

Hearing:  
November 12, 2009

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
January 27, 2010  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Paul D. Miller

Serial No. 77332676

Matthew G. McKinney of McKinney Law, LLC for Paul D. Miller.<sup>1</sup>

Jennifer Vasquez, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Walters, Bucher and Kuhlke, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Paul D. Miller seeks registration on the Principal Register of the mark **COMMANDER-IN-CHIEF** (*in standard character format*) for "equipment sold as a unit for playing board games" in International Class 28.<sup>2</sup>

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to

---

<sup>1</sup> Although applicant was represented by counsel throughout the prosecution of this application, he appeared *pro se* at the oral hearing.

<sup>2</sup> Application Serial No. 77332676 was filed on November 19, 2007 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has taken the position that applicant's mark, when used in connection with the identified goods, so resembles the mark **COMMANDER IN CHIEF** (*also in standard character format*) registered for, *inter alia*, "playing cards"<sup>3</sup> also in International Class 28, as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the issues involved in this case and an oral hearing was held before this panel of the Board on November 12, 2009.

In urging registrability, applicant argues that inasmuch as the two marks are "not identical," in order to find a likelihood of confusion, the relationship between the respective goods must be closer than would be the case if the marks were identical. As to the goods, applicant argues that "playing cards" and "equipment sold as a unit for playing board games" are distinctly different - not complementary or companion items. As to the Trademark Examining Attorney's purported evidence that some board games may actually contain playing cards, applicant argues

---

<sup>3</sup> Registration No. 2924653 issued to Olde Mill Company, Inc. on February 8, 2005.

that none of these copies of Internet printouts show "playing cards" when that term is correctly identified as "a deck of fifty-two playing cards that includes thirteen ranks of each of the four suits ... " as used in playing card games such as poker. As to the evidence drawn from third-party registrations, applicant claims that it is unreasonable for the Trademark Examining Attorney to rely upon "only four registrations out of the millions of trademark registration to support a finding of the relatedness of the Applicant's goods and the Registrant's goods." Finally, during his oral argument, applicant emphasized that in the real world, even if registrant still uses this mark on playing cards, the chances of confusion herein would be *de minimis*.

By contrast, the Trademark Examining Attorney contends that the marks "create the same commercial impression and are nearly identical." This finding is significant, according to the Trademark Examining Attorney, because of the close relationship of the goods, namely, that (i) applicant's identified goods are closely related to registrant's goods, (ii) presumably they move in the same channels of trade as do registrant's goods and (iii) they are within the logical zone of expansion of trade of registrant's goods.

**Preliminary matter**

Before getting to the issue of likelihood of confusion, we note that the evidence attached to applicant's brief, which was not introduced into the record during the prosecution of the application, is untimely. Trademark Rule 2.142(d), 37 C.F.R. 2.142(d). The Trademark Examining Attorney argues that this evidence should be disregarded, as its submission constitutes an improper reopening of examination. *Rexall Drug Co. v. Manhattan Drug Co.*, 128 USPQ 114 (CCPA 1960); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984); *In re Envoys U.S.A., Inc.*, 221 USPQ 646 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); and *In re Gagliardi Brothers, Inc.*, 218 USPQ 181 (TTAB 1983). The Trademark Examining Attorney did not consider this evidence, and neither do we. Inasmuch as the Trademark Examining Attorney had no opportunity to rebut this uncorroborated Wikipedia submission, we have disregarded it in reaching our decision herein. *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032-33 (TTAB 2007). Nonetheless, we hasten to add that even if we had considered this submission, it would not change our decision herein.

### **Likelihood of Confusion**

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. See *In re E. I. du Pont de Nemours & 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); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

### **Similarity of the marks**

We turn first to the *du Pont* factor focusing on the similarities or dissimilarities in the appearance, sound, connotation and commercial impression of the respective marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant makes much of the fact that the two marks herein are not identical given that applicant's mark includes hyphens between the three words (**COMMANDER-IN-CHIEF**), while the registrant's mark has spaces (**COMMANDER IN CHIEF**). However, we agree with the Trademark Examining Attorney that the presence of hyphens in applicant's mark provides for a negligible difference in appearance that might well be overlooked by many potential consumers of these goods. Furthermore, the test is not whether the respective marks can be distinguished when subjected to a side-by-side comparison. Rather, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Undeniably, applicant's hyphenated mark will be pronounced precisely the same as registrant's non-hyphenated mark.

Similarly, both marks create precisely the same connotation, namely the supreme commander of a nation's as armed forces.<sup>4</sup> And although applicant cites to cases such

---

<sup>4</sup> "COMMANDER IN CHIEF: defn. one who holds the supreme command of an armed force," *MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY* (11<sup>th</sup> ed. 2003).

as *In re Nobody's Perfect, Inc.*, 44 USPQ2d 1054 (TTAB 1997), there is no analogous situation in this case to the fact that Nobody's mark suggested that its "seconds" apparel items were less than perfect, while that registrant's mark playfully suggests the imperfections

present in a woman's torso or overall physique. *Cf. In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984).

In addition to being aurally identical and having the same connotations, we find that the presence or absence of a hyphen, like other items of punctuation or similar symbols does not change the commercial impressions of these marks. *In re Burlington Industries, Inc.*, 196 USPQ 718, 719 (TTAB 1977) ["[A]n exclamation point does not serve to identify the source of the goods"].

Applicant concludes that the difference in these marks favors his position, and that any finding of likelihood of confusion, as urged by the Trademark Examining Attorney, would require an especially-close relationship between the goods. We disagree. These marks

**NOBODY'S  
PERFECT**

For applicant's apparel retail store services primarily selling goods of irregular quality

v.

**NO BODY'S  
PERFECT**

For registrant's feminine underwear

are substantially identical, and this factor weighs heavily in favor of a finding of likelihood of confusion.

**Relationship of the Goods**

As noted above, when the marks are substantially identical, the relationship between the involved goods need not be as close to support a holding of likelihood of confusion as might apply where more significant differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Melville Corp.*, 18 USPQ2d 1386, 1387 (TTAB 1991); *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983); and *Ancor, Inc. v. Ancor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981).

During his oral argument, applicant tried to focus on registrant as a purveyor of inexpensive gifts ornamented with federal images and targeted to tourists in the nation's capital, who may, in fact, no longer use this mark on playing cards. We acknowledge that the cited registration has seven International Classes of goods, listing, in particular, the types of gift items popular in shops in touristy areas (e.g., mouse pads, magnets, pens, stationery, notepads, glasses and mugs, items of casual clothing, playing cards, golf balls and candy).

On the other hand, it is well settled that the issue of likelihood of confusion between an applied-for mark and a registered mark must be determined on the basis of the goods as they are identified in the involved application and cited registration, not on the basis of whatever the extrinsic evidence may show. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); *Paula Payne Products Company v. Johnson Publishing Company*, 177 USPQ 76 (CCPA 1973); and *In re William Hodges & Co., Inc.*, 190 USPQ 47 (TTAB 1976). In this regard, it would be improper to permit applicant to restrict the scope of registrant's registration based upon extrinsic evidence. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Accordingly, in the present case, without resort to extrinsic evidence, we must presume that registrant's playing cards might well be found nationwide wherever playing cards are found.

Applicant also contends that the Trademark Examining Attorney has interpreted the term "playing cards" incorrectly. Applicant argues that when this term appears alone (i.e., not as a component of, or equipment for, a

board game) in a registration, as it does in the cited registration, it should be interpreted as being a standard pack of fifty-two playing cards. Undeniably, the standard fifty-two card deck is within the umbrella of "playing cards." However, the Trademark Examining Attorney counters that traditional board games come with a variety of types of game cards, many of which are referred to as "playing cards."<sup>5</sup> The Examining Attorney shows that some "playing cards" may be representative of ancient coins,<sup>6</sup> as well as a myriad of other types of game cards:



Board game from Rio Grande Games, having eight *playing card sets*<sup>7</sup>



Age of Conan Board Game from Fantasy Flight Games having 165 *Playing Cards*<sup>8</sup>



Snowman Battle includes *playing cards* and extra game cards unique to this battle game!<sup>9</sup>

<sup>5</sup> "... [Odyssey TV game] also came with two hand controls and such traditional board game equipment as dice, *playing cards*, and play money..." <http://www.ideafinder.com/history/inventions/pong.htm>

<sup>6</sup> [http://www.pywacketgames.com/Pages/Cromlet\\_Contents.html](http://www.pywacketgames.com/Pages/Cromlet_Contents.html) - 105 "*Playing Cards*" (representing each of the 100 Coin quantities on the game board plus five "Wild" cards).

<sup>7</sup> [http://www.coolstuffinc.com/main\\_boardGame.php?viewType=view%20board%20games&fp=Acc-BGUPAlhambra3#Alhambra:%20The%20Thief's%20Turn%20Expansion](http://www.coolstuffinc.com/main_boardGame.php?viewType=view%20board%20games&fp=Acc-BGUPAlhambra3#Alhambra:%20The%20Thief's%20Turn%20Expansion)

<sup>8</sup> [http://www.coolstuffinc.com/main\\_boardGame.php?viewType=view%20board%20games&fp=Acc-AgeofConan#Age%20of%20Conan%20Board%20Game](http://www.coolstuffinc.com/main_boardGame.php?viewType=view%20board%20games&fp=Acc-AgeofConan#Age%20of%20Conan%20Board%20Game)

<sup>9</sup> <http://www.speechtherapygames.com/winter.htm>

Conversely, applicant argues that whenever the term "playing cards" is used to identify equipment for playing a board game, it always means game cards other than the fifty-two card set that might be used to play poker. While this is often the case in the games that populate the attachments placed into the record by the Trademark Examining Attorney, the record shows that this is not always true. One or more traditional fifty-two card decks are indeed critical contents of board game known as **CRIBBALL**,<sup>10</sup> **KINGS IN THE CORNER**,<sup>11</sup> **TRIPOLEY**,<sup>12</sup> **SEQUENCE** and **PO-KE-NO**:

## Sequence Board Game

The Sequence board game is the commercial version of an old card game called *Jack Foolery*. It is an exciting game of strategy for two to twelve players and is simple enough for children but still a challenge for adults. It is a great addition to a [family game night](#) and is suggested for players age seven to adult.<sup>13</sup>



---

<sup>10</sup> CRIBBALL: a sports contest for cribbage players from Anderson Game Co that uses a standard pack of fifty-two playing cards <http://boardgamesrus.com>

<sup>11</sup> "Kings in the Corner Game -- ... Kings go in the corners. Play your cards solitaire fashion and extend your turn as long as you can." <http://www.tkstoystand.com/>

<sup>12</sup> **Tripoley Special Tin Box Edition**  
This is a limited edition of Tripoley with special gold and silver chips, revolving tray, and higher quality playing cards. (Same contents as the Special Edition, offered in a conventional box.) <http://www.gamepreserve.com/>

<sup>13</sup> <http://boardgames.lovetoknow.com/Sequence Board Game>



#### PO-KE-NO Board Game

The thrill of Poker, the anticipation of Bingo!

2-13 players, for older kids and adults alike. With 5 ways to play, the fun never stops! So, shuffle up and deal. This **PO-KE-NO** set is brought to you by **Bicycle**, which is your assurance of a quality game.

This set includes everything you and your friends need to have an enjoyable evening. The basic game of **PO-KE-NO** is similar to Bingo, but is played with *playing cards* instead of bingo balls...



14

Finally, additional websites that the Trademark Examining Attorney made part of the record show other board games, like those discussed above, whose equipment includes "playing cards,"<sup>15</sup> as well as examples where a single manufacturer or merchant is marketing the standard fifty-two card deck of playing cards in close proximity to board games and other tabletop, card or role-playing games.<sup>16</sup> We view

<sup>14</sup> <http://www.playingcardsandmore.com/po-ke-no.aspx> and <http://www.playingcardsandmore.com/> We note that the PO-KE-NO games is "brought to you by 'BICYCLE'" playing card company, the leader in the field of playing cards.

<sup>15</sup> <http://www.boardgames.com/>

<sup>16</sup> <http://www.hasbro.com/> and <http://www.usgamesinc.com/>

this as probative evidence that the listed goods will be viewed by consumers as emanating from a single source.

In reviewing this prosecution, however, we do agree with applicant that the particular examples from the Trademark Examining Attorney's small sampling of use-based, third-party registrations showing the same mark registered for both playing cards and board games adds very little of probative value to her Internet evidence.

Conversely, the examples applicant put forward to show the same mark registered by separate parties for board games and playing cards is wholly unpersuasive of an Office practice contrary to that suggested by the Trademark Examining Attorney. The applicant's recited examples represented different marks (**TIGERS** v. **TIGER**, **COBRA** v. **COBRA and design**, **JAGUAR** v. **JAGUAR and design**), admittedly weak marks in this field (**TIGER(S)**), examples where the item "playing cards" had been eliminated from the identification of goods entirely (**TIGERS** and **COBRA**), or where the respective goods had no overlap with the goods at issue in the current case (**JAGUAR**).

Finally, as we recently observed, "the concept of expansion of trade is generally addressed in the context of the issue of priority in an *inter partes* proceeding" [*In re*

*1st USA Realty Professionals, Inc.*, 84 USPQ2d 1581 (TTAB 2007)], but priority of use is not an issue in an *ex parte* proceeding. Rather, in this *ex parte* context, we apply the traditional analysis of the relatedness of the involved goods and/or services, and have not considered the Trademark Examining Attorney's arguments as to "expansion of trade."

In summarizing this *du Pont* factor, we find that the Trademark Examining Attorney has shown that applicant's identified goods are related to registrant's goods, and this factor favors a finding of likelihood of confusion.

**Channels of trade and conditions under which and buyers to whom sales are made**

We turn to two related *du Pont* factors that focus on the similarity or dissimilarity of established, likely-to-continue trade channels, and the conditions under which and buyers to whom sales are made.

Neither registrant's goods nor applicant's goods are limited by classes of purchasers. Although applicant argues that registrant's goods should be restricted to a narrow, niche channel of trade, we must presume that both registrant's goods and applicant's goods will be available through all normal trade channels, including toys stores and game stores, where they will be encountered by all

types of potential customers, including children and adults. Given the retail costs of playing cards and board games, we cannot assume potential purchasers will be especially thoughtful in purchasing such goods. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); and *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977). These related *du Pont* factors also favor a finding of likelihood of confusion herein.

**Conclusion: Likelihood of Confusion**

In conclusion, the *du Pont* factors favoring a finding of likelihood of confusion include the fact that the marks are substantially identical, the goods are related, and we must presume that they will move through some of the same channels of trade to the same classes of ordinary consumers.

*Decision:* The refusal to register this mark based upon Section 2(d) of the Lanham Act is hereby affirmed.