

This Opinion Is Not a
Precedent of the TTAB

Hearing: January 28, 2021

Mailed: March 1, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Kojima Productions Co., Ltd.
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Serial No. 79210110
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Peter W. Peterson of DeLio Peterson & Curcio LLC,
for Kojima Productions Co., Ltd.

Jami E. Holland, Trademark Examining Attorney, Law Office 122,
Kevin Mittler, Managing Attorney.
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Before Wellington, Goodman, and Johnson, Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

I. Background – Partial Refusal and Abandonment of Goods and Services

Applicant Kojima Productions Co., Ltd. (“Applicant”) filed an application seeking registration on the Principal Register of the “Kojima Productions (Stylized) and Helmet Design” mark (“Applicant’s Mark”), reproduced below, for an extensive list of goods and services in International Classes 9, 14, 16, 21, 25, 28, 35, 38, 41, and 42.¹

¹ Serial No. 79210110 was filed June 22, 2016 as a request for extension of protection of International Registration No. 1350384 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a). Applicant claims a priority date of December 22, 2015. Applicant disclaims the exclusive right to use the word “productions” apart from the mark as shown. For sake of



The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in part, for certain goods and services in Classes 9, 28, 41, and 42² on the ground that Applicant’s Mark, as applied to the goods and services, so resembles the Registered Mark, “Kojima Productions (Stylized) and Fox Design,” reproduced below, for “video game software; video game programs; video game CD-ROMS; video game Digital Versatile Disc-ROMS; computer game programs; computer game CD-ROMS; computer game Digital Versatile Disc-ROMS;

brevity and due to the length of the application’s identification of goods and services initially listed in the application, we do not repeat the entire list, but only discuss the relevant goods and services, as necessary.

Page references to the application record are to the downloadable .pdf version of the United States Patent and Trademark Office’s (“USPTO” or “Office”) Trademark Status & Document Retrieval (TSDR) system. Citations to the briefs, motions, and orders on appeal are to TTABVUE, the Board’s online docketing system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any number(s) following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

² In the first Office Action, dated June 23, 2017, the Examining Attorney initially issued a refusal to register Applicant’s Mark under Section 2(d) based on the cited registration for all goods listed in Classes 9, 28, 41, and 42. During examination the cited registration was renewed, and certain goods in Class 9 as well as all services in Class 41 were deleted from the registration. Applicant then requested that the Examining Attorney reconsider the Section 2(d) refusal to register at least as to Classes 41 and 42. April 15, 2019, Response to Office Action. On August 5, 2019, the Examining Attorney issued a final Office Action indicating that the refusal was now limited to certain goods in Classes 9, 28, 41, and 42.

electronic game programs; electronic game CD-ROMS; electronic game Digital Versatile Disc-ROMS; downloadable electronic game software, downloadable computer game software and downloadable video game software” in International Class 9,³ as to be likely to cause confusion.



When the refusal was made final, Applicant appealed the partial refusal and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. Applicant then requested a remand to the Examining Attorney for submission of additional evidence. The Examining Attorney issued a second denial of reconsideration.

In its Appeal brief, Applicant expressly states that it is “appeal[ing] only the listed goods: ‘computer game software; computer games programmes; computer games cartridge’ and ‘computer game programs for home video game machines’” and that it

³ Registration No. 3531402 issued Nov. 11, 2008 [hereinafter the “Registered Mark” or “Registrant’s Mark”]. Combined declaration under Trademark Act Sections 8 and 15, 15 U.S.C. §§ 1058 and 1065, accepted and acknowledged on Sept. 18, 2014 and maintained on Sept. 28, 2018.

“is not appealing the refusal of the remaining goods [and services] under International Classes 09, 028, 041 and 042.”⁴ Therefore, the other goods and services subject to the partial refusal in the final Office Action in classes 9, 28, 41, and 42 are abandoned and will be deleted from the identification of goods and services.⁵ TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1202.01 (2020); *see also In re MGA Entertainment Inc.*, 84 USPQ2d 1743, 1745 n.1 (TTAB 2007) (applicant did not appeal requirement to delete Class 28 goods, so Board treated Class 28 goods as deleted).

This appeal, which is limited to the refusal to register Applicant’s mark for “computer game software; computer games programmes; computer games cartridge” and “computer game programs for home video game machines” in International Class 9, is fully briefed. We affirm the refusal to register.

II. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), *cited in B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen

⁴ Applicant’s Appeal Brief, 11 TTABVUE 5.

⁵ Again, for the sake of brevity, we do not repeat the extensive list of now-abandoned goods and services (identified in the August 5, 2019 Final Office Action). However, the goods and services identified in the application which have not been refused, and will remain in the application going forward, are listed at the end of this decision.

DuPont factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020) (citation omitted).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. The Similarity or Dissimilarity of the Marks

We turn first to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression. *DuPont*, 177 USPQ 567. “Similarity in any one of these elements may be

sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted). We focus on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

When marks consist of words and a design, we normally give the words greater weight because the words are likely to make more of an impression upon purchasers and purchasers will remember the words and use them to request the products. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc.*

v. Morrow, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir 1983)); *Herbko Int'l*, 64 USPQ2d at 1380 (“Because the impact of the design in the overall commercial impression is minor when compared with the words, a consumer viewing Herbko’s mark would attach greater significance to the words CROSSWORD COMPANION than to the crossword puzzle design.”). “[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences.” *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985).

Overall, “our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on a comparison of the entire marks, not just part of the marks.” *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, *4 (TTAB 2020) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014)). In making such a determination, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this appeal, the marks share the identical literal element KOJIMA PRODUCTIONS. Both Applicant and Registrant have disclaimed the exclusive right to use the term PRODUCTIONS. Typically, disclaimed matter is less significant or less dominant when comparing marks. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000). Although it is likely that consumers will

not view the term PRODUCTIONS as a source-distinguishing term, the filing of a disclaimer “does not remove the disclaimed matter from the purview of determination of likelihood of confusion.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

KOJIMA is the surname of Mr. Hideo Kojima, a preeminent video game producer and developer.⁶ There is no evidence of record as to the correct pronunciation of the Kojima surname or this element in KOJIMA PRODUCTIONS, but in any case, “there is no correct pronunciation of a trademark.” *In re Viterra*, 101 USPQ2d at 1912. And, similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *See, e.g., id.* at 1911 (XCEED and X-SEED and design, both for agricultural seed, found confusingly similar). So we find that the literal element KOJIMA PRODUCTIONS, as it appears in Applicant’s Mark and the Registered Mark, sound the same.

As to appearance, in Applicant’s Mark, the terms KOJIMA and PRODUCTIONS are positioned below the helmet design in big, bold black stylized letters that draw the viewer’s attention, with KOJIMA in larger letters positioned above PRODUCTIONS. The design element of Applicant’s Mark consists of a helmet, with complete and incomplete circles and multiple lines throughout, and a human skull embedded in the helmet, facing left. In the Registered Mark, KOJIMA appears in big, bold white stylized letters below what appears to be a jumping fox, and above the term

⁶ Applicant’s Appeal Brief, 11 TTABVUE 10; Apr. 15, 2019 Response to Office Action at pp. 22-33, 43-50.

PRODUCTIONS, which appears in smaller white letters. The design element of the Registered Mark is composed of an oval with a black background, a gray border inside of the oval, with the image of a jumping fox inside of the gray border. Because of the different design elements, Applicant contends that we should accord greater weight to the design component of its mark, citing our decisions in *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) and *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282 (TTAB 2009).⁷ But in those cases, the design elements played a more prominent role in creating a commercial impression with, at least in part, different literal elements.

The registrability of applicant's design mark, REDNECK RACEGIRL, shown below, for various items of clothing was at issue in *In re Covalinski*. The examining



attorney cited RACEGIRL (in standard characters) (registered for in part legally identical goods) against applicant's mark, arguing that the words "redneck racegirl" in applicant's mark were dominant and had the greatest impact on prospective customers. 113 USPQ2d at 1168. Despite the similar goods and trade channels, as well as the shared term "racegirl," we reversed the refusal to register because the RR "graphic devices serve not only to draw attention to the RR letters apart from the wording, but also make the letters that form the 'a-c-e' of the word 'RACEGIRL'

⁷ Applicant's Appeal Brief, 11 TTABVUE 22; Applicant's Reply Brief, 14 TTABVUE 6-7.

difficult to notice,” especially on retail hang tags or neck labels. *Id.* “In that context, the visual impression of the mark is likely to be more important.” *Id.*

Similarly, in *In re White Rock Distilleries*, we found no likelihood of confusion between the applicant’s VOLTA mark (in standard characters) for caffeine-infused vodka and the cited mark, TERZA VOLTA & Design, shown below, for wines, because the marks engendered different commercial impressions and the goods were not related, even though they traveled in the same channels of trade to the same class of



purchasers.

Specifically, as to appearance, we found that the larger and dominant term “terza,” coupled with a prominent design element, served to distinguish the cited mark from the applicant’s standard character mark, VOLTA, and that “it would not be reasonable to assume that applicant’s VOLTA mark would be presented with the design element appearing in registrant’s mark.” 92 USPQ2d at 1284.

Our holdings in *In re Covalinski* and *In re White Rock Distilleries* demonstrate that there is no mechanical test to select the dominant element of a mark. *Tao*

Licensing, LLC v. Bender Consulting Ltd., 125 USPQ2d 1043, 1059 (TTAB 2017).

Here, KOJIMA PRODUCTIONS is the central and most visually prominent element in both of the marks, and it is thus most likely to catch consumers' attention. KOJIMA PRODUCTIONS also has more source-identifying capability than the design elements in both of the marks, which would be viewed merely as decorative and would not be verbalized by consumers when calling for the goods. *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1736 (TTAB 2018) ("It further is settled that in a mark consisting of wording and a design, the design tends to make a less significant contribution to the mark's overall commercial impression.").

Furthermore, the significance of the term KOJIMA is enhanced by its prominence: As shown in the drawing below, KOJIMA, in slightly larger font, appears above PRODUCTIONS. KOJIMA immediately catches the eye.



In Registrant's Mark, KOJIMA appears in much larger font than PRODUCTIONS, as shown on the drawing below:



We find that KOJIMA PRODUCTIONS is the dominant element in both Applicant's and Registrant's marks, and accord that term more weight than the design elements of both marks. In making this finding, we do not ignore the stylization of the words or the design elements in the marks. However, for the reasons previously discussed, consumers are more likely to remember the element KOJIMA PRODUCTIONS than the design elements of the marks. *Nat'l. Data*, 224 USPQ at 751.

Overall, while there are obvious differences in the design elements of Applicant's and Registrant's marks, we find that in their entireties the marks are very similar in appearance, sound, and connotation due to the common presence of the dominant element KOJIMA PRODUCTIONS. Furthermore, the marks convey the same commercial impression, sharing the term KOJIMA, the surname of a renowned video developer and producer, and the term PRODUCTIONS, which is suggestive of the

creator behind the content for the computer, electronic, and video game software being offered for sale. The first *DuPont* factor thus favors a finding of likelihood of confusion.

B. Relatedness of the Goods

Next we turn to the second *DuPont* factor, the relatedness of the goods. When analyzing the *DuPont* factors on the relatedness of the goods, we look to the identifications in the application and cited registration. *Stone Lion* 110 USPQ2d at 1162; see *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (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, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”).

The identifications of goods are identical in part. Specifically, “computer game programs”⁸ are offered under both marks. Registrant’s “computer game programs” also encompasses Applicant’s “computer game programs for home video game machines.” And Applicant’s “computer game software” encompasses Registrant’s “downloadable computer game software.” A single good from among a list can sustain

⁸ Applicant spells programs as “programmes.” We take judicial notice of this British English spelling. LEXICO OXFORD ENGLISH DICTIONARY (2020) (<https://www.lexico.com/definition/programme>) (last accessed Feb. 25, 2021). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

a finding of likelihood of confusion, however. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

In addition to their in part identity, the Examining Attorney proffers evidence showing that the same entity commonly provides the relevant goods, and markets those goods under the same mark in the same field of use.⁹ Accordingly, the second *DuPont* factor strongly favors a finding of likelihood of confusion.

C. Similarity of Trade Channels and Classes of Purchasers

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. As previously stated, for the goods that are legally identical in part, we rely on a presumption that the channels of trade and classes of purchasers are the same. *See In re Viterra*, 101 USPQ2d at 1908; *see also Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”); *Octocom Sys.*, 16 USPQ2d at 1787 (“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

⁹ Examiner’s Statement, 13 TTABVUE 6; Aug. 5, 2019 Final Office Action at pp.14-67.

goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”).

The identifications for the remainder of the goods offered under the marks have no restrictions as to channels of trade and classes of purchasers. Therefore, we must presume that those goods travel through all normal and usual channels of trade for such goods, and that the class of purchasers for such goods is the same, i.e., members of the general public who purchase computer video game cartridges, software, and programs. *See Stone Lion*, 110 USPQ2d at 1161. Thus, the third *DuPont* factor also weighs in favor of finding a likelihood of confusion.

D. Sophistication of Consumers

The fourth *DuPont* factor concerns the “conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Applicant contends that the relevant consumers of its goods are less likely to be confused as to source or affiliation because they are “reasonably prudent purchasers”: “Mature”¹⁰ video game consumers who are well aware of Mr. Kojima’s employment history with Konami Digital Entertainment (“Konami”); his work at Konami; the acrimonious split from Konami; the formation of Kojima

¹⁰ Applicant states that the word “mature” is a reference to the Entertainment Software Rating Board rating of “M,” meaning that the video game is for “mature audiences only” (i.e., persons 17 years of age or older), and that the packaging for “Death Stranding” as well as Konami videos offered under the cited registration feature the “M” rating. Applicant’s Appeal Brief, 11 TTABVUE at 11. We note that there is no such limitation for mature audiences in the identification of goods for Applicant’s Mark.

Productions Co., Ltd.; and the creation of the blockbuster release “Death Stranding” shortly thereafter.¹¹

Specifically, Applicant asserts that the “least sophisticated potential purchaser” standard articulated in *In re FCA US LLC*, 126 USPQ2d 1214 (TTAB 2018), and *Stone Lion*, 110 USPQ2d 1157, is inapplicable because unlike the mix of sophisticated and general purchasers in those cases, here “[t]here is no evidence of record that consumers of Konami’s and Applicant’s video games are casual purchasers that have ‘little understanding’ of the product ... or are looking for products or services with ‘no minimum investment.’”¹² However, Applicant’s “sophisticated purchaser” argument is unconvincing, given the unrestricted identifications of goods involved in this appeal. Consequently, we find that the purchasers of video games are members of the general public who necessarily encompass both “gamers”¹³ as well as those who have limited knowledge of video games. Our decision must be based on the “least sophisticated purchasers,” *Stone Lion*, 110 USPQ2d at 1163, and we consider them.

Even if some of the consumers of Applicant’s or Registrant’s goods are sophisticated purchasers, or “gamers,” we note that they may not be sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re*

¹¹ Applicant’s Appeal Brief, 11 TTABVUE 10-13. For the uninitiated, “Death Stranding” is the first video game release of Kojima Productions Co., Ltd. and Sony Interactive Entertainment. “Death Stranding” has won over 60 “Game of the Year” awards, and has received critical acclaim from the gaming and mainstream press. *See id.* at pp. 5-9, 11.

¹² Applicant’s Appeal Brief, 11 TTABVUE 15.

¹³ We take judicial notice of the definition of “gamer” as “a person who plays games, especially: a person who regularly plays computer or video games” from the MERRIAM-WEBSTER DICTIONARY (2020) (<https://www.merriam-webster.com/dictionary/gamer>) (last accessed Feb. 22, 2021).

Shell Oil Co., 26 USPQ2d at 1690 (indicating that “even sophisticated purchasers can be confused by very similar marks”); *Top Tobacco, LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). And in the present circumstance where the marks have the same literal elements and the goods are identical in part, confusion is often found likely despite customer sophistication and care. “That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. ‘Human memories even of discriminating purchasers ... are not infallible.’” *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)); *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962) (“Being skilled in their own art does not necessarily preclude their mistaking one trademark for another when the marks are as similar as those here in issue, and cover merchandise in the same general field.”); *In re Wilson*, 57 USPQ2d 1863, 1865-66 (TTAB 2001) (where marks are very similar and goods related, confusion may be likely even among sophisticated purchasers).

Thus, this *DuPont* factor weighs in favor of finding a likelihood of confusion.

E. Strength of the Cited KOJIMA PRODUCTIONS Mark

Applicant spends considerable time in its briefs arguing that KOJIMA, as it appears in the Registered Mark, is weak because the target demographic of

Applicant's products is sophisticated and can distinguish between KOJIMA, as it appears in Applicant's Mark, and KOJIMA as it appears in the Registered Mark.¹⁴

The sixth *DuPont* factor, the number and nature of similar marks in use for similar goods or services, may be considered to determine any weakness of the cited mark and the scope of protection to which it is entitled. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017).

Here, Applicant has not submitted any evidence regarding third parties using marks similar to the Registered Mark for similar goods, and at oral argument, counsel for Applicant conceded that the Registered Mark "is not weak in the classic sense." We have no evidence of any commercial weakness of the Registered Mark, so the sixth *DuPont* factor is neutral. Rather, the crux of Applicant's argument is that the cited mark is weak because reasonably prudent consumers of video games "are keenly aware that there are two (2) different 'Kojima Productions' – the old one owned by Konami responsible for the development of the 'Metal Gear Solid' series, and the new one independently re-formed and owned by Mr. Kojima himself, responsible for the new 'Death Stranding' series," particularly since the "Kojima" in both marks is the surname of the renowned Hideo Kojima.¹⁵ In essence, Applicant attempts to merge the identity of Mr. Kojima into the marks: Mr. Kojima and his work are inseparable,

¹⁴ 11 TTABVUE 13-20; 14 TTABVUE 8.

¹⁵ Applicant's Appeal Brief, 11 TTABVUE 17-20. Mr. Kojima is not identified as an individual in the records for the Registered Mark, but the phrase "A Hideo Kojima Game" is clearly printed on a specimen of record for the Registered Mark. See Feb. 4, 2020 Request for Reconsideration, at p. 102; see also *id.* at p. 99 (another specimen of record using Hideo Kojima's name on product packaging).

and because he is so well-known, sophisticated consumers can readily distinguish between Applicant's Mark and the Registered Mark.

While we are cognizant of Mr. Kojima's desire, in furtherance of his vision and his art, to use his surname in the applied- for mark, the only issue before us in this forum is whether Applicant's Mark should proceed to registration. We have already found that the element KOJIMA PRODUCTIONS is dominant in both marks; the marks sound and appear alike, and they create similar commercial impressions; the goods offered under the marks are in part identical, related, and they travel in the same channels of trade; and that the purchasers of the goods offered under Applicant's Mark are the general public. Therefore, we are not persuaded that the fame of Mr. Kojima weighs against a finding of likelihood of confusion. In fact, on this record, we find that any fame attributed to the term KOJIMA may increase the likelihood of confusion between Applicant's Mark and the Registered Mark, especially since the goods at issue are offered to the general public.

F. Market Interface

The tenth *DuPont* factor requires us to consider evidence pertaining to the "market interface" between the applicant and registrant, including evidence of any past dealings between them which might be indicative of a lack of confusion in the present case. Generally, in an ex parte appeal context, this factor becomes relevant when there is an agreement between the applicant and registrant that evinces their business-driven conclusion and belief that there is no likelihood of confusion, and weighs heavily in favor of a finding that confusion is not likely. *In re Opus One Inc.*, 60 USPQ2d 1812, 1820 (TTAB 2001); *see also Bongrain Int'l (Am.) Corp. v. Delice de*

France, Inc., 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987) (“[I]n trademark cases involving agreements reflecting parties’ views on the likelihood of confusion in the marketplace ... such agreements may, depending on the circumstances, carry great weight”).

There is no consent agreement between Applicant and Registrant which may be indicative of their belief that there is no likelihood of confusion and what efforts they would undertake should any instances of actual confusion occur. Instead, Applicant proffers the declaration of Mr. Shinji Hirano,¹⁶ Applicant’s current President (and a former President of Konami), in support of its argument that Konami’s non-objection to, or silence about, the release of “Death Stranding” under Applicant’s Mark is tantamount to an agreement to peacefully coexist in the marketplace, which in turn overcomes any presumption of a likelihood of confusion. Clearly, this is not the equivalent of a consent agreement and we have no indication that Registrant is in agreement with Mr. Hirano’s assertions. In sum, the lack of any evidence of a written agreement between Applicant and Registrant compels us to find the market interface factor to be neutral.

G. Length of Time During and Conditions Under Which There Has Been Concurrent Use Without Evidence of Actual Confusion

The eighth *DuPont* factor contemplates the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ2d at 567. Applicant points to the absence of actual confusion for

¹⁶ Declaration of Shinji Hirano, Feb. 4, 2020 Request for Reconsideration After Final Action, Appendix 1, p. 146 ¶ 21.

at least five years during the concurrent use of Applicant's and Registrant's Marks — a time during which Mr. Kojima received significant news coverage about his departure from Konami, and during which "Death Stranding" was heavily promoted — as weighing in Applicant's favor.¹⁷

While examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. *In re Opus One*, 60 USPQ2d at 1817 ("The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred."). On this record, we accord the lack of any instances of actual confusion little probative weight. Thus, the eighth *DuPont* factor is also neutral.

III. Conclusion

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors for which there is argument and evidence, and we find that confusion is likely. The marks are very similar in appearance, sound, and connotation due to the common presence of the identical literal element KOJIMA PRODUCTIONS; the marks convey the same commercial impression; the goods are identical in part and

¹⁷ Applicant's Appeal Brief, 11 TTABVUE 26.

these identical goods are presumed to be found in the same channels of trade offered to the same class of purchasers, namely anyone in the general public interested in gaming software.

Decision: The partial refusal to register Applicant's mark for "computer game software; computer games programmes; computer games cartridge" and "computer game programs for home video game machines" under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in International Class 9 is affirmed.

The application will proceed to publication for the goods and services identified in Classes 14, 16, 21, 25, 35, and 38, as well as the following goods and services in classes 9, 28, 41, and 42:

Class 9: Application software, namely, software for use in database management and use in electronic storage of data; computer software, namely, software for use in database management and use in electronic storage of data; computer programmes, namely, programs for use in database management and use in electronic storage of data, downloadable software, namely, software for use in database management and use in electronic storage of data; telecommunication machines and apparatus, namely, telephones and mobile phones; slide film mounts; ozonators, namely, ozonisers; electrolytic cells, namely, electrolyzers; egg-candlers; blueprinting machines; cash registers; coin counting or sorting machines; electric sign boards for displaying target figures and current outputs, namely, electrical signs; photo-copying machines; mathematical instruments, namely, calculators; time and date stamping machines; time recording devices, namely, time clocks; punched card office machines; voting machines; mechanisms for coin-operated car parking gates, namely, electronic automatic ticket examination machines; lifesaving apparatus and equipment, namely, lifejackets and shoes for protection against accidents and fire; fire extinguishers; fire hoses; fire hose nozzles; sprinkler systems for fire protection; fire alarms; gas leak alarms; anti-theft warning apparatus, namely, theft alarms; safety helmets; railway signals; vehicle breakdown warning triangles; luminous or mechanical road signs; cinematographic machines and apparatus, namely, lenses for industrial laser cutting machines; optical machines and apparatus, namely, Binoculars and cameras; measuring or testing machines and instruments, namely, coordinate measuring machines; magnetic cores; resistance wires; fuel cell electrodes; fire boats; satellites for scientific purposes; fire trucks; dust masks; gas masks; welding masks; fireproof garments; fireproof garments, namely, disaster prevention

hoods; metronomes; electronic circuits and CD-ROMs recorded with automatic performance programs for electronic musical instruments featuring music; electrical effects units for electric or electronic musical instruments.

Class 28: Billiard equipment; go games; Japanese chess (shogi games); Japanese playing cards (utagaruta); dice games; Japanese dice games (sugoroku); cups for dice; Chinese checkers as games; chess games; checkers games; conjuring apparatus, namely, board game for conjuring spirits; dominoes; playing cards; Japanese playing cards (hanafuda); mah jong games; toys for domestic pets; insect collectors' articles, namely, butterfly nets; wax for skis.

Class 41: Reference libraries of literature and documentary records; book rental; art exhibition services; publication of books; arranging and planning of movies, shows, plays and musical performances, and providing information thereof; movie theatre services; movie film production and distribution; live entertainment, namely, live music concerts; direction or presentation of plays; presentation of musical performances; production of radio or television programs; production of videotape film in the field of education, culture, entertainment and sports, not for movies or television programs, and not for advertising or publicity; direction of radio and television programs; operation of video and audio equipment for production of radio and television programmes; organization, arranging and conducting of boat racing events; organization, arranging and conducting of motorcycle racing events; providing audio and video recording studio services; providing sports facilities; providing amusement facilities; providing facilities for movies, shows, plays, music or educational training; booking of seats for shows; rental of cinematographic apparatus; rental of cine-films; rental of musical instruments; rental of television sets; rental of radio sets; rental of records or sound-recorded magnetic tapes; rental of image-recorded magnetic tapes; rental of films; rental of toys; rental of amusement machines and apparatus; rental of game machines and apparatus; rental of paintings and calligraphic works; photography; interpreter services; translation; rental of cameras; rental of photographic equipment; operating lotteries; providing information on donation of human corpses for medical education; arranging of donation of human corpses for medical education; animal training; plant exhibitions; animal exhibitions; gardens for public admission; caves for public admission.

Class 42: Technical support, namely, providing backup computer programs on data networks; hosting of digital content on the Internet, namely, rental of memory space for internet servers; computer system design and analysis; research and development services relating to computer software; providing technical information in the field of computer technology, computer software and computer networks; technological advice provided to Internet used by means of a support hotline in the field of computers, automobiles and industrial machines; design services, namely, graphic design services and computer system design services; providing weather information; architectural services; surveying; geological research; industrial design, namely,

designing of industrial machines, industrial machine apparatus, industrial machine instruments including the parts or systems of such machines, apparatus and instruments; testing, inspection or research of pharmaceuticals, cosmetics or foodstuffs; research on building construction or city planning; testing or research on prevention of pollution; testing or research on electricity; testing or research on civil engineering; testing, inspection or research on agriculture, livestock breeding or fisheries; testing or research on machines, apparatus and instruments, namely, testing the functionality of machines and research on machines; rental of computers; rental of laboratory apparatus and instruments; rental of laboratory apparatus and instruments, rental of technical drawing instruments for use in laboratories.