

THIS OPINION IS NOT A
PRECEDENT OF THE
T.T.A.B.

Mailed: November 16, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pictionary Inc.
v.
Spark Games LLC

Opposition No. 91167236
to application Serial No. 78407499
filed on April 24, 2004

Thomas A. Hallin of Harness, Dickey & Pierce, P.L.C. for
Pictionary Inc.

Dr. Parag Gupta pro se for Spark Games LLC.

Before Quinn, Kuhlke and Wellington, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Spark Games LLC, seeks registration of the
mark shown below for goods identified in the application as
"board games" in International Class 28.¹



Opposer, Pictionary Inc., has opposed registration of applicant's mark on the ground that, as applied to applicant's goods, the mark so resembles opposer's previously used, registered and applied-for marks Pictionary, Pictionary Junior, and Pictionary and design, for a variety of goods and services, including gaming devices and board games, "as to be likely confused therewith ... so as to cause confusion, mistake or deception as to the origin of Applicant's goods bearing Applicant's mark." The pleading also contains allegations related to a claim of dilution. However, inasmuch as opposer has not argued dilution in its brief, we have only considered the claim of priority of use and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has filed an answer by which it has denied the salient allegations.

BRIEFING AND EVIDENTIARY ISSUES

Opposer's motion to strike applicant's rebuttal brief filed on April 8, 2007 is granted. See TBMP §§ 539 and 801.02(d) (2d ed. rev. 2004) (there is no provision for filing a reply brief by a party in the position of defendant); and Trademark Rule 2.128.

¹ Serial No. 78407499, filed April 24, 2004, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), with "GAME" disclaimed.

Opposer's objection to certain documents attached to applicant's Notice of Reliance on the basis that they are not documents "contemplated as being admissible in this proceeding under 37 C.F.R. §2.122(e)," is sustained as to Exhibit No. E-6 (note regarding a trademark search) submitted under applicant's Notice of Reliance inasmuch as this is not a printed publication available to the general public or an official record, and thus not proper subject matter for a notice of reliance. See Trademark Rule 2.122(e); TBMP §§ 704.07 - 704.08 (2d ed. rev. 2004) (and cases cited therein). Opposer's objection to the list of registrations attached as Exhibit No. E-8 consisting of search results from the Trademark Electronic Search System (TESS) in the form of a list of applications and registrations is sustained, to the extent that a listing does not make the third-party registrations of record and is of little probative value. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1494 (TTAB 2007); *In re Duofold*, 184 USPQ 638 (TTAB 1974). With regard to Exhibit Nos. E-11 - E-16 and E-18 - E-25 (web pages, promotional flyer, and pictures of game box), we note that these materials are also not proper subject matter for submission under a notice of reliance. See TBMP §704.08. However, opposer specifically stated that it does not "object to whether these publications are properly subject to the

Notice of Reliance procedure." Opposer only argues that "they are probative only for what they identify on their face and not for the purpose Applicant has identified, namely, that these publications show a lack of a likelihood of confusion." Br. p. 13. In view thereof, we have considered these documents. Opposer's objection as to the probative value of these as well as other documents has been considered in our evaluation of the evidence for purposes of the merits discussed *infra*. In addition, applicant's objections set forth in its brief as to the relevance of certain of opposer's evidence have been taken into consideration in evaluating opposer's evidence.² Finally, the exhibits attached to applicant's brief are untimely and have not been considered. See TBMP §704.05(b).

The evidence of record consists of the pleadings herein; the file of the opposed application; applicant's responses to opposer's interrogatories and requests for admissions, printouts of excerpted articles, and certified copies of opposer's pleaded registrations, which show that the registrations are subsisting and owned by opposer,

² With regard to applicant's objection to the reference to two unrelated registrations in opposer's brief, these appear to be typographical errors and we have referred to the record which includes only opposer's registrations for various PICTONARY marks.

submitted by opposer under a notice of reliance;³ copies of third-party registrations and dictionary definitions submitted by applicant under a notice of reliance. Opposer and applicant did not take any testimony. Both parties filed briefs.

PRIORITY AND LIKELIHOOD OF CONFUSION

The pleaded registrations, which are in full force and effect and are owned by opposer, are summarized as follows:⁴

Registration No. 1392492 for the mark Pictionary (in typed form) for "equipment sold as a unit for playing a board game" in International Class 28, issued on May 6, 1986, renewed;

Registration No. 1515528 for the mark Pictionary (in typed form) for "clothing, namely, t-shirts and sweatshirts" in International Class 25, issued on December 6, 1988, Section 8 accepted and Section 15 acknowledged;

Registration No. 1549250 for the mark Pictionary (in typed form) for "computer game programs" in International Class 28, issued on July 25, 1989, Section 8 accepted and Section 15 acknowledged;

Registration No. 1581691 for the mark Pictionary JUNIOR (in typed form) for "equipment sold as A unit for playing a board game" in International Class 28, issued on February 6, 1990, Section 8 accepted and Section 15 acknowledged; and

Registration No. 2821448 for the mark Pictionary (in typed form) for "gaming devices namely, gaming and slot machines with or without video output" in International Class 9, issued March 9, 2004.

³ In addition to its registrations, opposer submitted certified copies of its two pleaded applications.

⁴ Although opposer also pleaded ownership of Registration No. 2390148 for the mark Pictionary and design for various items of clothing, this registration was cancelled under Section 8.

Because opposer has made the pleaded registrations summarized above properly of record, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first note that, other than excerpts of articles from various third-party publications, opposer did not present any evidence regarding its alleged common law rights in its various PICTONARY marks. Our determination here is thus made only as to the marks and goods listed in the pleaded registrations. Moreover, we have limited our determination of likelihood of confusion to the most

relevant registration, Registration No. 1392492 for the mark Pictionary for "equipment sold as a unit for playing a board game."

We first address opposer's assertion that its mark has become famous. In support of this allegation, opposer submitted copies of articles featuring Pictionary in various trade publications and publications of general circulation, e.g., Crain's New York Business, Adweek, Los Angeles Times, and Chicago Tribune. Opposer also submitted an excerpt from a document titled "Public Opinion Online" from the Roper Center of the University at Connecticut retrieved from the Lexis/Nexis database.

As stated by the Board in *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005), "In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it." The record in this case does not even approach establishing fame. Opposer has not provided any evidence about the extent of its sales, advertising, and overall use of the mark such that we can conclude that opposer's Pictionary mark can be considered a famous mark. See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22

USPQ2d 1453 (Fed. Cir. 1992). However, although we have found that the record is insufficient to support a finding of fame, in view of the evidence we do have of third-party references to opposer's mark in various publications over a period of twenty years, and registration by opposer of the mark for a wide variety of goods (e.g., clothing, board games and computer games), we find that it is a strong mark, at a minimum, in the field of board games, which accords it a commensurate higher level of protection.

We now consider the goods, the channels of trade and the class of purchasers. In making our determination, we must consider the opposer's and applicant's goods as they are described in the registration and application, and we cannot read limitations into those goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the registration and application describe goods broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration and application encompass all goods of the type described, that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

The goods identified in the subject application, board games, are legally identical to, or, at least, encompass the goods in opposer's Registration No. 1392492, namely equipment sold as a unit for playing a board game.

Considering the channels of trade and class of purchasers, inasmuch as there are no limitations in either the registration or the subject application, we must presume that applicant's and opposer's goods will be sold in the same channels of trade and will be bought by the same classes of purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

In view of the above, the du Pont factors of the similarity of the goods, the channels of trade and class of purchasers favor a finding of likelihood of confusion.

With regard to the conditions of sale, these goods include general consumer items that would not be purchased with a great deal of care or require purchaser sophistication.

We now turn to consider the similarity or dissimilarity of the marks when compared in their entirety in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a

side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. Moreover, where the goods are identical "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).

In arguing that the marks are dissimilar, applicant states that QUESTIONARY is a word which has a meaning whereas PICTONARY is "a made up word." QUESTIONARY is defined as "a set of questions for submission to a group of persons for the purpose of bringing out their resemblances and differences in the matter considered" Webster's Revised Unabridged Dictionary (1998). In addition, applicant argues that the dominant portions of the marks are respectively QUEST and PIC or PICT. Further, applicant states that its mark contains additional wording and is much longer. Applicant contends that all of these elements contribute to the differences in sound, appearance and commercial impression of the marks. As to connotation, applicant argues that its mark connotes a set of questions whereas opposer's mark has a connotation of a "picture with somewhat

unclear connotation towards dictionary or so." Br. p. 14. Applicant argues that the only point of similarity is the "generic" and weak suffix "TIONARY" and that cannot be sufficient to preclude others from using this suffix for games.

In contrast, opposer contends that the entire word QUESTIONARY is the dominant element in applicant's mark and the additional terms in the mark do "not distract from the fact that the marks are similar in appearance." Br. p. 25. In addition, opposer argues that the marks are similar in sound in the same manner as PLAY-DOH and FUN DOUGH. See Kenner Parker Toys, *supra*. Opposer further argues that the marks have similar connotations in that "a question or two may be asked during the play of the PICTONARY brand game [and] 'questions' and 'pictures' are similar methods for conducting a game." Br. p. 28. As to commercial impression, opposer argues that it is using its mark in connection with a game that uses "a series of questions ... to identify a picture drawn by the game players" and applicant's game uses a series of questions to identify a word.

In comparing the marks PICTONARY and QUESTIONARY THE GAME OF SMART QUESTIONS within the above-noted legal parameters, we find the points of similarity outweigh the dissimilarities. *ESSO Standard Oil Co. v. Sun Oil Co.*, 229

F.2d 37, 108 USPQ 161, 163 (D.C. Cir. 1956). We first observe that the term QUESTIONARY is the dominant element in applicant's mark. It is displayed prominently and the additional wording "THE GAME OF SMART QUESTIONS" serves more to describe the product rather than to identify the source of the product. Recognizing that QUESTIONARY and Pictionary begin with different elements, we find in this case that the identical sound and appearance of the suffix presents a similarity sufficient to create a likelihood of confusion. Given the identical goods, trade channels and class of purchasers, we find that the overall commercial impression engendered by each of these marks is such that the similarities outweigh the differences. As to connotation, while applicant's mark has a meaning, both marks evoke the word "dictionary" and, consequently, the use of words in these games of inquiry. Taking into consideration the strength of opposer's mark, we conclude that the parties' marks are substantially similar.

In making our determination we have considered applicant's argument that the suffix "TIONARY" is weak. In support of this contention, applicant submitted copies of third-party registrations and a listing of third-party registrations.

Under the du Pont factors, existence of widespread third-party use may serve to indicate the weakness of a term

in the context of its source identifying significance. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). However, while third-party registrations may, in some circumstances, be used to indicate that a term has been commonly adopted in a particular field or may be used in the manner of dictionary definitions to indicate the descriptive or suggestive significance of a term, they are not probative of third-party use. Compare *In re Hamilton Bank*, 222 USPQ 174, 177 (TTAB 1984) ("Such registrations are ... competent to show that others in a particular area of commerce have adopted and registered marks incorporating a particular term. We can also note from such registrations that the term or feature common to the marks has a normally understood meaning or suggestiveness in the trade") with *AMF Inc. v. American League Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (CCPA 1973) ("We have frequently said that little weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them") Thus, the record does not support a finding that petitioner's mark is a weak mark due to widespread third-party use.

To the extent the registrations underscore that "TIONARY" is a common suffix we do not find this sufficient evidence upon which we may conclude that consumers would disregard this suffix and rely on the prefix to distinguish the marks. There are only three third-party registrations of record that are for related goods and are not cancelled (Reg. No. 2831196 for the mark CONSTRUCTIONARY for, inter alia, board games; Reg. No. 2900871 for DICKTIONARY for, inter alia, board games; and Reg. No. 2687829 for EMOTIONARY for, inter alia, board games).⁵ Moreover, the listing of third-party registrations is not probative inasmuch as it does not indicate the goods listed in the registrations. We further note that the vast majority of the marks in the list are very different from applicant's and opposer's marks, e.g., Reg. No. 3000348 for the mark PATRICK HENRY'S REVOLUTIONARY BLOODY MARY MIX.

Applicant also points to the correspondence from the USPTO in its application file noting that no similar registered or pending mark has been found to bar registration under Section 2(d). However, it is well-

⁵ Cancelled registrations are not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. See *In re Hunter Publishing Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation "destroys the Section [7(b)] presumptions and makes the question of registrability 'a new ball game' which must be predicated on current thought."). "[A] canceled registration does not provide constructive notice of anything." *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989).

settled that the Board is not bound by prior decisions of examining attorneys. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and In re Sunmarks Inc., 32 USPQ2d 1470 (TTAB 1994).

Finally, applicant argues that there is no evidence of actual confusion during the three years in which the marks have been used. While there is evidence that applicant first used its mark in February 2004, Opposer's Notice of Reliance Exh. No. 9, Interrogatory No. 12, there is nothing in the record to indicate whether and to what extent there has been overlapping use of the parties' respective marks. In any event, the relevant test is likelihood of confusion; it is not necessary to show actual confusion. Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). We consider this factor to be neutral.

Thus, considering the marks in their entireties, we conclude that the evidence of record as it pertains to the relevant du Pont factors supports a finding of a likelihood of confusion as between applicant's QUESTIONARY THE GAME OF SMART QUESTIONS mark and opposer's PICTONARY mark, such that registration of applicant's mark is barred under Trademark Act Section 2(d). To the extent we have any doubt, we must resolve that doubt in favor of opposer, the prior registrant. See Hard Rock Cafe International (USA)

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Inc. v. Thomas D. Elsea, 56 USPQ2d 1504, 1514 (TTAB 2000)
and W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.,
190 USPQ 308, 311 (TTAB 1976).

Decision: The opposition is sustained as to opposer's
claim of priority and likelihood of confusion under Section
2(d) of the Trademark Act.