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Subject: U.S. TRADEMARK APPLICATION NO. 85872412 - PROSPEROUS YEAR - 610/9-3222 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 2

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Attachment Information:

Count: 8

Files: TTAB01.jpg, TTAB02.jpg, TTAB03.jpg, TTAB04.jpg, TTAB05.jpg, TTAB06.jpg, TTAB07.jpg, 85872412.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 85872412

**MARK:** PROSPEROUS YEAR



**CORRESPONDENT ADDRESS:**

WILLIAM J. SAPONE

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**APPLICANT:** Universal Entertainment Corporation

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

610/9-3222

**CORRESPONDENT E-MAIL ADDRESS:**

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 3/4/2014

This Office action is in response to applicant's communication filed on February 12, 2014.

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The Section 2(d) refusal made final in the Office action dated August 15, 2013 is maintained and continues to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

As applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

#### SUMMARY OF ISSUES:

- Section 2(d) Refusal – Likelihood of Confusion

#### SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The Trademark Section 2(d) refusal because of a likelihood of confusion with the mark in U.S. Registration No. 3717589 continues to be **FINAL**. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the registration enclosed with first Office action.

The applicant has applied to register PROSPEROUS YEAR for "Slot machines and replacement parts therefor; video slot machines and replacement parts therefor; gaming machines and replacement parts therefor; gaming machines with liquid crystal displays and replacement parts therefor; mechanical reel type slot machines with liquid crystal displays and replacement parts therefor" in International Class 28.

The registered mark is PROSPEROUS LIFE for "Gaming machines" in International Class 9.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Vittera Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

### Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

In the present case, the applied-for mark PROSPEROUS YEAR is similar to the registered mark PROSPEROUS LIFE because both marks begin with the word PROSPEROUS. As both marks begin with the word PROSPEROUS, that term will make the first impression on consumers. Consumers are generally more inclined to focus on the first word in any trademark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing

decisions). When looking for gaming machines, consumers will believe both of these marks emanate from the same source because both use the word PROSPEROUS at the beginning of the marks.

The applied-for mark also includes the word YEAR and the registered mark includes the word LIFE, but the word PROSPEROUS is the dominant portion of each mark because it provides the first impression on consumers. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751. Consumers will see the word PROSPEROUS in the marks for gaming machines and believe they both emanate from the same source due to the similar use of the word PROSPEROUS.

Additionally, the marks are similar because consumers will believe that the terms LIFE and YEAR are different variations of the same PROSPEROUS gaming machines. Slot machines commonly pay jackpots either immediately or in annual payments. According to an article by gaming guru Mark Pilarski, 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*; see also *evidence about Megabucks annual payments*. According to an article on About.com about slot machine jackpots, “In the case of the MegaBucks or similar multi-million dollar jackpots, you will be paid a check for the partial amount and then you have 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*. For example, the attached article from the *Black Hills Pioneer* describes how the winner of a slot game machine had the option to receive an annuity check of roughly \$31,000 for every year for 21 years. See *attached evidence*. As it is common for slot machine payouts to be made in annual payments, consumers will believe that the wording YEAR and LIFE in the marks simply mean that the slot machines are annuity games where the payout is per year or per year over the course of your life. As a result, the additional words LIFE and YEAR in the applied-for mark give a similar commercial impression and consumers will believe that the terms LIFE and YEAR are different variations of the PROSPEROUS gaming machines. Consumers will see the word PROSPEROUS for annuity games and believe the game emanate from the same source.

As discussed further below, the goods identified by applicant and registrant are either identical or highly related. Where the goods of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir.

2012) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); TMEP §1207.01(b). As the identified goods are identical or highly related, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods.

Applicant argues that the marks have a different visual impression and pronunciation due to the differences between the words LIFE and YEAR. Applicant also argues that the use of these different words gives the marks a different meaning. Applicant is correct that the marks have a different sound and appearance. However, as discussed above, the marks have a similar commercial impression. Consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); see *Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125 (TTAB 1978) (holding TUNA O' THE FARM for canned chicken likely to be confused with CHICKEN OF THE SEA for canned tuna); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to be confused with DOWNTOWNER for the same services); TMEP §1207.01(b). The terms YEAR and LIFE will convey a similar impression of an annuity game to consumers meaning that consumers will believe that the terms LIFE and YEAR are different annuity game variations of the PROSPEROUS gaming machines. As a result, consumer confusion is likely despite the visual and phonetic differences between the marks.

In the first response, applicant argued that the wording PROSPEROUS is weak and so widely used that it should not be afforded a broad scope of protection. The weakness of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar goods*. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Applicant referenced evidence but did not attach any evidence to the first response. The mere mention of evidence without properly attaching it does not make that evidence part of the record. *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP §1208.02; TMEP §710.03. Applicant is responsible for ensuring that attachments are in fact submitted and for providing attachments in a format acceptable to the Office. See for example TMEP §§301, 807.05 regarding requirements for attachments for electronic filing. Applicant's arguments are not persuasive because applicant did not attach any supporting evidence to establish any similar marks in use in the marketplace in connection with similar goods.

In the request for reconsideration, applicant did not provide any evidence of United States registrations using the word PROSPEROUS for similar goods. Applicant mentioned U.S. Registration No. 4319546, but did not include any evidence about that registration. The mere mention of evidence without properly attaching it does not make that evidence part of the record. *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP §1208.02; TMEP §710.03. Even if applicant had provided evidence of U.S. Registration No. 4319546, one registered mark using the word PROSPEROUS does not establish that the word PROSPEROUS is weak or that the registered mark has related goods. Moreover, the weakness of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods. Applicant also did not attach any supporting evidence to establish any similar marks in use in the marketplace in connection with similar goods. Applicant's arguments are not persuasive because applicant did not attach any supporting evidence to establish any similar marks in use in the marketplace in connection with similar goods.

The word "prosperous" is defined by the American Heritage Dictionary of the English Language as "having success" or "well-off." *See evidence attached to final Office action.* The gaming machines identified by applicant and registrant offer monetary rewards that could make users financially successful or well-off, however, the word "prosperous" is not merely descriptive of applicant's slot machine goods. Instead, in order to come to the conclusion that a slot machine could make a person financially successful, it requires a mental thought process to equate the slot machine with monetary wealth and that monetary wealth as successful and that success as prosperous. A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a). Contrary to applicant's argument, the word PROSPEROUS in the applied-for mark is not descriptive of the applied-for goods and thus is not a weak term.

Even if applicant had provided evidence and the word PROSPEROUS is weak for the identified goods, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that wording deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). Even if weak, because of the similar use of the word PROSPEROUS for similar goods, there is a likelihood of confusion between the marks.

Thus, when looking at the gaming machine goods identified in the marks, a consumer would be confused as to the source of the goods because of the use of the word PROSPEROUS. Therefore, the marks are confusingly similar.

### Comparison of the Goods

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that the goods emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

Applicant and registrant both identify gaming machines. As these goods are identical, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. See *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012).

Applicant’s slot machines, video slot machines, gaming machines with liquid crystal displays, and mechanical reel type slot machines with liquid crystal displays are related to the registrant’s gaming machines because the same manufacturers commonly make all identified types of wagering machines. For example, IGT, Bally, Konami, Aristocrat, and WMS make slot machines, video slot machines, gaming machines with liquid crystal displays, and mechanical reel type slot machines with liquid crystal displays. See evidence attached to final Office action. This evidence establishes that the same entity commonly manufactures the relevant goods and markets the goods under the same mark and that the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant’s and registrant’s goods are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).



Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

The record includes evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely gaming machines, slot machines, and video gaming machines are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Applicant argues that other than the identical gaming machines, the goods are dissimilar because applicant identifies different goods than registrant. This argument is not convincing because, while some of the goods of the parties are not identical, they are closely related gaming machines. As discussed previously, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods would be encountered by the same consumers under circumstances such that offering the goods under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i). In this case, the evidence of record amply demonstrates that the goods are related gaming machine goods because they commonly emanate from the same manufacturer, are marketed under the same marks, and are offered to the same groups of consumers in the same trading channels.

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 and the identifications are broad enough to cover individuals who are not knowledgeable in the field. When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004); *see In re Shell Oil Co.*, 992 F.2d 1204, 1208-09, 26 USPQ2d 1687, 1690-91 (Fed. Cir. 1990). In a non-precedential case involving registrant's gaming machines, the TTAB has held:

in determining likelihood of confusion, the classes of purchasers for applicant's gaming devices include not only the sophisticated initial purchasers of the gaming devices themselves, i.e., casinos and other gaming establishments, but also must include the ultimate users of such gaming devices, i.e., ordinary casino customers. Given the fact . . . that slot machines and other gaming devices may be played a penny, nickel or quarter at a time, these ultimate users of gaming devices must be deemed to be ordinary consumers and impulse purchasers who do not exercise more than an ordinary degree of care in deciding to play gaming devices in a casino.

*In re Aristocrat Technologies Australia PTY Limited*, 2005 TTAB LEXIS 472, 11 (2005). The Trademark Trial and Appeal Board has stated that decisions designated as not precedential are not binding upon the Board but may be cited for whatever persuasive value they might have. TBMP §101.03; TMEP §705.05. The above discussion is persuasive that the classes of purchasers for the gaming devices include not only the sophisticated initial purchasers of the gaming devices themselves but also the ultimate users of such gaming devices which are unsophisticated casino customers. As the standard of care for purchasing the goods is that of the least sophisticated purchaser, the relevant standard of care for these goods is the ordinary degree of care and not a heightened sophisticated purchaser standard of care.

Even if registrant's or applicant's goods are only used by knowledgeable consumers, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). The knowledge of the consumers does not obviate a likelihood of confusion.

Applicant argues that no likelihood of confusion exists because applicant owns a registered mark in Australia for an identical mark for similar goods to those in the application and such registration has co-existed in Australia with registrant's mark, which is also registered in Australia. Therefore, applicant concludes there is no likelihood of confusion between the applied-for mark and the registered mark and the trademark examining attorney should withdraw the Trademark Act Section 2(d) refusal. Use of a mark in a foreign country does not give rise to rights in the United States if the goods are not sold in the United States. *Buti v. Impresa Perosa S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985 (2nd Cir. 1998); *Mother's Restaurants Inc. v. Mother's Bakery, Inc.*, 498 F. Supp. 847, 210 USPQ 207 (W.D.N.Y. 1980); *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Aktieselskabet af 21. November 2001 v. Fame Jeans Inc.*, 77 USPQ2d 1861 (TTAB 2006). *See also Honda Motor Co., Ltd. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009) ("[T]he evidence that applicant relies upon

through its foreign registrations and Internet printouts does not demonstrate trademark use for the claimed goods. Further, these documents do not show that applicant has an intent to use the mark in the United States.”) Applicant has not established any use of the applied-for mark in the United States and use of the mark in Australia does not give applicant any rights in the United States.

Even if applicant was using the mark in both the United States and Australia, evidence of applicant co-existing with registrant in Australia does not obviate a likelihood of confusion in the United States because the scope of federal trademark jurisdiction is commerce that may be regulated by the United States Congress. TMEP §901.03. The United States Congress may not regulate commerce in Australia and has no role in determining whether a likelihood of confusion exists between two marks under the laws of Australia. It is also unknown whether any use agreements or other similar issues allowed for both applicant and registrant to register similar marks for similar services in Australia. Regardless, the marketplace and channels of trade relevant to determining likelihood of confusion for the identified services are the United States and in the United States applicant and registrant do not have co-existing registrations that would obviate a likelihood of confusion.

Thus, when confronted by applicant’s and registrant’s gaming machine goods, consumers would likely be confused as to the source of the goods because they are identical or manufactured by the same companies. Therefore, the goods are closely related.

Since the marks are similar and the goods are related, there is a likelihood of confusion as to the source of applicant’s goods. The Section 2(d) refusal made final in the Office action dated August 15, 2013 is maintained and continues to be **FINAL**. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

#### ASSISTANCE

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusals and requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. See TMEP §§705.02, 709.06.

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THIS OPINION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed:  
Nov. 3, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Aristocrat Technologies Australia PTY Limited

Serial No. 76460411

Bernhard Kreten and Scott Hervey of Bernhard Kreten, Esq. & Associates for Aristocrat Technologies Australia PTY Limited.

Sonya B. Stephens, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Seeherman, Bucher and Grendel, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark RED BARON (in standard character form) for goods identified in the application (as amended) as "gaming

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devices, namely, gaming machines and associated software for use therewith, to enable the gaming machine to run.”<sup>1</sup>

The Trademark Examining Attorney has issued a final refusal to register applicant’s mark, on the ground that the mark, as applied to applicant’s identified goods, so resembles the mark RED BARON, previously registered (in standard character form) for goods identified in the registration as “computer game programs,”<sup>2</sup> as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal. Both applicant and the Trademark Examining Attorney have submitted evidence in support of their positions, and the appeal is fully briefed. We affirm.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion 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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201

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<sup>1</sup> Serial No. 76460411, filed on October 22, 2002. The application is based on applicant’s allegation of a bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

<sup>2</sup> Registration No. 1679024, issued on March 10, 1992. Affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

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(Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In this case, additional factors which are pertinent to our analysis are the trade channels in which the goods are sold, the classes of purchasers to whom they are sold, and the sophistication of those purchasers and the care with which the goods are purchased.

We find, under the first *du Pont* factor, that applicant's mark and the cited registered mark are both RED BARON, and that they therefore are identical in terms of appearance, sound, connotation and overall commercial impression.

Under the second *du Pont* factor, i.e., the relatedness of the goods, our analysis and determination are made in accordance with the following principles. It is not necessary that applicant's and registrant's goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would

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be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Moreover, the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods and the registrant's goods that is required to support a finding of likelihood of confusion. Where the applicant's mark is identical to the registrant's mark, as it is in this case, there need be only a viable relationship between the respective goods in order to find that a likelihood of confusion exists. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).



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In this case, the goods identified in the cited registration are "computer game programs." Applicant's goods are identified as "gaming devices, namely, gaming machines and associated software for use therewith, to enable the gaming machine to run." As the dictionary evidence made of record by applicant shows, "gaming" is defined as "the act or practice of gambling." Webster's New World Dictionary (2d College Edition) at 574. Applicant notes that the software referred to in its identification of goods is not sold separately to purchasers, but rather is intrinsic and incidental to the gaming devices themselves.

We find, therefore, that the goods involved in this appeal are applicant's gaming devices (i.e., gambling devices such as slot machines; see applicant's brief at 10), and registrant's "computer game programs." Applicant has argued throughout prosecution of this case that the fact that applicant's and registrant's goods both involve computer software is not determinative. The Trademark Examining Attorney agrees, and has specifically stated (at page 4 of her brief) that "...even if the applicant were to delete software from its current identification of goods (which is 'gaming devices namely gaming machines and associated software for use therewith'), the applicant's

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remaining gaming machine goods would still be considered similar to the registrant's computer game programs."

In support of her Section 2(d) refusal, the Trademark Examining Attorney has submitted printouts of eight use-based third-party registrations which include, she contends, both applicant's type of goods and registrant's type of goods. We note that although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

We find that several of these third-party registrations are of marks which specifically include, in their identifications of goods, both gaming or gambling devices, on one hand, and computer games, on the other hand. For example, Reg. No. 2745324 is of the mark THE CHICKEN GAME, which includes in its identification of goods both "gaming equipment, namely, slot machines with or without video output" and "computer game programs." Reg. No. 2799992 is of the mark INTERBLOCK, which includes in

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its identification of goods both "gaming equipment, namely gaming machines, slot machines, video slot machines, casino gambling machines," and "computer games, namely video game software." Reg. No. 2673863 is of the mark I DREAM OF JEANNIE, which includes in its identification of goods "slot machines, electronic gaming machines, computer game cartridges, and computer games on CD-ROM."

We find, under *Trostel and Mucky Duck, supra*, that these third-party registrations are entitled to probative value in support of the Trademark Examining Attorney's contention that applicant's goods are related to registrant's goods.

There is additional evidence in the record which supports a finding that applicant's "gaming devices" are related to registrant's "computer game programs" such that source confusion is likely to result from use of these identical marks on the respective goods. By way of background, we note that Applicant has attached to its main appeal brief (as Exhibit E) a copy of Regulation 14 of the Regulations of the Nevada Gaming Commission and State Gaming Control Board (hereinafter "Regulation 14"), and requests that we take judicial notice thereof; we shall do so. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694,