This Opinion is Not a Precedent of the TTAB

Mailed: August 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Martha Maria Sanchez Quiroz

Serial No. 90630537

John M. Murphy,
for Martha Maria Sanchez Quiroz.

Rebecca Gilbert, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

Before Shaw, Lebow and Allard
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Martha Maria Sanchez Quiroz ("Applicant") seeks registration on the Principal Register of the wording LOTERIA (in standard characters) for goods identified as "Gaming machines, namely, slot machines and electronic gaming machines for playing games of chance," in International Class 28.[1] According to the application's

[1] Application Serial No. 90630537 was filed on April 7, 2021 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce of May 1, 2011.

translation statement, "The English translation of LOTERIA in the mark is LOTTERY."

The Examining Attorney initially refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the proposed mark is merely descriptive of the identified goods. Applicant appealed the refusal and requested reconsideration, including a claim that LOTERIA has acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). Upon reviewing the request for reconsideration of the merely descriptive refusal, and the Section 2(f) claim, the Examining Attorney continued the merely descriptive refusal and found that Applicant had not established that the proposed mark has acquired distinctiveness. The Examining Attorney also refused registration under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127, on the ground that the proposed mark is generic for the identified goods.[2]

After the Examining Attorney made the refusals final, Applicant appealed and filed two additional requests for reconsideration with requests for remand in order to submit additional evidence. The Board granted both of the requests. However, the Examining Attorney denied the additional requests for reconsideration, and maintained the final refusals. The appeal then resumed. The case is fully briefed. We affirm the refusals to register.[3]

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[2] The Examining Attorney also cited to Section 3 of the Trademark Act, 15 U.S.C. § 1053, however, this section is inapposite inasmuch as it applies only to service marks.

[3] As part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases, the citation form in this opinion is in a form provided in the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") 101.03 (2024). This

I. Background

Applicant claims that its predecessor in interest introduced the Don Clemente Loteria a bingo-style game called "Don Clemente Loteria" in Mexico around 135 years ago.[4] That game is described as follows:

> With a game format similar to Bingo, the Don Clemente Loteria game is composed of a deck of 54 different cards, each featuring a different design. Shuffling the deck of cards, the caller, also known as the *cantador* (Spanish for singer), picks a card from the deck, sometimes using a verse related to the card's image, before announcing the card's name. Players attempt to locate the matching card image on their individual game board, marking – most often with a pinto bean – a matching picture. The winner is the first player to shout "*LOTERIA"* after completing the pre-announced pattern such as a row, column, or cross on their game board.[5]

Applicant now offers a variety of goods in the United States under several LOTERIA-formative marks. Applicant claims ownership of the following marks, among others:

Mark	Reg. No.	Goods
 The English translation of "**JUEGO DE LOTERIA**" is "game of lottery." "**JUEGO DE LOTERIA**" is disclaimed.	2317479	Board games, bingo game playing equipment, in Class 28.

opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion employs citation to the Westlaw (WL) database. Practitioners should also adhere to the practice set forth in TBMP § 101.03.

[4] Applicant's DON CLEMENTE LOTERIA GAME Expert Witness Report, January 23, 2023, TSDR 79-114.

[5] *Id.* at 92.

Mark	Reg. No.	Goods
LOTERIA (Typed drawing) The English translation of "LOTERIA" in the mark is "LOTTERY."	3029671	Printed matter, namely, paper napkins, paper place mats, coasters made of paper, paper flags and posters, in Class 16; and Playing cards, in Class 28.
LOTERIA The English translation of "LOTERIA" in the mark is "LOTTERY."	4752814	Posters; calendars; notebooks; note pads; blank journals; personal organizers; memopads; stickers; temporary tattoo transfers; writing paper; envelopes; greeting cards; paper coasters; paper mats; postcards; trading cards; paper party decorations; paper party bags; paper napkins; paper place mats; paper invitations; decorative paper centerpieces; gift wrapping paper; paper goodie bags and lunch bags; paper banners; paper cake decorations, in Class 16.
 The English translation of "LOTERIA" in the mark is "LOTTERY." "**LOTERIA**" and "**SINCE 1887**" disclaimed.	5003661	Lottery tickets; scratch cards for playing lottery games, in Class 28.
LOTERIA The English translation of "LOTERIA" in the mark is "LOTTERY."	5581248	Beer, in Class 32.
LOTERIA The English translation of "LOTERIA" in the mark is "LOTTERY."	6040060	A wide variety of clothing articles, in Class 25.
LOTERIA	6873683	Non-medicinal cosmetic products and toiletry preparations; perfumery products; essential oils; makeup

Mark	Reg. No.	Goods
The English translation of "LOTERIA" in the mark is "LOTTERY."		foundations; skin foundation; neutralizing foundations for lips; beauty masks; nail polish; lip gloss; hair styling solutions; shampoo; hair conditioner; cologne; cosmetics, in Class 3.

II. Genericness

We begin with the genericness refusal under Sections 1, 2, and 45 of the Trademark Act. A generic term "is the common descriptive name of a class of goods or services." *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965 (Fed. Cir. 2015) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989 (Fed. Cir. 1986)). Because generic terms "are by definition incapable of indicating a particular source of the goods or services," they cannot be registered as trademarks. *Id.* (quoting *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001)).

Whether a proposed mark is generic rests on its primary significance to the relevant public. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 641 (Fed. Cir. 1991). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?" *Marvin Ginn*, 782 F.2d at 990; *see also Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1366 (Fed. Cir. 2018). A term can be considered generic if the public "understands the term to refer to a key aspect of that genus," or part of the genus, "even if the public does not understand the term to refer to the broad genus as a whole." *In re Cordua Rests., Inc.*, 823 F.3d 594, 603, 605 (Fed. Cir. 2016).

Determining whether a term is generic is fact intensive and depends on the record. *See In Re Tennis Indus. Assn.,* 2012 WL 1267923, at *12 (TTAB 2012) ("Genericness is a fact-intensive determination and the Board's conclusion must be governed by the record which is presented to it."); *Royal Crown*, 892 F.3d at 1364 ("Whether an asserted mark is generic or descriptive is a question of fact" based on the entire evidentiary record). In an ex parte appeal, the Examining Attorney bears the burden of establishing that a mark is generic by preponderance of the evidence. *See In re Uman Diagnostics AB*, 2023 WL 2039689, at *16 (TTAB 2023).

"Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.,* 828 F.2d 1567, 1570 (Fed. Cir. 1987); *see also USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, at *2307 n.6 (2021) ("Evidence informing [a genericness] inquiry can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term's meaning."). "These sources may include [w]ebsites, . . . and use 'in labels, packages, or in advertising material directed to the goods.'" *In re N.C. Lottery*, 866 F.3d 1363, 1368 (Fed. Cir. 2017) (citations omitted).

A. What is the genus of the goods at issue?

Our first task is to determine the proper genus. In defining the genus, we commonly look to the identification of goods or services in the application. *See In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1378 (Fed. Cir. 2007); *Magic Wand*, 940 F.2d at 640 (a proper genericness inquiry focuses on the identification set forth in the

application or certificate of registration). Applicant has identified its goods as "Gaming machines, namely, slot machines and electronic gaming machines for playing games of chance."[6] The Examining Attorney maintains that Applicant's identification of goods appropriately defines the genus of Applicant's goods. Applicant describes the genus of goods simply as "gaming machines," which is slightly broader than goods as identified in the application.[7] We find that the identification of goods as listed in the application adequately defines the genus of the goods, although we accept Applicant's usage of "gaming machines" as shorthand for the goods.

B. Who are the relevant purchasers?

The second part of the *Marvin Ginn* test is whether the term sought to be registered is understood by the relevant public primarily to refer to that genus of goods or services. "The relevant public for a genericness determination is the purchasing or consuming public for the identified goods." *Frito-Lay v. Princeton Vanguard*, 2017 WL 3948367, at *4 (TTAB 2017) (citing *Magic Wand*, 940 F.2d at 641). Because there are no explicit restrictions or limitations to the channels of trade or classes of consumers for Applicant's identified goods, the relevant consumers

[6] A gaming machine is defined as: "a device such as a slot machine designed to play solitary gambling games." Https://www.yourdictionary.com/gaming-machine (accessed July 26, 2024). A slot machine is defined as: "an originally coin-operated gambling machine that pays off according to the matching of symbols on wheels spun by a handle." Https://www.merriam-webster.com/dictionary/slot%20machine (accessed July 26, 2024). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed form or regular fixed editions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, Opp. No. 91061847, 1982 TTAB LEXIS 146, at *7(TTAB 1982), *aff'd*, 703 F.2d 1372 (Fed. Cir. 1983).

[7] Applicant's Br., p. 1, 15 TTABVUE 2.

consist of the adult public of the United States who are interested in gambling on gaming machines, namely, slot machines and electronic gaming machines for playing games of chance.

III. How does the Relevant Public Perceive the Wording LOTERIA?

The Examining Attorney argues that "the mark is generic for two reasons, one as applied-for in Spanish and one as translated to English."[8] First, the mark is generic because "'Lotería (Spanish word meaning 'lottery') is a traditional game of chance, similar to bingo, but using images on a deck of cards instead of numbered ping pong balls."[9] Second, according to the Examining Attorney, "Lottery (and the equivalent Loteria) is the generic name for games of chance, such as applicant's."[10] We address each of these arguments in turn.

A. Is LOTERIA generic for a Mexican-style bingo game

The Examining Attorney argues that "Loteria is a generic name for [a] type of traditional Mexican game. Applicant has a version of this game featuring particular designs and there are myriad other versions of this game with differing designs."[11] In support of the refusal, the Examining Attorney introduced a variety of evidence, including the following eleven examples of similar games offered by third parties:

[8] Examining Attorney's Br., p. 4, 17 TTABVUE 4

[9] *Id.* at. 4, 17 TTABVUE 4 (quoting a Wikipedia article on "Lotería," February 24, 2023 Office Action at TSDR 21-24).

[10] *Id.* at 8, 17 TTABVUE 8.

[11] *Id.* at 4, 17 TTABVUE 4.

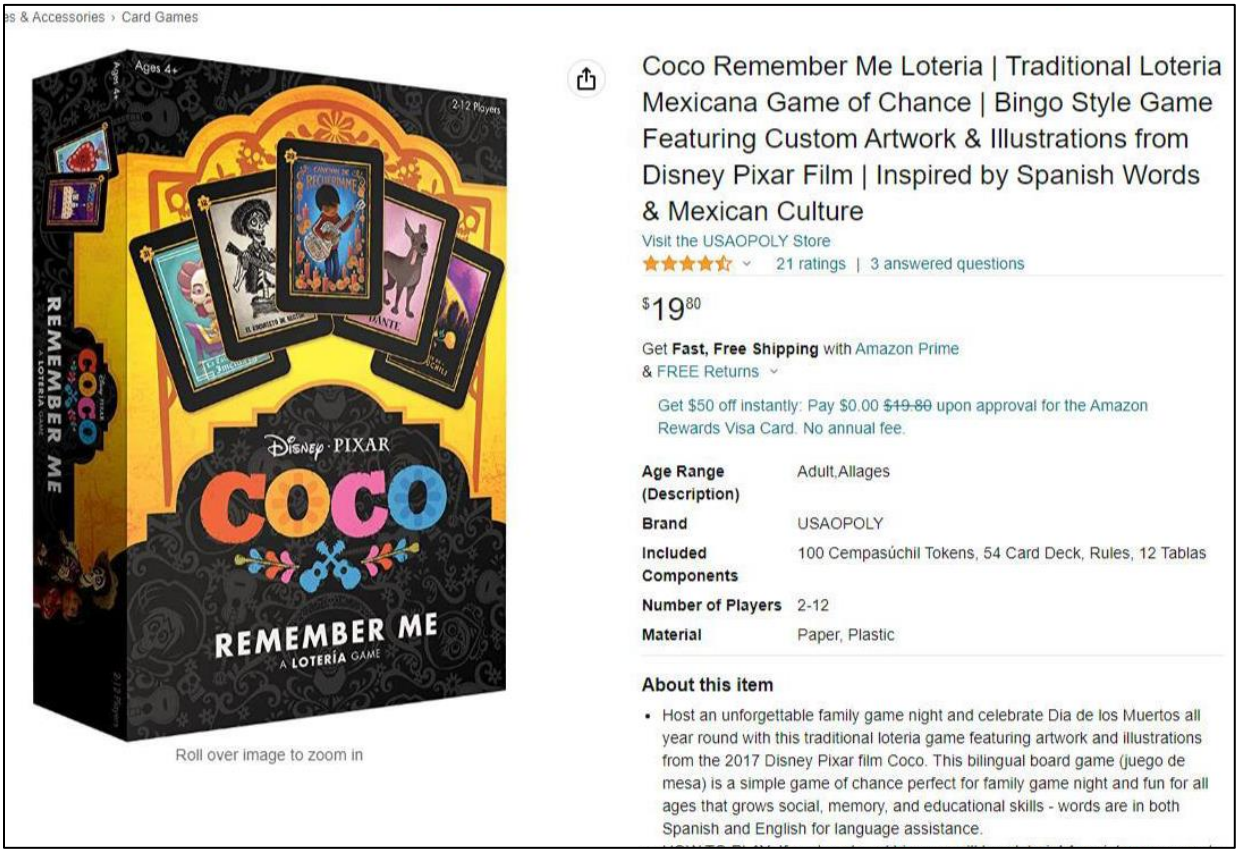
1. A game titled "*Millennial Lotería*", sold at the Target online website, which is described as: "A brand new take on the best-selling Latinx card game that reflects a NEW generation" and a "Hilarious and insightful parody of the classic 'Mexican Bingo' game called Loteria."[12] The website includes the following image:

2. A game titled "*Disney PIXAR Coco Remember Me Loteria*", sold on Amazon.[13] The game is variously described as: a "Traditional Loteria Mexicana Game of Chance," a "Bingo style game," a "traditional loteria game," and a "bilingual board game (juego de mesa)" that is "a simple game of chance . . . ." According to the

[12] Office Action of February 24, 2023, TSDR 7.

[13] *Id.* at 12.

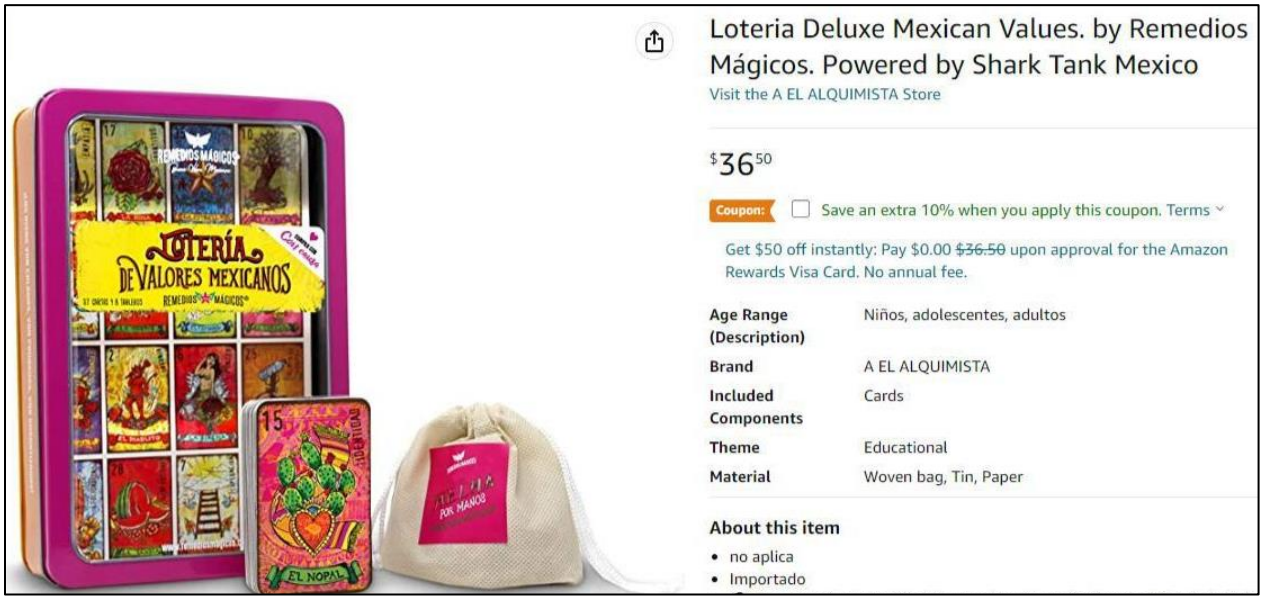
advertisement, "If you've played bingo, you'll love loteria!" The website includes the following image:



3. A "*Loteria Fiesta Bingo Game Set*", sold on Amazon.[14] The website describes the game as: "An original Fiesta themed Loteria game from Mexico. Full game set for up to 10 players includes complete deck of 54 cards and 20 playing boards." The website includes the following image:

[14] *Id.* at 54, 56.

4. A game titled "*Loteria Deluxe Mexican Values*", sold on Amazon.[15] The website states: "The game includes 30 of the most emblematic figures of the 'loteria' and 3 figures with high cultural value . . . . 4 new cards . . . . Includes 37 individual cards, a woven bag, and 8 boards." The game is further described as: "The first Mexican Values lottery/Loteria." The website includes the following image:



[15] *Id.* at 62, 64.

5. A "*Baby Shower Loteria Bingo Game*", sold on Amazon.[16] The website states the game is for up to 10 players and includes 48 cards in English and Spanish. The website includes the following images:

[16] *Id.* at 70-72.

6. A game described as "*EQCstudios Loteria COVID-19*", sold on Amazon.[17] The website shows a COVID-themed Mexican-style bingo game. The website includes the following image:

7. A game titled "*Bible Loteria Game*", sold on Amazon.[18] The website shows a Bible-based Mexican-style bingo game and describes the game as "Bible bingo, [a] Bible game, scripture references and images on every loteria card." The website includes the following image:

[17] *Id.* at 79.

[18] *Id.* at 86, 112.

8. A game described as *"Loteria de Muertos Day of the Dead Lottery Bingo*", sold on Amazon.[19] The website's product description states:

> What's more fun than playing Loteria at family gatherings? Surprise your guests with the newest, cutest Loteria with symbols of the holiday! This is the Loteria de Muertos version which is designed using illustrations of skeletons and other Day of the Dead images. This is a fun game for all ages and can be a great tool for young people learning Spanish. Game comes with 10 large playing cards and a deck of 52 'calling' cards.

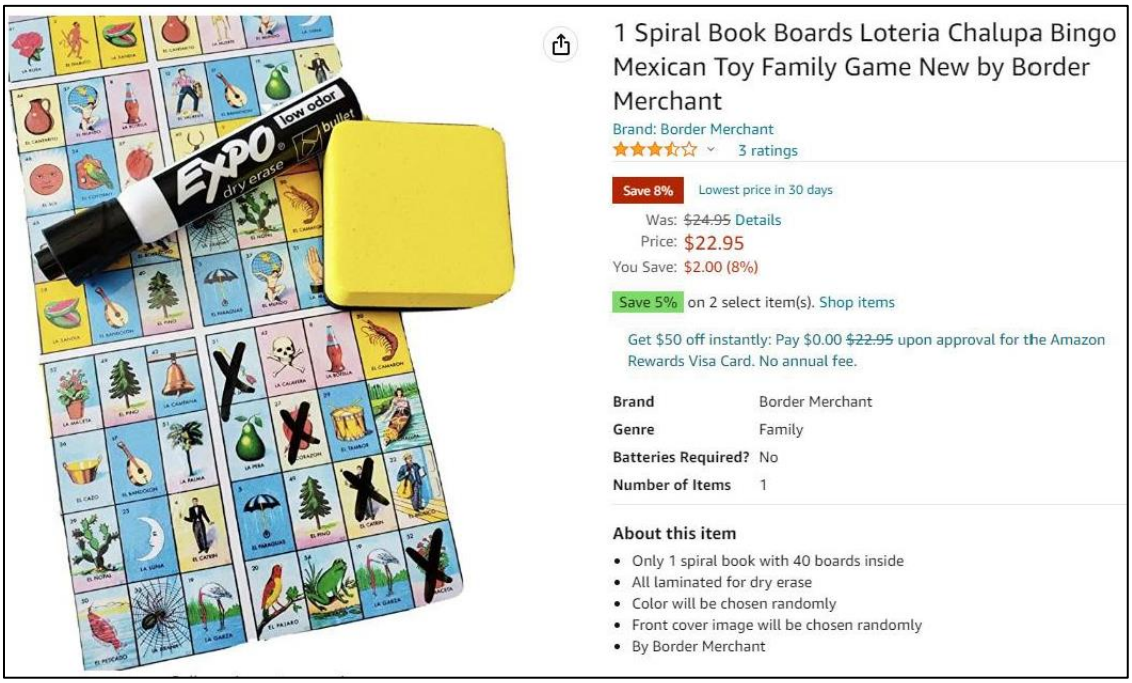
The website includes the following image:

[19] *Id.* at 94.

9. A game titled "Loteria Boricua: Puerto Rican Bingo Board Game-Loteria Game", sold on Amazon.[20] The game is described as a "Modern Loteria Bingo variation for Puerto Ricans." The website includes the following image:

[20] *Id.* at 102.

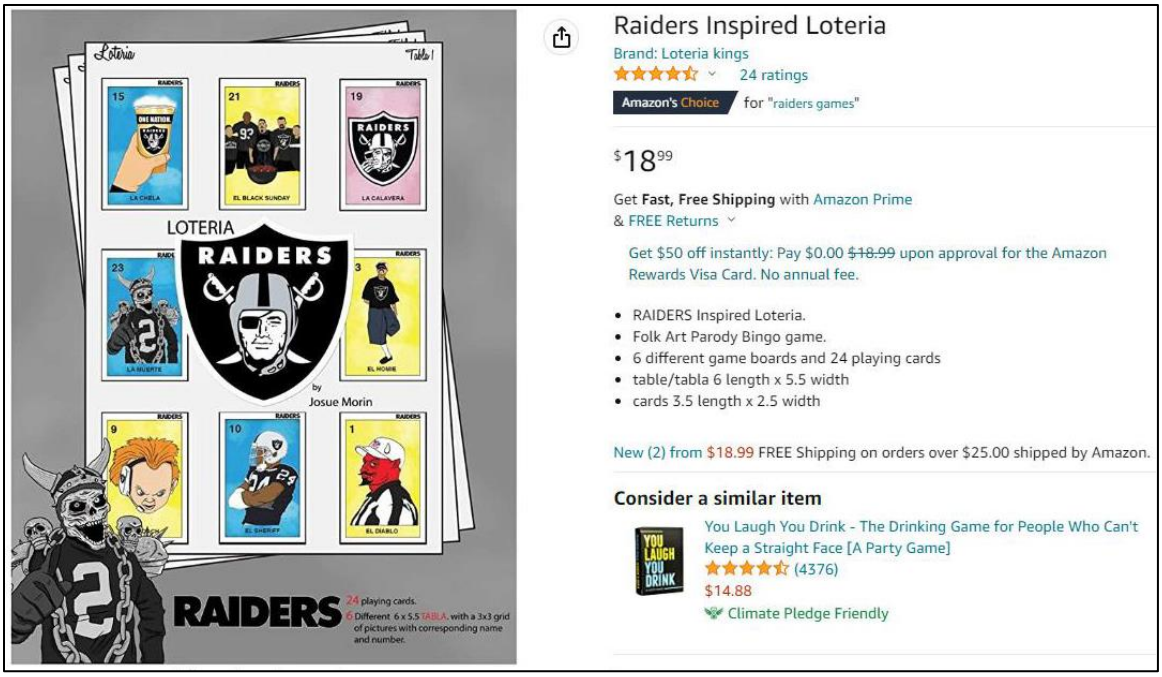
10. A book of boards for playing a game described as "*Loteria Chalupa Bingo*", sold on Amazon.[21] The goods appear to be spiral-bound books of Mexican-style bingo game boards with images:



11. A game described as "*Raiders Inspired Loteria*", sold on Amazon.[22] The game is described as a "folk art parody game" with "6 different game boards and 24 playing cards." The website includes the following image:

[21] *Id.* at 111.

[22] *Id.* at 113.



The Examining Attorney also introduced two general feature articles discussing loteria games. The first is a *Time* magazine article by Jasmine Aquilera titled '*It Needed to Be Modernized.' The Artists Recreating Lotería, the Iconic Mexican Game of Bingo*.[23] The article describes the work of numerous artists who have created updated versions of Mexican-style bingo with contemporary graphic images and themes. The article states, in part:

> Though Lotería is a board game, its roots go deeper than Monopoly or Scrabble. The game is a cultural tradition for many Latinos, and artists . . . are giving it a new life.
>
> * * *
>
> Gonzales is now among a range of artists throughout the U.S. and Latin America who have redesigned the classic Lotería, which is now more than a century old, though none have come as close to popular as the Clemente [Applicant's]

[23] *Id.* at 40.

> version. The most famous Lotería design we know today was created by Clemente, a French immigrant in Mexico who printed what he named the "Don Clemente Gallo" Lotería in his own factory. The version that we know today can be traced back to the early 1920s, according to Gloria Arjona, a Spanish lecturer at the California Institute of Technology who has done extensive research into the origins of each of Clemente's designs, and recently published a book titled *¡Lotería!*.
>
> More recently, artists have made Millennial Lotería, Women Power Lotería, Estar Guars Lotería and Lotería Salvadoreña, to name a few. In October, presidential candidate Joe Biden aired a campaign ad narrated by Julian Castro featuring new Lotería designs about American jobs. Texas fast food chain Whataburger even offers a free themed Lotería pack. These versions are all available online.[24]

The second article appeared online at Oprahdaily.com, the website of celebrity Oprah Winfrey.[25] The article, by Stephanie Castillo, is titled *How the Mexican Game Lotería Is Providing Comfort During a Pandemic*. The article describes the history of the game, modern versions of loteria, and how to play the game:

> How do you play lotería?
>
> The game is played similarly to bingo: there is a four-by-four "tabla" or board with images of different lotería cards. The "cantor" or caller draws a card from the deck and will recite a verse, short poem, or a riddle that alludes to the card to give players a hint. . . . You don't have to guess the card correctly in order to mark it down on your board with

[24] *Id.* at 40-49.

[25] *Id.* at 25.

> whatever you are using as a chip. . . . Once a player has four chips in a row, they say "lotería!" to claim their victory.

The Examining Attorney also introduced a Wikipedia entry for LOTERÍA from Wikipedia.org. According to the Wikipedia entry:

> Lotería (Spanish word meaning "lottery") is a traditional Mexican board game of chance, similar to bingo, and is played on a deck of cards instead of numbered ping pong balls. . . .
>
> * * *
>
> The origin of lotería can be traced far back in history. The game originated in Italy in the 15th century and was brought to New Spain (modern Mexico) in 1769. In the beginning, lotería was a hobby of the upper classes, but eventually it became a tradition at Mexican fairs.
>
> Don Clemente Jacques began publishing the game in 1887. His version of the game was distributed to Mexican soldiers along with their rations and supplies. The images Don Clemente used in his card designs have become iconic in Mexican culture, as well as gaining popularity in the U.S. and some European countries. . . . Other popular lotería sets are *Lotería Leo, Gacela* and *Lotería de mi tierra.*
>
> * * *
>
> With the rise of online gaming and app-based gaming, electronic versions such as the *Loteria online game* allow computer users to play an online version of the *Lotería Mexicana.*[26]

In response to the Examining Attorney's evidence of third party use of LOTERIA in connection with Mexican-style bingo games, Applicant argues that "[t]he fact that

[26] *Id.* at 21-24. Citations omitted.

third-party marks contain the word lotería does not mean that lotería is the generic name of a card game."[27] For support, Applicant relies on *In re Aloe Bioscience, LLC*, Ser. No. 85531266, pp. 18-19 (TTAB 2015) (non-precedential). In *Aloe Bioscience*, the Board stated that "[t]he fact that companies have used 'Bioscience' in their names to describe the nature of their business does not render 'Bioscience' generic for the goods at issue in this application." *Id*.

We do not find *Aloe Bioscience* to be binding or relevant precedent. The issue before us is not whether an "entity designator" (such as BIOSCIENCE) can be a generic term, as it was in *Aloe Bioscience*. None of the Examining Attorney's evidence shows that LOTERIA is being used as an entity designation. Rather, the evidence from online retailers shows that at least eleven different Mexican-style bingo game makers use the term LOTERIA to identify the nature of their goods. That is, the games are all Mexican-style bingo games with different themes illustrated in the playing cards, e.g., Millennial Lotería, Baby Shower Lotería, Bible Lotería, and Lotería Covid-19.

Furthermore, the fact that Applicant uses the name DON CLEMENTE with the term LOTERIA in its marks for use in connection with bingo game playing equipment (Reg. No 2317479) and scratch-off lottery tickets (Reg. No. 5003661) may suggest that Applicant has previously recognized that LOTERIA, by itself, is unable to serve as a source designation for its products comprising Mexican-style bingo games.

[27] Applicant's Br., p. 6, 15 TTABVUE 7.

Applicant's LOTERIA DON CLEMENTE may be the most successful and well-known LOTERIA game, but clearly it is not the only LOTERIA game.

As for the *Time* and Oprahdaily.com articles and the Wikipedia entry, Applicant is correct in noting that, generally, they "'may not be considered for the truth of the matters asserted therein,' but only 'for what they show on their face.'"[28] *But cf.*, *In re Embiid*, 2021 USPQ2d 577, at *5 n.19 (TTAB 2021) (Board is "more permissive regarding the use of hearsay in ex parte appeals" but "may still consider the hearsay nature of evidence in assessing its probative value in an ex parte proceeding"); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1597 (TTAB 2018) (same). These exhibits nevertheless show that consumers are exposed to stories that use the term LOTERIA as the generic name for Mexican-style bingo. Applicant admits as much when it states: "[a]t most, the Oprah Daily and Time articles show that an unknown number of persons who may or may not be users of gaming machines may have been exposed to what the examiner considers to be generic use of the term lotería."[29]

Taken as a whole, we find the Examining Attorney's evidence establishes that LOTERIA is the generic name of a Mexican-style bingo game of chance played with cards and boards featuring various images.

The Examining Attorney next argues that, when applied to Applicant's gaming machines, LOTERIA will be understood by the relevant public primarily to refer to the Mexican-style bingo game:

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[28] *Id.* at 7 (quoting *Ricardo Media Inc. v. Inventive Software, LLC,* 2019 WL 3956987, at *2 (TTAB 2019)).

[29] *Id.* at 7.

> With a gaming machine, the game is preloaded and the good being offered is, not just the machine, but the game itself. Thus, the name of the game is the generic name for the goods as well. . . . A gaming machine by definition has a game preloaded onto it, that is how one plays a game. Games can be played in many formats, this is merely an electronic version of the same game. Indeed, applicant's specimens show that the gaming machines are preloaded with a loteria game.[30]

Applicant argues that "there is nothing of record to show that the game played on LOTERIA gaming machines resembles applicant's card game."[31] We disagree. As shown by the partial image below, Applicant's gaming machines feature the wording LOTERIA DON CLEMENTE at the top and have various images from its game cards on the machine's display screen:

[32]

[30] Examining Attorney's Br., 6-7, 17 TTABVUE 6-7.

[31] Applicant's Br., p. 4, 15 TTABVUE 5.

[32] January 23, 2023 Response to Office Action, TSDR 132.

The images or symbols shown at the top of the machine and in its display-screen portion correspond to images, shown below, from Applicant's LOTERIA DON CLEMENTE game cards, albeit sometimes with different-colored backgrounds or cropped to fit the display squares.

[33]

Clearly, Applicant's gaming machines feature images from its LOTERIA DON CLEMENTE Mexican-style bingo game, as would be expected from the name at the top of the machine.

The record shows that gaming machines can be programmed with any number of different symbols or themes to be matched for prizes. These symbols or themes can be proprietary or generic but correspond to the game being played. For example, the third-party registrations submitted by Applicant for marks such as PAC-MAN, DOODLE JUMP, ALFRED HITCHCOCK, and ELVIRA MISTRESS OF THE DARK indicate that gaming machines can feature a number of different proprietary themes used in matching symbols.[34] Similarly, the Wikipedia entry for *Slot machine,* also introduced by Applicant, suggests that gaming machines are programmed with well-

[33] *Id.* at 98.

[34] July 20, 2023 Request for Reconsideration after Final Action, TSDR 13-14, 101-103, 107-114, 135-138.

recognized generic games such as poker and keno, various symbols to be matched such as pieces of fruit or bells, as well as media-franchise themes such as the movie character *Austin Powers* or the TV game show *Wheel of Fortune*.[35]

Given that LOTERIA is the generic name for a Mexican-style bingo game featuring multiple card images or symbols and that gaming machines can be programmed to give prizes for various combinations of images or symbols, we agree with the Examining Attorney that Applicant's Mexican-bingo style game, i.e., LOTERIA, "is the key aspect and central feature of the goods."[36] *See Cordua Rests.*, 823 F.3d at 603 ("[A] term can be generic for a genus of goods or services if the relevant public . . . understands the term to refer to a key aspect of that genus[.]"). Accordingly, we find that LOTERIA is generic when used in connection with Applicant's gaming machines featuring an image matching game. That is, when the term LOTERIA appears on gaming machines, it is "understood by the relevant public to refer primarily to" a Mexican-style bingo game played on the machine. *Marvin Ginn*, 782 F.2d at 991.

Applicant nevertheless argues that LOTERIA is not generic because Applicant "owns an incontestable registration on the Principal Register for the mark LOTERIA, covering 'playing cards' in Class 28 (Reg. No. 3029671). The examiner may believe

[35] *Id.* at 26-47.

[36] Examining Attorney's Br., p. 6, 17 TTABVUE 6.

that the granting of this registration was a mistake. Nonetheless, it is incontestable evidence that applicant owns a valid trademark."[37]

This argument is unpersuasive. This proceeding does not involve a challenge to Applicant's '671 Registration. Applicant's prior registration creates only a presumption of validity. "[T]he PTO always bears the burden of proving genericness[.]" *Cordua Rests.*, 823 F.3d at 600. Moreover, "[t]he presumption of validity of 15 U.S.C. § 1057(b) does not carry over from registration of the older mark to a new application for registration of another mark that happens to be similar (or even nearly identical)." *Cordua Rests.,* 823 F.3d at 600. Here, the identified goods for which Applicant seeks registration are different from those in the '671 Registration because they do not encompass "playing cards."

It is well settled that the USPTO is required to examine all trademark applications for compliance with each and every eligibility requirement, including non-genericness, even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect. *See, e.g., In re Shinnecock Smoke Shop,* 571 F.3d 1171, 1174 (Fed. Cir. 2009) ("Applicant's allegations regarding similar marks are irrelevant because each application must be considered on its own merits."); *In re Nett Designs, Inc.,* 236 F.3d 1339, 1342 (Fed. Cir. 2001) ("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."); *Cordua Rests.*, 823 F.3d at 600 ("Thus, whether or not [a term] was generic when it was registered, we,

[37] Applicant's Br., p. 5, 15 TTABVUE 6.

like the Board, must evaluate the evidence in the present record to determine whether there is sufficient evidence to establish that it is ineligible.").

B. Is LOTERIA (and the English equivalent LOTTERY) generic for gaming machines

The Examining Attorney further argues that LOTERIA is generic when used on the identified goods because "the mark is also generic as translated into English."[38] According to the Examining Attorney, "Applicant's 'slot machines and electronic gaming machines for playing games of chance' encompass those which are lotteries, that is, games of chance. They are a scheme for the distribution of prizes by chance. Lottery (and the equivalent Loteria) is the generic name for games of chance, such as applicant's."[39]

Although, as discussed above, we have found LOTERIA to be generic for Applicant's gaming machines featuring a Mexican-style bingo game, it is possible that some Spanish-speaking consumers are unfamiliar with Mexican-style bingo. That is, some Spanish-speaking consumers would understand LOTERIA only to translate simply to LOTTERY. We must consider the possibility in which such a relevant consumer is likely to "stop and translate" LOTERIA into its English equivalent, LOTTERY. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005) (quoting *In re Pan Tex Hotel Corp.*, 1976 WL 20921, at *2 (TTAB 1976). Accordingly, we also consider whether LOTERIA, which translates to LOTTERY in English, is generic when used on Applicant's goods.

[38] Examining Attorney's Br., p. 7, 17 TTABVUE 7.

[39] *Id.* at 8.

In starting our analysis, we note that the foreign equivalent of a generic English term is no more registrable than the English term itself. "Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks." *Id.*; *In re Sambado & Son Inc.*, 1997 WL 818020, at *4 (TTAB 1997) (FRUTTA FRESCA is equivalent to "fresh fruit" and thus generic and unregistrable for goods including "fresh fruits").

Applicant does not dispute that LOTERIA translates to LOTTERY inasmuch as Applicant submitted a statement that "The English translation of 'LOTERIA' in the mark is 'LOTTERY'."[40] In addition, Applicant's LOTERIA-formative registrations, listed above, all indicate that LOTERIA translates to LOTTERY.

Citing to U.S. Census Bureau data, the Examining Attorney next argues that Spanish is a common, modern language in the United States.[41] We agree, and find it likely that the ordinary American consumer would "stop and translate [LOTERIA] into its English equivalent." *Palm Bay*, 396 F.3d at 1377. *See also Ricardo Media, Inc. v. Inventive Software, LLC*, 2019 WL 3956987, at *8 ("We have consistently found that Spanish is a 'common language' in the United States, and we have routinely applied the doctrine of foreign equivalents to Spanish-language marks.").

[40] January 23, 2023 Request for Reconsideration, TSDR 6.

[41] July 14, 2023 Final Office Action, TSDR 16-21.

Thus, the only remaining issue is whether the relevant public understands LOTTERY "to refer to a key aspect" of gaming machines. *Cordua Rests.*, 823 F.3d at 603. We begin with the definition of the term "lottery," which is defined as:[42]

> 1 a : a drawing of lots in which prizes are distributed to the winners among persons buying a chance
> b : a drawing of lots used to decide something
> 2 : an event or affair whose outcome is or seems to be determined by chance.

A second definition of "lottery" defines the word as:[43]

> 1. a gambling game or method of raising money, as for some public charitable purpose, in which a large number of tickets are sold and a drawing is held for certain prizes.
> 2. any scheme for the distribution of prizes by chance.
> 3. any happening or process that is or appears to be determined by chance: *to look upon life as a lottery.*

From these definitions, we find that the crux of the term lottery is distributing prizes by chance, whether by the drawing of lots or some other "scheme" to determine a winner. Applicant's broadly worded goods, "Gaming machines, namely, slot machines and electronic gaming machines for playing games of chance," are not limited to a particular game. The identified goods simply specify that the games use "chance" in deciding whether the player wins. Given the broad wording in the identification of goods—no particular game is identified—we see no reason why Applicant's gaming machines could not encompass lotteries.

Applicant nevertheless argues that "[n]ot all games of chance are lotteries. For example, roulette, craps, and dice games are games of chance, but not lotteries.

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[42] Https://www.merriam-webster.com/dictionary/lottery, October 15, 2021 Office Action, TSDR 16.

[43] Https://www.dictionary.com/browse/lottery, July 14, 2023 Office Action, TSDR 11.

Likewise, gaming machines are not lotteries."[44] Applicant also argues that the "dictionary definitions of the word lottery do not encompass gaming machines. The definitions refer to drawings, events, affairs, schemes, happenings, and processes – not physical objects such as machines."[45]

In response, the Examining Attorney argues that Applicant's gaming machines could encompass lotteries:

> Applicant's "slot machines and electronic gaming machines for playing games of chance" encompass those which are lotteries, that is, games of chance. They are a scheme for the distribution of prizes by chance. Lottery (and the equivalent Loteria) is the generic name for games of chance, such as applicant's. Applicant argues that not all games of chance are lotteries and that, likewise, gaming machines are not lotteries. The questions of whether or not all games of chance are lotteries and what is the definition of "lot" are not relevant in this case because applicant's goods are broadly described to encompass those which are lotteries and for which a key aspect, feature and main characteristic is to play a lottery.[46]

We agree with Applicant that gaming machines could simulate any number of games, such as roulette, craps, dice games, or poker. Indeed, the evidence shows that they do. But, as noted above, we do not read Applicant's broadly-worded identification of goods to be limited to any particular game of chance. The fact that Applicant could provide other games of chance, besides lotteries, is not relevant in determining

[44] Applicant's Br., p. 2, 15 TTABVUE 3.

[45] *Id.*

[46] Examining Attorney's Br., p. 8, 17 TTABVUE 8.

registrability. It is enough that Applicant's gaming machines could include lotteries. *See Octocom Sys. Inc. v. Houston Computs. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods[.]"). Registration is properly refused if the subject matter for registration is generic of any one of the goods for which registration is sought. *See In re Wm. B. Coleman Co.*, 2010 WL 766487, at *5 (TTAB 2010); *In re Analog Devices, Inc.*, 1988 WL 252496, at *3 (TTAB 1988), *aff'd*, 871 F.2d 1097 (Fed. Cir. 1989) (unpublished).

Moreover, the fact that the dictionary definitions for the term LOTTERY do not mention gaming machines is not controlling on the question of registrability if the examining attorney can show that LOTTERY has a well understood and recognized meaning that is a key feature of Applicant's goods. *See In re Hikari Sales USA, Inc.*, 2019 WL 1453259, at *10 (TTAB 2019) ("[T]he presence or absence of [a term] in dictionaries is not controlling on the question of whether a term is generic.").

The Examining Attorney also submitted the following evidence from five websites, mostly directed to the gaming public, purporting to show that the term "'lottery' is used in the gaming industry to refer to electronic gaming machines."[47]

[47] Examining Attorney's Br., p. 9 17 TTABVUE 9; July 14, 2023 Office Action, TSDR 25-36 (emphasis added).

1. An excerpt from the Wikipedia entry for the term "**Video Lottery Terminal**" which states in part:

> A **video lottery terminal** (VLT), also sometimes known as a **video gaming terminal** (VGT), video slots, or the **video lottery**, is a type of electronic gambling machine. They are typically operated by a region's lottery, and situated at licensed establishments such as bars and restaurants. VLTs typically feature a selection of multiple games, primarily video slot machines and Keno.

2. An excerpt from the New York State government web page titled *How Gambling Machines Work*. The article states:

> Playing on a gambling machine is playing a game of chance. . . . Modern **gaming machines** use computer technology to operate their functions. . . . **Video Lottery Games** are linked to a Centralized System maintained by the Gaming Commission that tracks all information specific to the game, including its payout rate and win rate.

3. An excerpt from the West Virginia Lottery web page titled ***Video Lottery FAQ***. The web page states:

> In the state of West Virginia, **Video Lottery** is the legal use of player interactive **gaming machines** similar to those commonly known as "slot" machines in the casino industry. As of 1994, **video lottery** was approved, with restraints set forth by law, at West Virginia's four thoroughbred and greyhound racetracks. . . . In 2001, the West Virginia Legislature passed a bill allowing for a limited number of **video lottery machines** in adult environments.

4. An excerpt from the Oregon Lottery's **VIDEO LOTTERY** web page listing "All **Video Lottery Games**" available in the state. The web site states: "Try your luck and experience countless worlds of imagination as you decide between

dozens of exciting **Video Lottery** games!" The web site shows a variety of different image-matching games being offered, including themes such as poker, patriotic images, cats, and Chinese characters.

5. An article from the web page of "Professor Slots" providing a summary of *Delaware Slot Machine Casino Gaming*. The web site states: "*Delaware slot machine casino gambling* consists of three pari-mutuel racetracks offering **video lottery terminal (VLT) style gaming machines** controlled offsite by the state lottery and offering multiple games of video slots, video poker, video keno, and video blackjack."

The foregoing evidence, particularly the evidence from dictionaries and from state gaming authorities, is sufficient to establish that the term LOTTERY is generally accepted to refer to games of chance played on gaming machines. Simply put, relevant consumers are likely to understand that video lottery games are played on gaming machines. We find that the relevant public understands LOTTERY to refer to a key aspect of Applicant's goods: "Gaming machines, namely, slot machines and electronic gaming machines for playing games of chance." *Cordua Rests.*, 823 F.3d at 600 ("[A] term can be generic for a genus of goods or services if the relevant public . . . understands the term to refer to a key aspect of that genus—e.g., a key good that characterizes a particular genus of [goods or services]").

Applicant disagrees, and argues that "The websites introduced by the examiner do not show use of the word lottery, standing alone, for gaming machines."[48] This is

[48] Applicant's Br., p. 8, 15 TTABVUE 9.

not the test, however. A term also can be considered generic ""even if the public does not understand the term to refer to the broad genus as a whole." *See Cordua Rests.*, 823 F.3d at 605.

In sum, we find that the Examining Attorney has established by a preponderance of the evidence that LOTERIA is widely-recognized to be the name of a Mexican-style bingo game which is a central, or key, aspect of Applicant's gaming machines. The Examining Attorney also established by a preponderance of the evidence that the term LOTERIA translates to LOTTERY and describes a key aspect of video lottery gaming machines. *See Uman Diagnostics*, 2023 WL 2039689, at *16 (applying preponderance of the evidence standard). Taken as a whole, this evidence demonstrates that the relevant public would understand and use LOTERIA or LOTTERY primarily to refer to key aspects of gaming machines. Accordingly, we find that LOTERIA is generic for gaming machines "and should be freely available for use by competitors." *In re Cent. Sprinkler Co.*, 1998 WL 929628, at *4 (TTAB 1998) ("[B]ecause the term ATTIC directly names the most important or central aspect or purpose of applicant's goods, that is, that the sprinklers are used in attics, this term is generic and should be freely available for use by competitors.").

IV. Mere Descriptiveness

Although we have found Applicant's mark to be generic, for completeness, we address the alternate refusal that Applicant's mark is merely descriptive and that Applicant did not make a sufficient showing of acquired distinctiveness under Section 2(f).

Our finding that LOTERIA is generic subsumes a finding that the term is merely descriptive, because "[t]he generic name of a thing is in fact the ultimate in descriptiveness." *Marvin Ginn*, 782 F.2d at 989. That is, LOTERIA "immediately conveys knowledge of a quality, feature, function, or characteristic" of Applicant's goods, specifically that they are either Mexican-style bingo games played on gaming machines, or that they are lotteries played on gaming machines. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300 (Fed. Cir. 2012) (quoting *In re Bayer AG*, 488 F.3d 960, 963 (Fed. Cir. 2007)). Accordingly, we find that LOTERIA is merely descriptive.

V. Acquired distinctiveness

Acquired distinctiveness, and more specifically, the issue of whether Applicant did or did not meet its burden of proving that its proposed mark has acquired distinctiveness within the meaning of Section 2(f) is the only issue that remains.

Whether acquired distinctiveness has been established is a question of fact. *Schlafly v. St. Louis Brewery, LLC*, 909 F.3d 420, 423 (Fed. Cir. 2018) (citing *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1335 (Fed. Cir. 2015)). "To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself." *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005).

As for Section 2(f) evidence, the amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and the nature of the mark. *La. Fish Fry Prods.*, 797 F.3d at 1336. Based on the evidence discussed

above in connection with the genericness refusal, we find that Applicant's proposed mark LOTERIA is at least highly descriptive of Applicant's gaming machines. *See e.g., Uman Diagnostics*, 2023 WL 2039689, at *21 (finding NF-LIGHT "at the very least highly descriptive" of biological specimen analysis kits); *In re Guaranteed Rate, Inc.*, 2020 WL 4383820, at *4 (TTAB 2020) ("Because of the highly descriptive nature of the proposed mark, Applicant faces a proportionately higher burden to establish acquired distinctiveness.").

Applicant supported its claim of acquired distinctiveness with the following:[49]

1. A verified statement of five or more years' use, i.e., that "[t]he mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement."

2. A claim of ownership of the following four LOTERIA marks:

Mark	Reg. No.	Goods
LOTERIA (Typed drawing) The English translation of "LOTERIA" in the mark is "LOTTERY."	3029671	Printed matter, namely, paper napkins, paper place mats, coasters made of paper, paper flags and posters, in Class 16; and Playing cards, in Class 28.
LOTERIA The English translation of "LOTERIA" in the mark is "LOTTERY."	4752814	Posters; calendars; notebooks; note pads; blank journals; personal organizers; memopads; stickers; temporary tattoo transfers; writing paper; envelopes; greeting cards; paper coasters; paper mats; postcards; trading cards; paper party decorations; paper party bags;

[49] Applicant's July 12, 2023 Response to Office Action, TSDR 8-11.

Mark	Reg. No.	Goods
		paper napkins; paper place mats; paper invitations; decorative paper centerpieces; gift wrapping paper; paper goodie bags and lunch bags; paper banners; paper cake decorations, in Class 16.
LOTERIA The English translation of "LOTERIA" in the mark is "LOTTERY."	6040060	A wide variety of clothing articles, in Class 25.
LOTERIA The English translation of "LOTERIA" in the mark is "LOTTERY."	6873683	Non-medicinal cosmetic products and toiletry preparations; perfumery products; essential oils; makeup foundations; skin foundation; neutralizing foundations for lips; beauty masks; nail polish; lip gloss; hair styling solutions; shampoo; hair conditioner; cologne; cosmetics, in Class 3.

3. Evidence that LOTERIA is used "on a variety of products, which currently includes shirts, belts, hats, embroidered iron-on patches, keychains, wallets, hair care products, toy figurines, posters, jigsaw puzzles, coffee, hot sauce, beer, glassware, travel mugs, water bottles, dog and cat collars, dog leashes, and shower curtains."[50]

Applicant's evidence fails to establish acquired distinctiveness of the proposed mark LOTERIA for gaming machines. First, because we have found the wording LOTERIA to be highly descriptive of Applicant's goods, Applicant's statement of five years use does not establish acquired distinctiveness of the wording. *In re La. Fish Fry Prods.*, 797 F.3d at 1337 (The Board was within its discretion not to accept five

[50] Applicant's Br., p. 14, 15 TTABVUE 15; Applicant's September 4, 2023 Request for Remand, 11 TTABVUE 4-32.

years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness for highly descriptive mark.); *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Tech., Inc.*, 2017 WL 3600737, at *13 (TTAB 2017) (25+ years not sufficient to prove acquired distinctiveness); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 2013 WL 5407315, at *19 (TTAB 2013) (19 years use insufficient to prove acquired distinctiveness). Furthermore, while we acknowledge that absolute exclusive use is not required, substantially exclusive use is. 15 U.S.C. § 1052(f). The record establishes that multiple entities use the wording LOTERIA to identify Mexican-style bingo games similar to the game played on Applicant's gaming machines. Applicant's use is therefore not substantially exclusive.

Second, Applicant's claim of acquired distinctiveness based on its prior registrations likewise fails because the goods in those registrations are not sufficiently similar to the goods identified in the pending application. Trademark Rule 2.41(a)(1), 37 C.F.R. § 2.41(a), states:

> In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness **if the goods or services are sufficiently similar to the goods or services in the application**; however, further evidence may be required. (Emphasis added).

None of the registrations that Applicant relies on are for goods that are sufficiently similar to the goods in the involved application to support a claim of acquired distinctiveness. Cosmetics, clothing, and stationary products are clearly not similar to gaming machines. The most similar goods are playing cards, but even these goods

are only tangentially related to gaming machines. *See generally*, *In re Rogers*, 1999 WL 1427726, at *3 (TTAB 1999) (applicant must establish a sufficient relationship between the prior goods and the applied-for goods to warrant the conclusion that the mark's distinctiveness will transfer to the applied-for goods). Instead, we find that Applicant's other two registrations, listed below, are more relevant because they are for actual games or lottery tickets, but have disclaimed LOTERIA.

Mark	Reg. No.	Goods and/or Services
 The English translation of "**JUEGO DE LOTERIA**" is "game of lottery." "**JUEGO DE LOTERIA**" is disclaimed.	2317479	Board games, bingo game playing equipment, in Class 28.
 The English translation of "LOTERIA" in the mark is "LOTTERY." "**LOTERIA**" and "**SINCE 1887**" disclaimed.	5003661	Lottery tickets; Scratch cards for playing lottery games, in Class 28.

The disclaimer of LOTERIA in these registrations is a concession that the term is not inherently distinctive, at least when used on games and lottery tickets. *In re Six Continents Ltd.*, 2022 WL 407385, at *8 (TTAB 2022) (a disclaimer is a concession that a term is not inherently distinctive). Given the disclaimer of LOTERIA in

Applicant's registrations for more-similar goods, and the highly descriptive nature of the proposed mark, Applicant's prior registrations are insufficient to establish acquired distinctiveness of the mark. Trademark Rule 2.41(a)(1).

Third, regarding the evidence that LOTERIA is used on a variety of products, we note that none of the evidence relates to use of LOTERIA on gaming machines. Applicant has not explained how any distinctiveness from use of LOTERIA on the other goods will transfer to the applied-for goods. Nor has Applicant provided any sales revenues, advertising expenditures, or similar indicia of consumer recognition. Trademark Rule 2.41(a)(3)

Furthermore, much of the above evidence shows that Applicant's LOTERIA mark is always used in conjunction with the name DON CLEMENTE. This is insufficient to establish that LOTERIA, by itself, has acquired distinctiveness, particularly in light of the third-party uses of LOTERIA. *Guaranteed Rate*, 2020 WL 4383820, at *8 ("The USPTO and the Board have discretion to find such a use claim insufficient, especially where, as here, the mark at issue is highly descriptive and third parties use it in connection with the same kinds of services covered by Applicant's application."). *See also In re Mogen David Wine Corp.*, 372 F.2d 539, 542 (CCPA 1967) (holding evidence of a bottle design failed to prove secondary meaning where advertising depicting the bottle design always featured applicant's word mark); *In re Franklin Cnty. Hist. Soc'y*, 2012 WL 4285352, at *8 (TTAB 2012) (noting none of applicant's evidence showed use of the proposed mark "CENTER OF SCIENCE AND

INDUSTRY" without the acronym "COSI," while other evidence only used the acronym to refer to applicant's services).

Here, the plentiful evidence of third-party use of LOTERIA coupled with the absence of evidence such as sales and advertising figures, unsolicited media attention, or quantification of consumer impressions or views of the proposed mark, is fatal. "When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances." *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403 (Fed. Cir. 1984). We find that Applicant has failed to meet its burden of showing that the highly-descriptive wording LOTERIA has acquired distinctiveness for gaming machines.

Decision: We affirm the refusal to register Applicant's proposed mark LOTERIA on the ground that it is generic for the identified goods, and in the alternative, we affirm the refusal to register on the ground that the mark is merely descriptive and without acquired distinctiveness.