

**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 Hyperkin Inc.

Serial No. 85472382

Edward C. Schewe of Schewe & Associates, representing Hyperkin Inc.

Laurie R. Kaufman, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Grendel, Mermelstein and Wolfson, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Hyperkin Inc. (“applicant”) seeks registration on the Principal Register of the mark depicted below:



for goods amended during prosecution to: “Cheat device, namely, software downloaded from an online database to allow a user to manipulate selectable game

play features associated with game software for video games to be played on personal computers and video game consoles,” in International Class 9.¹

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), contending that applicant’s use of its mark on the listed goods is likely to cause confusion with Reg. No. 3841795 for the mark GAME GENIE (in typed characters) for “hand held units for playing electronic games and stand alone video game machines” in International Class 28.²

After the examining attorney made the refusal final, applicant appealed to this Board. We affirm the refusal to register.

Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v.*

¹ Filed November 14, 2011. Initially based on allegations of first use and first use in commerce, applicant amended the application filing basis to Section 1(b), claiming a bona fide intent to use the mark. A disclaimer has been entered to the word GAME in the mark.

² Registered August 31, 2010.

Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

A. Comparison of the Marks

In comparing the marks, we must consider the marks in their entirety as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *du Pont*); *Palm Bay*, 73 USPQ2d at 1692; and TMEP §1207.01(b)-(b)(v) (April 2013). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). *See In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007). Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, the analysis is not predicated on dissecting the marks into their various components; the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant's mark includes a fanciful design that represents a "genie," a "magic spirit that looks like a person, often lives in a lamp or bottle, and serves the person who calls it."³ Although the design contributes to the appearance of

³ At <http://www.merriam-webster.com>. The Board may take judicial notice of dictionary definitions retrieved from online sources when the definitions are derived from dictionaries

applicant's mark, in terms of the overall impression of the mark, the words create the more dominant impression while the design just reinforces the impression of "GENIE" in the words.] In general, words dominate over design elements in a mark because the word portion is more likely to be impressed upon a purchaser's memory and to be used when requesting the goods or services. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also, Viterro*, 101 USPQ2d at 1911; *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). When purchasing the goods, consumers are more likely to use the words "GAME GENIE" to make their purchase and to call for the goods, rather than by referring to the design. Moreover, the fact that the design is that of a "genie" reinforces the meaning and impression of the literal portion of the mark. We also note the fact that the word "game" has been disclaimed does not make the phrase "GAME GENIE" subordinate to the design; disclaimed matter remains part of the mark, and despite the descriptive nature of the word "game" in the literal portion of the mark, the words as a phrase make a strong impact as a result of their alliteration. For these reasons, the words "GAME GENIE" are considered the dominant portion of the mark. *See In re National Data Corp.*, 224 USPQ at 751 (nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties).

that exist in printed form. *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009). *See University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Applicant argues that because its goods are available only when downloaded from an online database, they will be purchased through “web search engines where users can search for images.” *Brief* at 15. Applicant argues that prospective buyers will use an image of a genie to locate applicant’s goods, rather than use the word “genie” as a search term. We find this argument speculative at best. Searching for an image likely entails complexities that are not present when simply typing in a word search. Even assuming that some users may search for the goods using an image of a genie does not elevate the design to the dominant position in the mark. Moreover, the prior registrant’s mark is registered in standard characters, and there is nothing which would prevent the registrant from using its mark in conjunction with a design — including a design similar to applicant’s.

Turning then to a comparison of the marks, applicant’s mark consists of an appropriation of the words “GAME GENIE,” the entirety of registrant’s mark, and the addition of a genie design. “When one incorporates the entire arbitrary mark of another into a composite mark, inclusion in the composite mark of a significant, nonsuggestive element will not necessarily preclude a likelihood of confusion.” *The Wella Corp, v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men’s cologne, hair spray, conditioner and shampoo is likely to cause confusion with the mark CONCEPT for cold permanent wave lotion and neutralizer). *See also, In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (CCPA 1972) (WEST POINT PEPPERELL and griffin design for fabrics is likely to cause confusion with WEST POINT for woolen

piece goods); *Coca Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER and soldier design for nonalcoholic club soda, quinine water and ginger ale likely to cause confusion with BENGAL for gin).

In this case, we do not believe that the design feature of applicant's mark so distinguishes the mark that the likelihood of confusion generated by the word portions of the two marks would be obviated. We reach this conclusion on the basis of our examination of the entire marks as presented in the application and the cited registration before us.

This *du Pont* factor favors a finding of likelihood of confusion.

B. Comparison of the Goods

We next turn our attention to a comparison of the similarity or dissimilarity and nature of the goods as they are identified in the registration and application. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). It is settled that it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed.

Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Applicant's goods are identified as a "cheat device, namely, software downloaded from an online database to allow a user to manipulate selectable game play features associated with game software for video games to be played on personal computers and video game consoles." As applicant explains, its software allows a user "to manipulate selectable game play features associated with game software for video games to be played on personal computers and video game consoles." *Brief* at 12. On its website, applicant features a game card under the mark, which it advertises as follows:

The Game Genie for the DS unlocks the hidden potential of all of your Nintendo DS games. Special codes that give you unlimited lives, infinite health, limitless money, infinite ammo, and so much more, the Game Genie is the ultimate source for enhanced gaming!"⁴

Applicant's GAME GENIE game card is advertised as "Game Genie Cheat Device for 3DS/DSiXL/DSi/DSlite/DS."⁵ That is, the product is for use with a Nintendo DS console, or several of the upgraded versions, such as the Nintendo 3DS, a handheld device for playing games.

Registrant's goods are "hand held units for playing electronic games and stand alone video game machines." The examining attorney has shown that companies that sell hand held gaming units also make downloadable software available under the same mark, for use with the gaming unit, and offer such

⁴ At <http://hyperkin.com>; accessed 3/1/12. Attached to Office action dated March 1, 2012.

⁵ *Id.*

software at the same website as the gaming units. Indeed, the products appear to be so closely related that they would be considered complementary, i.e., goods that are typically used, served, or consumed together and found when encountering one good while purchasing the other. *In re Sela Products, LLC*, 107 USPQ2d 1580 (TTAB 2013) (surge protectors and wall mounts/brackets are complementary products because purchasers likely to encounter both during course of purchasing a television, audio or home theater system for use at same time); *American Drill Bushing Co. v. Rockwell Manufacturing Co.*, 342 F.2d 1019, 145 USPQ 144, 146 (CCPA 1965) (drill bits and drill bushings are complementary products).

To show that the goods are related, the examining attorney submitted pages from Nintendo's website, advertising the Nintendo 3DS.⁶ The Nintendo 3DS device accepts game cartridges, but is also equipped with built-in software for downloading additional games, taking photos, browsing the Internet, and accessing previously created lists and memos. Users can visit Nintendo's online "eShop" to purchase "new games, classics from the Game Boy and NES eras, and exclusive 3D titles available nowhere else."⁷ This software is downloadable directly to the Nintendo DS device, and, as shown on the website, each game title is accompanied by a banner that reads: "Nintendo 3DS Downloads."

The examining attorney submitted other printouts from third-party websites showing that a single company may sell a hand held unit for playing electronic games as well as game cartridges and downloadable software for use with the hand

⁶ At <http://www.nintendo.com>; accessed 9/16/12. Attached to Final Office action.

⁷ *Id.*

held device, under a single trademark. One such website shows “Wii” brand games being played on a “Wii” console by a boy holding a hand held device. The website advertises games “right out of the box” as well as “All-time classic game downloads & more.”⁸ Viewing two websites together, namely, “www.xbox.com” and “http://supportxbox.com,” reveals the sale of gaming hardware and software under the same trademark. The first pictures the “Xbox 360 4GB Console with Kinect,” which includes a controller and the Kinect Adventures game, along with the console and other accessories.⁹ The second includes a page titled “Manage your Xbox 360 games.”¹⁰ On this page, “you can download games from the Xbox, LIVE Marketplace and install games from disc to your console’s hard drive.” Finally, another website, at <http://us.playstation.com>, illustrates the complementary nature of gaming hardware and software. A “PlayStation3 System” is shown, which is described as a bundled system including a console, controller and game cartridge,¹¹ and also at the website, a “library of great games” is advertised for those who join the “PlayStation Plus” program, with “new titles arriving all the time for download.”¹²

These websites show that consumers of hand held gaming units can purchase not only the gaming units at the website but can also download games for playing on the units. Applicant argues that its intended goods are not game cards themselves, but rather software downloadable from the Internet. As has been

⁸ From <http://www.nintendo.com>; accessed 9/16/12. Attached to Final Office action.

⁹ At <http://www.xbox.com>, accessed 9/16/12. Attached to Final Office action.

¹⁰ At <http://supportxbox.com>, accessed 9/16/12. Attached to Final Office action.


¹¹ Accessed 9/16/12. Attached to Final Office action.

¹² At <http://us.playstation.com>; accessed 9/16/12. Attached to Final Office action.

shown, sellers of game cards also advertise downloadable software under the same mark. Applicant itself does the same; one of the features of the game card sold by applicant on its website is touted as allowing a user to “download the latest codes and [sic] from www.thegamegenie.com.”¹³ Accordingly, it is clear that applicant’s downloadable software is also intended to be used with hand held gaming units. Applicant further argues that none of the websites offer game manipulation software but only the games themselves. This is irrelevant. Because the games and gaming units are sold together, prospective purchasers are likely to believe that game manipulation software bearing applicant’s mark would not only be playable on hand held units bearing the same or similar mark, but would emanate from the same manufacturer. Moreover, applicant’s argument that these companies are “more in the nature of online department stores for computer hardware and software whose line of products are so varied,” *Brief* at 13, is without support, and contradicted by the evidence.


The eight third-party registrations submitted by the examining attorney corroborate the finding of a likelihood of confusion. Copies of use-based, third-party registrations may serve to suggest that the goods are of a type which may emanate from a single source. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff’d*, 864 F.2d 149 (Fed. Cir. 1988). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993). In particular, two of them, Reg. No.

¹³ *Id.* The specimen originally submitted with the application was a copy of the game card in its packaging. The examining attorney refused the specimen as showing the mark used on a game cartridge, and not in connection with downloadable software. In response, applicant amended the application to Section 1(b), as noted *supra*.

3480069 for the mark  for, *inter alia*, stand alone video game machines and downloadable computer software for video games,¹⁴ and Reg. No. 4106271 for the mark BATTLE TAG for, *inter alia*, hand held units for playing electronic games and providing an online computer game for others over the Internet,¹⁵ show that companies have registered, under the same mark, both downloadable software for accessing computer games and the equipment on which to play the games. This evidence supports the conclusion that purchasers familiar with registrant's GAME GENIE hand held gaming units and stand alone video game machines will be likely, when encountering applicant's GAME GENIE software online, to believe that registrant has extended its line to include game manipulation software. Applicant's software is meant to be downloaded to a gaming unit. Thus, consumers familiar with registrant's GAME GENIE gaming units who encounter game manipulation software bearing the mark GAME GENIE are likely to be confused as to the origin of the goods.

This *du Pont* factor weighs in favor of a finding of likelihood of confusion.


C. Balancing the factors.

The cited mark is GAME GENIE. Applicant's mark  incorporates registrant's mark in its entirety and adds a design of a "genie." The additional design element does not distinguish the two marks because it lends exactly the same impression as the word "GENIE." The marks are similar in their appearance,

¹⁴ Registered August 5, 2008.

¹⁵ Registered February 28, 2012.

pronunciation, connotations and overall commercial impressions. The goods are related, if not complementary, as they are likely to be encountered on the same websites and sold together for compatible use. Accordingly, we find that applicant's

registration of the mark  for a "cheat device, namely, software downloaded from an online database to allow a user to manipulate selectable game play features associated with game software for video games to be played on personal computers and video game consoles," is likely to cause confusion with the registered mark GAME GENIE for "hand held units for playing electronic games and stand alone video game machines."

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.