S.C. § 1056(a) on the grounds that the term is merely descriptive of the identified goods. Upon final refusal of registration, Applicant filed a timely appeal and request for reconsideration. Applicant argued against the merits of the disclaimer requirement, and in the alternative, asserted a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), in part, as to the term “EZ.”

We first consider Applicant’s alternative claim of acquired distinctiveness in part. In its appeal brief, Applicant argues that based on its ownership of two prior registrations on the Principal Register incorporating the term “EZ,” it has established acquired distinctiveness as to the term “EZ” in the present application. The Examining Attorney, however, counters that because the term “EZ” is highly descriptive, Applicant’s claim of ownership of prior registrations is insufficient to

¹ Application Serial No. 85315739. The description of the mark is as follows: “The mark consists of a yellow and gold disc superimposed over a red pagoda outlined in black all on a black background where the disc is outlined in black and has the black wording NO COMMISSION in its yellow outer circumference, a thin black ring below the wording NO COMMISSION, and in the gold center of the disc, the black wording EZ above the black wording EZ PAI GOW both imposed over a black dragon design.” The color(s) yellow, gold, red and black is/are claimed as a feature of the mark.

establish acquired distinctiveness. Rather, direct evidence of acquired distinctiveness is required.

As a threshold matter, we must first determine whether Applicant's claim of acquired distinctiveness in part as to the term "EZ" is appropriate. *See* Trademark Manual of Examining Procedure ("TMEP") § 1212.02(f)(ii) (April 2014) ("*Appropriate/Inappropriate Situations for Claiming § Section 2(f) in Part*"). In evaluating claims of acquired distinctiveness in part,

Generally, the element that is the subject of the §2(f) claim must present a separate and distinct commercial impression apart from the other elements of the mark. That is, it must be a separable element in order for the Applicant to assert that it has acquired distinctiveness as a mark.

Id. Applying these guidelines, we find that the rendition of the term "EZ" in Anglicized Chinese style characters, prominently displayed in the center of Applicant's composite mark, presents a "separate and distinct commercial impression" apart from the remaining literal and design elements. Both "NO COMMISSION" and "PAI GOW" are presented in smaller sized font. Moreover, their distinct connotation as compared to "EZ" renders each a "separable element" because standing alone, each conveys a particular feature of Applicant's identified goods. The same is true of the design elements of Applicant's mark, especially the graphic design of the yellow and gold disc which appears in lighter shading in contrast to the darker lettering of "EZ." This serves to reinforce the separate and distinct nature of the term "EZ" as presented in Applicant's mark. The red pagoda design is also a separate element, functioning as a background for the literal elements of the mark.

Given that the facts of the case establish that Applicant may rely on a claim of Section 2(f) in part because the term “EZ” is separable, we must now examine whether Applicant has satisfied its burden of proving acquired distinctiveness in this portion of its composite mark. *See Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). Trademark Rule 2.41(b) provides that “in appropriate cases, ownership of one or more prior registrations on the Principal Register of the same mark may be accepted as prima facie evidence of distinctiveness.” *In re Lytle Eng’g & Mfg. Co.*, 125 USPQ 308 (TTAB 1960). *See also In re Owens-Illinois Glass Co.*, 143 USPQ 431, 432 (TTAB 1964). “When an applicant is claiming §2(f) in part as to only a portion of its mark, the mark in the claimed prior registration must be the same as or the legal equivalent of the portion of the mark for which the applicant is claiming acquired distinctiveness.” TMEP § 1212.02(f)(ii)(B). “A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark.” *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). Whether two marks are legal equivalents is a question of law, not fact. *Id.* In addition, a claim of ownership of one or more prior registrations on the Principal Register of the relevant portion of the mark must be for goods or services that are either the same as or related to those named in the pending application. TMEP §§ 1212.04–1212.04(e).

Applicant’s claim of acquired distinctiveness in part is based on the following two registrations:



Registration No. 4006358 for the mark on the Principal Register for “casino card games; casino card games and casino card game instruction manuals sold together as a unit; game tables; and game table layouts’ in International Class 28, with a disclaimer of “BACCARAT”;² and

Registration No. 4188347 for the mark EZ BACCARAT in standard character format for “casino card games and accessories therefore, namely, casino card game instruction manuals sold as a unit, game tables, game table layouts” in International Class 28, with a disclaimer of “BACCARAT.”³

We observe that neither prior registration includes a claim of acquired distinctiveness under Section 2(f) or a disclaimer of the term “EZ”; in other words, the term “EZ” is registered as inherently distinctive on the Principal Register in both registrations. *Compare Kellogg Co. v. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1771 n.5 (TTAB 2007). We further observe that the identifications of goods for the two prior registrations include goods that are either identical to or highly similar to those in the present application. Clearly, “EZ,” as registered in standard character format in Registration No. 4188347, is the legal equivalent of the stylized version of “EZ” in Applicant’s current mark. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1258 n.2 (Fed. Cir. 2010), citing Trademark Rule 2.52(a) (“standard

² Registered August 2, 2011, pursuant to Section 1(a), with a claim of priority under Section 44(d) based on a Canadian application. The registration alleges January 4, 2007 as the date of first use anywhere and in commerce.

³ Registered on August 14, 2012, pursuant to Section 44(e) with a claim of priority under Section 44(d) based on a Canadian application.

character” marks are registered “without claim to any particular font style, size, or color.”). *See also Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). Furthermore, the stylized depiction of the term “EZ” in the present application as compared to Registration No. 4006358, while different, conveys the same commercial impression to consumers. That is to say, the literal elements are identical and the stylization is not so great as to diminish or detract from the connotation or meaning of the term. As such, the “EZ” portions of each mark are legally equivalent.

We therefore find that the distinctiveness of the term “EZ” in Applicant’s previously registered marks for same or similar goods transfers to the “EZ” portion of the mark at issue in the instant application. Simply put, prospective consumers encountering Applicant’s mark will attribute “EZ” to Applicant.⁴

Decision: The refusal to register Applicant’s mark due to an insufficient showing of acquired distinctiveness as to the term EZ is reversed. In view thereof, the requirement to disclaim “EZ” is moot.

⁴ Insofar as applicant’s prior registrations are not incontestable, the Board’s ruling in the case of *In re American Sail Training Ass’n*, 230 USPQ 879 (TTAB 1986) does not apply here.