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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re James Charne

Serial No. 85778933

Joseph S. Heino of Davis and Kuelthau, s.c. for James Charne.

Katherine S. Chang, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).

Before Seeherman, Cataldo, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

James Charne (“Applicant”) has filed an application to register on the Principal Register the mark RISE OF KINGS in standard characters for the goods set forth below:

Computer game programs; Computer game software; Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones; Computer programs for video and computer games; Downloadable computer game programs; Downloadable computer game software via a global computer network and wireless devices; Downloadable electronic game programs; Electronic game software for cellular telephones; Electronic game software for handheld electronic devices; Electronic game software

for wireless devices; Interactive game programs;
Interactive game software; Video and computer game
programs, in International Class 9.¹

The Trademark Examining Attorney refused registration under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with Applicant's goods, so resembles the registered mark THE RISE OF THE WITCH-KING (in standard characters) as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is the subject of three registrations (owned by the same entity) for the goods and services set forth below:

| <u>Reg. No.</u> | <u>Goods/Services</u> |
|-----------------|---|
| 3427968 | Computer game software, computer game discs, computer game programs, computer game software featuring fantasy games, fantasy films, and music; electronic game programs, electronic game software, pre-recorded computer game discs featuring fantasy games, fantasy films, and music, in International Class 9. ² |
| 3757887 | Providing an interactive computer game that may be accessed network-wide by network users; providing computer games via an electronic network; online computer games and video games via a global computer network; providing interactive multiplayer games over an electronic network, in International Class 41. ³ |
| 3838204 | Computer software that permits multiplayer computer games manufactured by others to be played interactively over a global computer network; interactive multimedia computer game programs; pre-recorded DVDs featuring fantasy games, in International Class 9. ⁴ |

¹ Application Serial No. 85778933, filed November 14, 2012 under Trademark Act § 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant's *bona fide* intent to use the mark in commerce.

² Issued May 13, 2008; Section 8 affidavit accepted.

³ Issued March 9, 2010.

⁴ Issued August 24, 2010.

When the refusal was made final, Applicant filed a request for reconsideration, which the Examining Attorney denied. This appeal ensued. Applicant and the Examining Attorney have filed briefs.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also submitted arguments regarding trade channels, the co-existence of similar registered marks, conditions of sale and sophistication of customers.

In performing our analysis of likelihood of confusion, we will focus on Registration No. 3427968 because, as is discussed below, that registration relates to goods that are legally identical to those identified in Applicant's application. If we find that the refusal based on this registration should be affirmed, there is no need for us to consider the issue of likelihood of confusion with respect to Registration Nos. 3757887 and 3838204. If we do not find likelihood of confusion with respect to the mark for legally identical services, then there would be no likelihood of confusion with respect to registrations for goods and services that are not identical.

See In re Hartz Hotel Services Inc., 102 USPQ2d 1150, 1151 (TTAB 2012); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

1. The goods.

Addressing first the goods of Applicant and Registrant, we find that they are, in part, legally identical. The application and cited Reg. No. 3427968 both cover “computer game software.” Moreover, Applicant’s “computer game software” includes within its scope the more specifically identified “computer game software featuring fantasy games, fantasy films, and music” identified in the Registration.

We need not address the degree of commercial relationship between each of Applicant’s goods and Registrant’s identified goods. In the context of likelihood of confusion, it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in a single-class application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007). Accordingly, we find that the *du Pont* factor relating to the similarity or dissimilarity of the goods at issue weighs in favor of a finding of likelihood of confusion.

2. Trade channels.

As Applicant’s goods are, in part, legally identical to those of Registrant, we must presume that the goods of Applicant and Registrant move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *American*

Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Accordingly, the *du Pont* factor relating to the similarity or dissimilarity of trade channels favors a finding of likelihood of confusion.

3. The marks.

We next consider the similarity or dissimilarity of the marks at issue in appearance, sound, meaning, and overall commercial impression. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that “[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007). As Applicant correctly urges, we must consider each mark in its entirety. However, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided that our ultimate conclusion rests upon a

comparison of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).⁵

The two marks at issue are clearly not identical. Just as clearly, each includes the phrase RISE OF followed by some form of the designation KING. These features render the marks, at least in part, similar in appearance and sound. The fact that Applicant's mark, unlike the registered mark, makes use of a plural form of the KING element is a very minor distinction that does not meaningfully distinguish the marks, at least in terms of appearance and sound. *See Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (CCPA 1957); *In re Pix of America, Inc.*, 225 USPQ 691, 692 (TTAB 1985); *In re Sarjanian*, 136 USPQ 307, 308 (TTAB 1962). In both marks, the common wording RISE OF and KING(S) connotes the ascendancy of one or more royal personages, giving the marks some similarity in meaning.

The most important difference between the two marks is the distinction between the designations KINGS and THE WITCH-KING. Applicant argues that this distinction has a serious impact on the meanings and overall commercial impressions of the two marks. Applicant points out that THE WITCH KING would be recognized by relevant consumers as a reference to a particular fictional character, the "Witch-king of Angmar," that is "a major antagonist" in the novels of

⁵ We note Applicant's objection that the Examining Attorney has inappropriately dissected the mark in her analysis. (Applicant's brief at 4.) However, the Examining Attorney's arguments in her brief indicate that she has considered all aspects of the marks at issue. The manner in which she has weighed the various aspects of the marks is not inappropriate "dissecting."

J.R.R. Tolkien.⁶ In support of this contention Applicant has submitted a Wikipedia entry for “Witch-king of Angmar,”⁷ as well as a Wikipedia entry for “Tolkien fandom.”⁸ Applicant also contends that even for those persons who would not recognize this reference to the fiction of Tolkien, THE WITCH KING would create the impression of “a singular person of position” as opposed to the more general term KINGS, which “cannot be construed to be a singular person of position,” but rather “denotes a plurality of persons within a certain position.”⁹

The Examining Attorney, in response, argues that even if customers would recognize THE RISE OF THE WITCH-KING as a reference to a fictional character of J.R.R. Tolkien, they might also perceive RISE OF KINGS as a reference to characters of Tolkien because Tolkien’s fiction includes kings other than the “Witch-king.” The Examining Attorney points out that one of Tolkien’s novels is entitled “The Return of the King” and that Tolkien also wrote a work on the subject of King Arthur.¹⁰ We also note that the Wikipedia entry for “Witch-king of Angmar” refers to other kings involved in the same narrative, including King Arveleg of Arthedain, King Earnil II of Gondor, “three splinter kingdoms of Arnor,” and a Prince Earnur who “inherited the throne” of King Earnil II.¹¹

⁶ Applicant’s brief at 11-13.

⁷ Applicant’s response of May 16, 2013 at 12-16.

⁸ *Id.* at 26-33.

⁹ Applicant’s brief at 11-12.

¹⁰ Office Action of June 6, 2013 at 6-11.

¹¹ Applicant’s response of May 16, 2013 at 13.

The Examining Attorney also argues that Applicant, in devising his mark, has merely deleted the wording THE and THE WITCH- from the registered mark, leaving little more than wording that is common to both marks (with the exception of the S at the end of KINGS).¹²

Overall, we find that the similarities between the marks in appearance, sound, meaning and commercial impression outweigh the differences. We agree with the Examining Attorney that the connection to Tolkien that many would understand in Registrant's mark does not reliably distinguish the two marks, as Applicant's mark also suggests subject matter for which Tolkien is known. Accordingly, we find that the factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion.

4. Similar marks of third parties.

Applicant has submitted a substantial number of third-party registrations of computer game marks that include the designations RISE, RISE OF, and RISING, as well as information regarding applications for registration of such marks and the results of searches of the TESS database for such marks.¹³ Among these are registrations of 10 marks that include the element RISE OF, including RISE OF LEGENDS, RISE OF IMMORTALS, RISE OF THE KASAI, and RISE OF THE ELDRAZI. Applicant has also submitted 25 third-party registrations of computer game marks that include the designation KING, including KING GALAH,

¹² Examining Attorney's brief at 3.

¹³ Request for reconsideration of November 5, 2013 at 30-95.

DINOSAUR KING, WRATH OF THE LICH KING and KING OF ILLUSIONS.¹⁴

Applicant argues (emphasis in original):

[T]he word “RISE,” the words “RISE OF” and the active word “RISING” have little significance in and of themselves as an indicia of origin in the field of computer games. The fact that the word “RISE” has been widely adopted in the trade to suggest an ascension or resurgence of something cannot be ignored in determining the likelihood of confusion. ...

[The USPTO] has tacitly recognized that consumers, particularly those purchasing computer games, are able to distinguish among other unrelated entities that use such terms with other computer games.¹⁵

Applicant makes similar arguments regarding the word KING, and argues that “the relative weakness of the words ‘RISE’ and ‘KING’ as they relate to marks used for computer games places significant importance on the presence of the word ‘WITCH,’ a word that is not used in the Applicant’s Mark.”¹⁶

One purpose of introducing examples of third-party marks is to show that “customers have become so conditioned by a plethora of such similar marks that they ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). *Du Pont* requires that we consider any evidence of record regarding “the number and nature of similar marks *in use* on similar goods.” *Du Pont* at 567 (emphasis added). However, third-party registrations alone are not evidence that the marks are *in use*. *Productos Lacteos*

¹⁴ *Id.* at 103-159.

¹⁵ Applicant’s brief at 7.

¹⁶ *Id.* at 11.

Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc., 98 USPQ2d 1921, 1934 (TTAB 2011). Accordingly, the third-party registrations do not demonstrate that the distinctiveness of the terms RISE OF and KING has been weakened by widespread third-party use.

Under certain circumstances, however, third-party registrations can be used in the same manner as dictionary definitions to show that a term has a significance in a particular field or industry. *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 592 (TTAB 1975). Even if we accept that the separate elements RISE OF and KING have some suggestive meaning in connection with computer games, in the case now before us *both* expressions are found in the marks at issue and, as we have already discussed, the additional word in Registrant's mark is not enough to distinguish the marks. There is no evidence of any marks, other than those of Applicant and Registrant, that combine RISE with KING, and there is nothing to suggest that the combination of RISE OF with KING results in a weak or nondistinctive mark. While THE RISE OF THE WITCH-KING may have certain weak elements, the mark as a whole is not so weak that it is not entitled to protection from the very similar mark RISE OF KINGS for identical goods.¹⁷

¹⁷ In a related argument, Applicant notes that the marks BATTLEFIELD EARTH and THE BATTLE FOR MIDDLE-EARTH were registered side-by-side for computer games. (Applicant's brief at 13.) We are not persuaded by this argument. We decide each case on its own merits and "[e]ven if some prior registrations had some characteristics similar to [Applicant's] application, the PTO's allowance of such prior registrations does not bind the Board." *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

5. Conditions of sale; Customers.

We next consider the “conditions under which and buyers to whom sales are made.” *Du Pont* at 567. Applicant emphasizes that the “name recognition” of the Tolkien character known as the “Witch-King” is an important factor in connection with the purchase and sale of the goods. Applicant argues:

“[O]rdinary purchasers” of video games – colloquially referred to as “gamers” – giving the amount of attention they would be giving to the purchasing of those types of goods, would not be confused by the marks. ... [G]amers are a unique consumer base and one that is quite well-versed in the games they play and in each of the characters appearing in such games. As such, gamers are not likely to be confused by the titles of the games or their source and tend to be quite sophisticated and particular as to the games they play.¹⁸

Applicant appears to argue that, when viewed as the *titles* of games or as indicators of the *characters* depicted in the games (*i.e.*, KINGS and THE WITCH KING), the marks are sufficiently different that customers would not confuse one game for the other; but that is not the relevant question before us. The real issue is whether there is a likelihood of confusion as to the *sources* of the games. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). Even if customers appreciate that the offered games are different and involve different characters, it does not follow that they would necessarily believe the games emanate from different sources. Even assuming that gamers are particular with respect to the games they select and the fantasy characters depicted in those games, there is no evidence to indicate that they are equally particular or knowledgeable as to the sources of those games.

¹⁸ Applicant’s brief at 13.

Further, it is not appropriate to assume that all customers would recognize the character of the “Witch-king.” As the Examining Attorney has pointed out, we must consider the standard of care of the least sophisticated purchaser in the relevant class of customers, *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004), and “[t]his would include those who are not familiar with Tolkien’s work at all” and who would not recognize the “Witch-king” character.¹⁹ In that regard, we observe that the consumers of the goods in question include not only the gamers themselves, but also their parents or other family members who may not be as familiar with the goods and the subject matter. In light of the foregoing discussion, we are not persuaded that the conditions of sale and the nature of the relevant customers would render confusion unlikely and, accordingly, we find this *du Pont* factor to be neutral.

6. Conclusion.

Having considered the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors, we find that Applicant’s mark, used in connection with Applicant’s goods, so closely resembles the registered mark as to be likely to cause confusion, mistake or deception as to the source of Applicant’s goods.

Decision: The refusal to register is affirmed.

¹⁹ Examining Attorney’s brief at 5.