

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Universal Entertainment Corp.
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Serial No. 85872412
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William J. Sapone of Ware Fressola Maguire & Barber LLP for Universal Entertainment Corp.

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Before Adlin, Gorowitz and Hightower, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Universal Entertainment Corp. (“Applicant”) seeks registration of the mark PROSPEROUS YEAR, in standard characters, for “Slot machines and replacement parts therefor, video slot machines and replacement parts therefor; gaming machines and replacement parts therefor; gaming machines with liquid crystal displays and replacement parts therefor; mechanical reel type slot machines with liquid crystal displays and replacement parts therefor.”¹ The Examining Attorney

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¹ Application Serial No. 85872412, filed March 11, 2013 based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act.

refused registration under Section 2(d) of the Act, on the ground that Applicant's mark so resembles the previously-registered mark PROSPEROUS LIFE, in standard characters, for "Gaming machines,"² that use of Applicant's mark in connection with Applicant's goods is likely to cause confusion or mistake or to deceive. After the refusal became final, Applicant appealed and filed a motion for reconsideration which was denied. Applicant and the Examining Attorney filed briefs.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Turning first to the goods and channels of trade, they are identical, as Applicant's "gaming machines and replacement parts therefor" encompass Registrant's "gaming machines." *See Tuxedo Monopoly, Inc. v. General Mills Fun*

² Registration No. 3717589, issued December 1, 2009 under Section 44(e) of the Act based on an Australian registration.

Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found with respect to a class of goods or services in an application if there is likely to be confusion with respect to any item that comes within the identification of the goods or services in that class); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (“We need not consider applicant’s remaining goods because likelihood of confusion as to one of the products listed in applicant’s description of goods in that class is sufficient to support a conclusion that the opposition should be sustained.”). Applicant concedes the point. Applicant’s Reply Brief at 12 and n. 3 (“The goods are essentially identical, gaming machines ...” and “[t]he Examining Attorney’s arguments on product relatedness were unnecessary as it was admitted that [Applicant] and [Registrant] both sell gaming machines.”).

Furthermore, because Applicant’s and Registrant’s identifications of goods contain no limitations, they are presumed to encompass all goods of the type described, and the goods are presumed to move in all normal channels of trade and be available to all classes of consumers for those goods. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (“An application with ‘no restriction on trade channels’ cannot be ‘narrowed by testimony that the applicant’s use is, in fact, restricted to a particular class of purchasers.’”); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even

though there was no evidence regarding channels of trade, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). Applicant also essentially concedes this point. Applicant's Reply Brief at 12 ("the Registrant and the applicant sell to the same consumers").

The legal identity of Applicant's and Registrant's goods and their overlapping channels of trade not only weigh heavily in favor of a finding of likelihood of confusion, but also reduce the degree of similarity of the marks necessary to find a likelihood of confusion. *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). For this reason, Applicant's reliance on cases in which the goods or services were different is misplaced.

With respect to the marks, we must compare them "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). That is, we may not dissect the marks into their various components. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981).

Here, the marks are similar, as they share and begin with the word PROSPEROUS. It is settled that the first part of a mark is often its most prominent and dominant feature. *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9

USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *see also*, *Palm Bay Imports Inc.*, 73 USPQ2d at 1692; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). That is the case here, because in both Applicant’s and Registrant’s marks, the term is followed by another term which may be perceived as indicating a length of time a person is prosperous, either a single year or an entire lifetime. While Applicant is certainly correct that “year” and “life” may also convey different meanings from each other to at least some consumers, in this case, that is not enough to avoid confusion. *See In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988) (“in the context of likelihood of confusion, the fact that a word mark will be understood by some individuals in a manner such that confusion with a prior mark is likely and by other individuals in a manner such that confusion is unlikely, will generally still result in a finding of likelihood of confusion, provided that the size of the group of individuals who are likely to be confused is not inconsequential.”).

Here, we find that a consequential number of consumers would be confused between PROSPEROUS YEAR and PROSPEROUS LIFE. Both marks have the same structure, are in standard characters and in the context of gaming (gambling) machines such as slot machines³ convey that winning users may become prosperous, whether for a year or a lifetime. *See Proctor & Gamble Co. v. Conway*,

³ The Examining Attorney has established that gaming machines include slot machines, video poker machines and other machines which enable users to gamble. *See*, website printouts attached to Office Action of April 20, 2013 and website printouts and third party registrations attached to Office Action of August 15, 2013.

419 F.2d 1332, 164 USPQ 301, 304 (CCPA 1970) (finding MISTER STAIN for stain remover likely to be confused with MR. CLEAN for cleaning products, despite “both aural and optical dissimilarity between ‘stain’ and ‘clean,’” because MR. STAIN conveys “the same idea, or stimulates the same mental reaction, or in the ultimate has the same meaning”); *Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125 (TTAB 1978) (holding TUNA O’ THE FARM for canned chicken likely to be confused with CHICKEN OF THE SEA for canned tuna and stating “In essence, we are holding with a broad interpretation of the expression that ‘TUNA O’ THE FARM’ is a ‘colorable imitation’ of ‘CHICKEN OF THE SEA.’”). In fact, the Examining Attorney has introduced evidence that some gaming (slot) machines are “annuity games” in which winners are paid in annual installments. Denial of Motion for Reconsideration March 4, 2014 (printout from “bhpioneer.com”); Office Action of August 15, 2013 (printouts from “casinocitytimes.com,” “slot-machine-resource.com” and “casinogambling.about.com”). In other words, YEAR may be perceived as referring to annual payments leading to “prosperity,” or to a large win leading to a “prosperous year,” just as LIFE may be perceived as referring to a win so large that the player attains a “prosperous life.”⁴ Consumers may also perceive the PROSPEROUS YEAR game as a new version of the PROSPEROUS LIFE game, perhaps with a smaller or more immediate payout, or vice versa. For all of these

⁴ While Applicant is correct that neither Registrant nor Applicant identify their goods as “annuity gaming machines,” Applicant’s Reply Brief at 8, this is irrelevant. The identified “gaming machines” encompass gaming machines which reward winners with annuity payments.

reasons, the similarity of the marks also weighs in favor of finding a likelihood of confusion.

Applicant argues that the cited mark is conceptually weak because PROSPEROUS suggests that “one can become prosperous through gambling.” Applicant’s Appeal Brief at 11. We accept that PROSPEROUS is not arbitrary for gaming machines,⁵ but do not find that Registrant’s mark is so highly suggestive and weak that it is unentitled to protection against Applicant’s mark, which creates a similar overall commercial impression and is intended to be used for identical goods. *See In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 (TTAB 2007) (“applicant has not submitted evidence that the term MVP is so highly suggestive that the inclusion of its house mark would create significant differences in the marks’ appearance, pronunciation, meaning, and commercial impression”). In fact, “[i]t has often been emphasized that even weak marks are entitled to protection against confusion.” *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1567-68 (TTAB 2011) (quoting *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974)); *see also In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) (“even suggestive or weak marks are entitled to protection from the use of a very similar mark for legally identical services”).⁶

⁵ While gaming machines are by definition more likely deplete than enrich their users, we do not believe this arguable incongruity would be relevant to gamblers. In any event, to the extent there is an incongruity, it is the same for each mark.

⁶ Applicant’s reliance on the registration of third-party marks arguably more similar to previously-registered marks than Applicant’s mark is to Registrant’s mark in this case is misplaced. “Neither the Trademark Examining Attorney nor the Board is bound to approve

Applicant argues that because its mark and the cited mark “co-exist on the Australian trademark register,” Applicant’s mark is entitled to registration in the United States. Applicant’s Appeal Brief at 12-13. The argument is misplaced at best, because trademark rights are territorial.

We are concerned here with business and goodwill attached to United States trademarks, not French trademark rights existing under French law. We take it as axiomatic that neither the trademark law of France nor of the United States has any extraterritorial effect. Where, then, can *business* done under United States trademarks, registered in the United States Patent Office, and the goodwill symbolized by them, have their situs except in the territory where United States law is enforceable?

Roger & Gallet v. Janmarie, Inc., 245 F.2d 505, 114 USPQ 238, 241 (CCPA 1957); *E. Remy Martin & Co. S.A. v. Shaw-Ross International Imports, Inc.*, 756 F.2d 1525, 225 USPQ 1131, 1135 (11th Cir. 1985) (“this skirmish must be fought in this country, notwithstanding the presence of a French connection. ... More importantly, we are not bound to recognize or rely upon foreign law and disagreements abroad settled under it.”).

Applicant argues that its goods are “very expensive,” that the gaming industry is “highly regulated” and that the purchasers of gaming machines are “sophisticated.” Applicant’s Brief at 13-16. We accept that *buyers* of Applicant’s

for registration an Applicant’s mark based solely upon the registration of other assertedly similar marks for other goods or services having unique evidentiary records.” *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); *see also, In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merits. ... Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”).

and Registrant's gaming machines would exercise care in purchasing. However, even careful purchasers can be confused as to source where similar marks are used on identical goods. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (*citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)) ("Human memories even of discriminating purchasers ... are not infallible."). Moreover, here we must consider not only the *buyers* of gaming machines but *users/players* as well. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001) (purchasers of radio broadcasting services include advertisers, but "the public at large who watches television and listens to radio comprises another class of consumers that is relevant to our likelihood of confusion analysis. Although these individuals do not 'purchase' broadcasting services in the sense that they pay for such services ... the broadcast services are certainly directed to this class that 'uses' the services, and likelihood of confusion among viewers and listeners is relevant."); *In re Artic Electronics Co., Ltd.*, 220 USPQ 836 (TTAB 1983) (in case involving coin-operated audio video games and electronic apparatus for recognizing money and making change, the Board held that "in addition to source confusion among buyers, source confusion among ultimate users of the goods before us (i.e., arcade customers) is both likely and encompassed within the confusion proscriptions of Section 2(d)"). Here, there is no evidence that slot or other gaming machine players are sophisticated. Nor would they be expected to exercise significant care when some

gaming machines may be played for 25 cents or less,⁷ and players tend to “pull,” “spin” or play over and over again, quickly and one turn after another, for minutes or hours at a time. If these players are either attracted to or uninterested in particular gaming machines, their views will impact the machines’ success in the marketplace. This factor does not outweigh the essentially identical goods and channels of trade and similar marks.

There is no relevant evidence or argument concerning the remaining likelihood of confusion factors, and we therefore treat them as neutral.

Conclusion

After considering all of the evidence of record as it pertains to the relevant *du Pont* factors, including all of Applicant’s arguments and evidence, even if not specifically discussed herein, we find that confusion is likely because the goods and channels of trade are identical and the marks are similar.

Decision: The Section 2(d) refusal to register Applicant’s mark is affirmed.

⁷Office Action August 15, 2013 (printouts from “azslot.com,” “houstonslotmachines.com”).