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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85872412
Applicant	Universal Entertainment Corporation
Applied for Mark	PROSPEROUS YEAR
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In The Matter Of Application No. 85/872,412, **Filed: March 11, 2013** **Universal Entertainment Corporation,** **Applicant and Appellant** **For the mark:** **PROSPEROUS YEAR**	**Law Office 113** **Examining Attorney:** **Timothy Schimpf**

REPLY BRIEF

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In The Matter Of Application No. 85/872,412	
Universal Entertainment Corporation, **Applicant and Appellant**	**Law Office 113** **Examining Attorney:** **Timothy Schimpf**
For the mark: **PROSPEROUS YEAR**	

APPELLANT'S REPLY BRIEF

Universal Entertainment Corporation (hereafter "Universal") replies to the Examining Attorney's Appeal Brief filed on June 5, 2014.

ISSUE PRESENTED

Whether Universal's mark PROSPEROUS YEAR is confusing similar to the registered mark PROSPEROUS LIFE.

1. THE MARKS ARE NOT CONFUSINGLY SIMILAR

A. Legal Basis

The key factor in this case is the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). In comparing the marks, the test 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 impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741(TTAB 1991), aff'd unpublished, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

B. Overemphasis On Single Word Identity

The Examining Attorney admitted that the marks do not look or sound the same, but argued that the two marks create a similar commercial impression. The analysis however was flawed.

While both marks share the common word PROSPEROUS, the Board must look at the marks as a whole, not dissected into separate parts. But even so, looking at the single identical word PROSPEROUS, when used in association with gaming, the word is more akin to a laudatory or suggestive term, as the ordinary person hopes to prosper when gaming. The use of PROSPEROUS is quite similar to the situation in *Colgate Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529, 530 (CCPA 1970), where the common element in the marks was a common noun or adjective of everyday use (PEAK) and had a laudatory or suggestive indication. Even though the entire mark was subsumed in the challenged mark, PEAK PERIOD for personal deodorants was deemed not confusingly similar to PEAK for dentifrice.

C. LIFE And YEAR Do Not Suggest An Annuity

The Examining Attorney speculated that the isolated words YEAR and LIFE would create the impression of gaming machines associated with alleged "annuity games", citing an inquiry concerning huge jackpot wins: "When a slot player hits a big one, for instance 10 million dollar jackpot, is it paid in installments or in its entirety?"

The response, by self proclaimed "Gaming Guru", Mark Pilarski, was that many slot machines "like Megabucks, Wheel of Fortune, Jeopardy, The Price is Right, etc., are 'annuity games' where you do NOT receive your total winnings up front but are paid instead in annual installments. The clear-cut way to find out which-is-which is simply to read what's printed on the face of the machine. There it will tell you straight away if it's

an annuity game or an immediate full-pay win.") See evidence attached to final Office action dated 8/15/2013 at 2)

Concerning how a lucky winner may collect her millions, as suggested, requires reading the fine print. Note that none of the games cited by Mr. Pilarski have names that suggest these are "annuity" gaming machines: "Megabucks, Wheel of Fortune, Jeopardy, The Price is Right, etc", nor is there any indication that users may actually seek out such alleged "annuity game" machines. Yet, the Examining Attorney speculates that the additional words "YEAR and LIFE in the marks simply means that the gaming machines are annuity games…" and "…give a similar commercial impression of annuity games.", even though his own cited article states that a winner has "90 days to decide if you want to be paid a lump sum or an annual annuity on the balance." See evidence attached to final Office action dated 8/15/2013 at 5-6. Nowhere is there discussed payments over a YEAR or over a players entire LIFE; it is immediate or over a defined number of years.

This alleged similar commercial impression is pure speculation. The listing of goods of Universal and the Registrant do not specify annuity gaming machines. Nothing in the evidence cited by the Examining Attorney suggests that certain gaming machines are indeed specifically designated as, marketed as, or sold as, "annuity" gaming machines. It is certainly strained to expect the "recollection of the average customer, who retains a general rather than specific impression of the marks" to be that both marks suggest "annuity games". *Winnebago Industries, Inc., supra.*

D. Dissection Distorts The Analysis

Dissection does not enlighten as to the true commercial impression, but rather distorts what is fairly clear. Both marks use common phrases. These common phrases inherently have ordinary meanings which are conveyed and give general impressions. PROSPEROUS YEAR means what it says, that is, a year of prosperity, a phrase in common usage, as noted in the dictionary: "The company had a prosperous year".[1]

The word "YEAR" is an impersonal well defined period of time, PROSPEROUS YEAR connoting a single year of prosperity.

PROSPEROUS LIFE is more personal, suggesting a lifetime of personal prosperity, which evokes an impression similar to a greeting card: "Wishing you a long and prosperous life", or another well known salutation, "Live long and prosper" (see http://en.wikipedia.org/wiki/Vulcan_salute).

Certainly, a consumer would readily note the differences between these two distinct and commonly understood phrases. See *Procter & Gamble Co. v. Johnson & Johnson*, 485 F.Supp. 1185, 205 USPQ 697, 708 (SDNY 1979) aff'd without opinion, 636 F.2d 1203 (2d Cir. 1980) ("When arbitrary or fanciful marks are involved, the

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[1] Appellant's Exhibit 1. The Examining Attorney decried the lack of third party evidence, but as to meaning or commercial impression, what better evidence could there be than the exact phrase, PROSPEROUS YEAR, appearing in a dictionary definition? This phrase is so common and well understood that it is used by an objective source, a dictionary. If the phrase were not so well understood, the exemplary use would be lost on those trying to understand the meaning of the word "prosperous".

distinctiveness of the marks will make the public more conscious of similarities than differences. … In contrast when common words are involved … the degree of difference rather than the degree of similarity is likely to be more noticeable.”) (Emphasis Added).

The likelihood of confusion inquiry must consider "the operative facts of the real world" and "the performance of the marks in the commercial context," and avoid a myopic view of the "appearance of the litigated marks side by side in the courtroom [as that] does not accurately portray actual market conditions". *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1106, 18 USPQ2d 1587, 1592 (6th Cir.1991) (internal quotation marks and citation omitted).

The Examining Attorney’s speculative determination of commercial impression does not “portray actual market conditions”, as it ignores the general impressions made by the marks as a whole which are formed from common words and phrases. When such common words and phrases are used, the ordinary meanings would create the first impressions, and the differences would be immediately noticed by consumers.

E. Overemphasis on Users

The Examining Attorney focused heavily on users of the gaming machines as being equivalent to the actual purchasers of these machines:

“Applicant argues that the applied-for goods and the registered goods are used only by knowledgeable consumers. Neither the application nor the registration limits the goods to certain sophisticated users…”

An over emphasis on users, to the exclusion of actual consumers, does not conform to the Lanham act. The Lanham Act seeks to prevent consumer confusion that enables a seller to pass "off his goods as the goods of another." *Programmed Tax Systems, Inc. v. Raytheon Co.*, 439 F.Supp. 1128, 1132, 197 USPQ 509 (S.D.N.Y. 1977) (quoting *Jean Patou, Inc, v. Jacqueline Cochran, Inc.*, 201 F.Supp. 861, 863, 133 USPQ 242 (S.D.N.Y. 1962), aff'd, 312 F.2d 125, 136 USPQ 236 (2d Cir. 1963). In *Programmed Tax Systems*, the court explained that the relevant confusion is that which affects "the purchasing and selling of the goods or services in question." Id.

The proper inquiry is directed to "a likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question". *New Sensor Corp. v. CE Distribution LLC*, 303 F.Supp.2d 304, 310-11, 71 USPQ2d 1828, 1832 (E.D.N.Y.2004)

Universal made of record evidence as to the nature of the goods whose sale and operation are highly regulated. The goods are also very expensive. Yet, the Examining Attorney ignored whether the actual purchasers would be confused, relying on dicta from a non-precedential decision.

There is clearly articulated reasoning in *In re Aristocrat Technologies Australia PTY Limited*[2] for refusing registration of the mark RED BARON for gaming machines. The marks were identical: RED BARON. There was no difference in commercial

[2] 2005 TTAB LEXIS 472 (2005)

impression. The goods were different, though related, gaming machines for the applicant, computer games for the registrant. The Board determined who the actual consumers would be of Registrant's products, and decided that there was a likelihood that those consumers would be confused, if confronted with the identical RED BARON mark appearing on the applicant's gaming machine.

Here, a similar overlap with the general public as consumers does not exist. The goods are essentially identical, gaming machines[3], and the Registrant and the applicant sell to the same consumers. Neither party sells gaming machines to the public at large. This was established by the applicant in *In re Aristocrat*, the Registrant in this proceeding, with supporting evidence. As the Board must give due consideration to "actual market conditions", it is those consumers who should be considered in determining a likelihood of confusion.

F. The Sophistication Of The Buyers

The Examining Attorney challenged whether the buyers were "sophisticated users". However, under this Du Pont factor, the Board must evaluate "[t]he general impression of the ordinary purchaser, buying under the normally prevalent conditions of the market and giving the attention such purchasers usually give in buying that class of goods." *W.W.W. Pharm. Co. v. The Gillette Co.*, 984 F.2d 567, 575, 25 USPQ2d 1593,

[3] The Examining Attorney's arguments on product relatedness were unnecessary as it was admitted that Universal and Aristocrat both sell gaming machines (Main Brief P. 13).

1600 (2d Cir.1993) (quoting *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1137, 202 USPQ 81 (2d Cir.1979)). "[T]he more sophisticated and careful the average consumer of a product is, the less likely it is that similarities in .. trade marks will result in confusion concerning the source or sponsorship of the product." *Bristol-Myers Squibb Co. v. McNeil-P.P.C. Inc.*, 973 F.2d 1033, 1046-47, 24 USPQ2d 1161, 1170 (2d Cir. 1992).

Although gaming machines are made available to the adult general public, only properly licensed buyers may purchase gaming machines. These professionals "know the market and are less likely than untrained consumers to be misled or confused by the similarity of different marks." *Virgin Enterprises Ltd. v. Nawab*, 335 F.3d 141, 151 67 USPQ2d 1420 (2d Cir.2003) (quoting the district court: "retail customers ... are not expected to exercise the same degree of care as professional buyers, who are expected to have greater powers of discrimination).

In addition, these professional buyers operate in the entertainment industry, purchasing gaming machines which prominently display their various trademarks, and there is no basis to allege that these buyers are unsophisticated in the field of trademarks. Rather, the contrary is true. These buyers, by necessity, must be knowledgeable about trademarks in order to make purchasing decisions. This can be confirmed from the Examining Attorneys evidence, showing that gaming machines carry marks such as “Wheel of Fortune, Jeopardy, The Price is Right, etc”. Clearly, buyers of

such gaming machines have to understand trademark rights, and such buyers would not be confused as to source by the marks in issue here.

G. Whether Users Or Consumers, The Result Is The Same

Even if the confusion analysis were to extend to users of gaming machines, the result would be the same; no likelihood of confusion. As distinguished from *In re Aristocrat*, there are significant differences between the two marks in look, sound and commercial impression, differences not present in that case. As explained above, the impressions made by these marks are colored by their commonality, and so the differences between PROSPEROUS YEAR and PROSPEROUS LIFE would be readily noticed by even the ordinary users of such machines. The commercial impression cannot be divorced entirely from the commonality in understanding of the two phrases "prosperous year" and "prosperous life". Whether users are included or not, there would still be no likelihood of confusion.

As stated in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295 (CCPA 1958):

"The fact of the matter is that 'Rite' and 'Sure' do not look alike or sound alike, factors which we feel, at least in this case, militate against appellant's position. *Hillyard Chemical Co. v. Vestal Laboratories, Inc.*, 206 F.2d 926, 927, 41 C.C.P.A., Patents, 701, is peculiarly applicable to the instant case. In that case this court quoted with approval the following language of the examiner:

"Aside from the question of laches, however, it is the opinion of the Examiner that the cancellation should be dismissed because of lack of confusing similarity between the notations `Shine-All\' and `Briten-All.\' The notation `Shine-All\' manifestly is highly suggestive of the nature of the goods here involved, and while the notation `Briten-All\' is similarly suggestive thereof, it differs substantially from `Shine-All\' in both appearance and sound. The applicant having adopted a notation of such character as a trade-mark for its goods may not prevent others from using similarly suggestive but otherwise distinguishable notations as trade-marks for their goods." (Emphasis added.)

Similar to SHINE-ALL and BRITEN-ALL, or SURE-FIT and RITE-FIT or PEAK and PEAK PERIOD, the applicant here should be permitted to use the suggestive or laudatory word PROSPEROUS with gaming machines so as to present the same suggestion of prosperity, but in a way which distinguishes the goods of Universal from the goods of Registrant.

It is believed that LIFE and YEAR do indeed distinguish the two trademarks, being in fact further away from each other than SHINE and BRITEN, or SURE and RITE.

Use of additional matter has been found sufficient to distinguish marks under circumstances where the common element is descriptive or highly suggestive and/or has been frequently used and/or registered by others in the same or related fields. *See, e.g.*, *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011) (ZU ELEMENTS, stylized, not confusingly similar to ELEMENTS for identical apparel); *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (NORTON MCNAUGHTON ESSENTIALS for ladies' sportswear not confusingly similar to ESSENTIALS for women's clothing because ESSENTIALS is a highly

suggestive term for articles of clothing); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975) (HIG-DURABLE for stationery articles not likely to cause confusion with DURABL, on the Supplemental Register, for record books); *In re Merchandising Motivation, Inc.*, 184 USPQ 364 (TTAB 1974) (MEN'S WEAR for a semi-monthly magazine not confusingly similar to MMI MENSWEAR for fashion consulting for men because "MENSWEAR" is merely descriptive of such services).

H. There Is No Likelihood Of Confusion

Whether considering the actual sophisticated buyers or the average user or a mix of both, when considered in their entireties, in terms of appearance, sound, connotation, and commercial impression, the marks are dissimilar, and there is no likelihood of confusion between the marks. Consequently, Universal respectfully repeats its' request that the refusal to register the mark PROSPEROUS YEAR be reversed.

Respectfully submitted,

________/WJS/__________
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