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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77445498
Applicant	Planet Bingo, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	PLANET BINGO, INC.	)
		)
Serial No.:	77/445,498	)
		) **APPLICANT'S REPLY BRIEF**
Filing Date:	04/10/2008	)
		)
Mark:	B1 PLANET BINGO (and design)	)
		)
		)

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April 3, 2009

I hereby certify that on the 3rd day of April, 2009, this correspondence is being filed electronically via EFS-Web.

/Karen J. Sepura/
Karen J. Sepura

APPLICANT'S REPLY BRIEF

Dear Sir:

Applicant hereby submits this Reply Brief in support of its appeal from the Examining Attorney's December 2, 2008 final refusal to register the above-referenced mark, and in response to the Examining Attorney's Appeal Brief dated March 18, 2009.

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I. PRELIMINARY STATEMENT

This appeal comes down to whether or not this mark

is likely to cause confusion with this mark B1 GAMES. In conducting a likelihood of confusion analysis, the obvious fundamental differences between these two marks cannot be overlooked. These two marks look different, they sound different, they mean different things, and they convey different commercial impressions. While the registrant's mark, B1 GAMES, begins with B1 and Planet Bingo's mark includes a design with a bingo ball having a B1 designation, that is where the slight similarities between these marks end. Planet Bingo respectfully submits that after a proper consideration of the marks in their entireties, no likelihood of confusion exists. This compels a reversal of the Examining Attorney's final refusal to register applicant Planet Bingo's mark, B1 PLANET BINGO (and design).

II. ARGUMENT

A. The Board May Take Judicial Notice of Commonly Known Facts, Including Elements of the Traditional Game of Bingo

The Examining Attorney acknowledges that the facts presented in Planet Bingo's opening brief are accurate. *See* Examining Attorney's Brief ("EA Brief"), p. 2. In spite of this, in the Examining Attorney's brief, objection is made to Planet Bingo's inclusion in its recitation of facts section information about the traditional game of bingo. Planet Bingo noted early on some common facts about the traditional game of bingo. For example, it noted that B1 "is the first letter number combination of bingo." *See* Response to Office Action, dated November 18, 2008. It also noted that "B1 is one of the squares on the B section of some bingo cards." *See* Request for Reconsideration, dated December 12, 2008. These facts are in the record, and no

objection was made to them below. In any event, the traditional game of bingo is a commonly understood game. It is common knowledge that the traditional game of bingo includes the basic elements described by Planet Bingo in its opening brief, and that it is played in the manner so described. This includes the fact that the first bingo ball in the traditional game of bingo is designated as "B1." Accordingly, the Board may take judicial notice of these facts, and Planet Bingo respectfully requests that it do so. *See* TBMP § 1208.04 ("The Board may also take judicial notice of…commonly known facts."); *see also In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 n.5 (TTAB 2001) (noting that "Although there is no evidence of record on these points, it is common knowledge that radio broadcasts may be heard in realtime on the Internet."); *In re Major League Umpires*, 60 USPQ2d 1059, 1060 n.2 (TTAB 2001) (taking "judicial notice that the National League is part of Major League Baseball"); and *In re Dial-A-Mattress Operating Corp.*, 52 USPQ2d 1910, 1916 (TTAB 1999), rev'd. on other grounds, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (taking judicial notice "that toll-free telephone area codes such as '1-888' are used by numerous persons and businesses").

The Examining Attorney also objects to Planet Bingo's comments regarding the publicly-available information on the registrant's web site and B1 portion of the cited registration, B1 GAMES. The information on registrant's web site is readily available and accessible on the Internet, and the Examining Attorney does not contend otherwise. Tellingly, the Examining Attorney has not questioned or objected to the content of the information, but rather, has merely objected to Planet Bingo's timing in discussing it. The Board, in its discretion, may take judicial notice of the fact that the website www.b1games.com exists and that it includes the following text: "[t]he name 'B1' symbolizes our belief in bringing families and friends together for a truly interactive shared experience."

For these reasons, Planet Bingo respectfully submits that the information included in the facts section of its opening brief may be properly considered, notwithstanding the Examining Attorney's objection thereto.

B. The Dominant Portion of Planet Bingo's Mark is PLANET BINGO

As the Examining Attorney has acknowledged, "[w]hen a mark consists of a word portion and a design portion, the *word portion* is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services. EA Brief, p. 7 (emphasis added). As discussed above, the Board may take judicial notice that B1 is the designation for the first bingo ball used in the traditional game of bingo. The Examining Attorney does not dispute that the first bingo ball in the traditional game of bingo is so designated. What is disputed is which portion of Planet Bingo's mark comprises the word portion and which portion comprises the design portion.

Here, Planet Bingo respectfully submits that it is clear that the word portion of its mark is PLANET BINGO, while the design portion consists of five bingo balls appearing behind the PLANET BINGO name, with the first bingo ball designated as a B1 bingo ball. By definition, the B1 designation is part of the *design* of that bingo ball. That Planet Bingo did not seek to register "B1" as part of its mark PLANET BINGO is telling. The B1 designation is *not* part of the PLANET BINGO name, and the Examining Attorney's own arguments demonstrate that it is unreasonable to interpret Planet Bingo's mark in this manner. In this regard, in support of his position, the Examining Attorney states that the oval in which the "B1" bingo ball designation appears is "in large font almost as large as most of the other wording, PLANET BINGO." EA Brief, p. 9. Rather than supporting his position, this argument actually works against it. In this

regard, if the Examining Attorney's statement that the "oval is in large font" is adopted, then the "oval" should actually be construed as the letter "O" rather than an oval. In that case, Planet Bingo's mark could be construed as "OPLANET BINGO B1" or "OB1 PLANET BINGO" or some other variation thereof. But this is not a logical construction. This further supports Planet Bingo's position that it is unreasonable to include the B1 designation in the mark that Planet Bingo seeks to register.

Further, Planet Bingo respectfully submits that a consumer looking at its mark would understand the mark to be PLANET BINGO appearing over the bingo ball design, and *not* B1 PLANET BINGO or "OB1 PLANET BINGO" or "OPLANET BINGO B1" or some other variation. The dominant portion of Planet Bingo's mark, and the portion that consumers would notice first, is PLANET BINGO.

In addition, the Examining Attorney's insistence that B1 is the portion that consumers would see as being predominant ignores the fact that B1 is the designation for the first bingo ball in the traditional game of bingo, and that consumers would recognize it as such. Thus, consumers would recognize B1 as being part of the bingo ball design appearing *behind* the mark PLANET BINGO. Moreover, B1 has been placed in a distinctly subordinate position relative to the words PLANET BINGO. Planet Bingo respectfully submits that B1 would not be impressed upon consumers as the dominant portion of Planet Bingo's mark.

While the Examining Attorney cites to cases for the proposition that the first word, prefix, or syllable is what consumers focus on (EA Brief, p. 8), this is not always the case. Indeed, "[w]hile some cases indicate that the first word, prefix or syllable in a mark is always the dominant part, it is impossible to make any generalized statement as to whether the beginning or end of a mark is more important when one or the other is used by another seller." 4 J. THOMAS

MCCARTHY, MCCARTHY ON TRADEMARKS § 23:45 (2008) (footnotes omitted). Here, where B1 is in the foreground, is substantially smaller than PLANET BINGO, is a bingo ball designation, and is part of the design appearing behind the PLANET BINGO name, the conclusion that B1 is dominant, just because it appears "first" and the words PLANET BINGO appear to the right of B1 is particularly unwarranted.

C. PLANET BINGO, the Dominant Portion of Planet Bingo's Mark, Does Not Look or Sound the Same, and Does not Mean the Same Thing or Convey the Same Commercial Impression as Registrant's Mark, B1 GAMES

In comparing Planet Bingo's mark with the cited registration, the Examining Attorney asserts that Planet Bingo has merely added to its mark the generic term BINGO, in place of registrant's generic term GAMES. EA Brief, p. 8. In support of this position, the Examining Attorney relies on cases involving marks containing additional matter, where a likelihood of confusion was found. But there are exceptions to the general rule concerning additions to marks. *See* TMEP § 1207.01(b)(iii). Such exceptions "may arise if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted." *Id.*, citing *Shen Manufacturing Co. v. Ritz Hotel Ltd.,* 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N

CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

Planet Bingo respectfully submits that such exceptions apply here. As Planet Bingo noted in its opening brief, the marks at issue do not convey the same commercial impressions. Although bingo is a type of game, it is a specific and distinct game that consumers recognize. The bingo ball design appearing behind the PLANET BINGO name illustrates that the game of bingo is being conveyed by Planet Bingo's mark. In contrast, B1 GAMES does not convey a commercial impression specifically of the game of bingo. Further, the B1 designation on the first bingo ball in the design portion of Planet Bingo's mark is commonly known and understood by consumers to be the designation for the first bingo ball in the traditional game of bingo. It is also a designation used on corresponding bingo cards. Planet Bingo's B1 designation appearing in the design portion of its mark, in addition to the term BINGO, further informs consumers that bingo is what is being conveyed by Planet Bingo's mark. *See* Request for Reconsideration, dated December 12, 2008.

The Examining Attorney further asserts that disclaimed matter is typically less significant when comparing marks, and that the elements for comparing the two marks are therefore B1 PLANET and B1. EA Brief, p. 8. (Planet Bingo notes that even when comparing these elements in this way, only one letter – B – and one number – 1 – are common to the marks.) However, the different disclaimed words are still part of the respective marks and must be considered. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *see also*, *Computer Identics Corporation v. Identicon Corporation*, 182 USPQ 438 (TTAB 1974) (no likelihood of confusion

between IDENTICON and the marks COMPUTER IDENTICS and COMPUTER IDENTICS CORPORATION, notwithstanding that "computer" and "corporation" are common descriptive words). In comparing the cited registration, B1 GAMES, with Planet Bingo's mark, the presence of other elements in Planet Bingo's mark – PLANET and BINGO – and the absence in Planet Bingo's mark of the element GAMES is significant. Both marks contain unique terms that are absent from the other mark, clearly distinguishing them from one another. Further, given the somewhat descriptive nature of "B1" when used in conjunction with bingo, the presence of other terms in Planet Bingo's mark, including the non-descriptive term PLANET and the term BINGO – even though BINGO may be the subject of a disclaimer – is significant.

As the Examining Attorney has acknowledged, the *word* portion of a mark consisting of a word portion and design portion "is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services." EA Brief, p. 7. Here, the word portion of Planet Bingo's mark is PLANET BINGO. That is the portion of the mark that is likely to be impressed upon a purchaser's memory, and no other. The B1 designation on the first bingo ball appearing in the design portion of Planet Bingo's mark is part of that design portion. Planet Bingo respectfully submits that the likely consumer would *not* remember Planet Bingo as "B1 Planet Bingo," but rather, simply as PLANET BINGO.

III. CONCLUSION

For all of the foregoing reasons, as well as those provided in Applicant's opening brief, Applicant Planet Bingo respectfully requests that the Examining Attorney's final refusal to register B1 PLANET BINGO (and design) be reversed.

If there are any fees incurred by this Appeal Brief, please deduct them from our Deposit Account No. 23-0830.

Respectfully submitted,

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