

This Opinion is not a  
Precedent of the TTAB

Mailed: January 9, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re GMR, LLC*

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Serial No. 86338948

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Joseph J. Weissman of Johnson Pope Bokor Ruppel & Burns LLP  
for GMR, LLC.

Angela M. Micheli, Trademark Examining Attorney, Law Office 101,  
Ronald R. Sussman, Managing Attorney.

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Before Zervas, Ritchie and Wolfson,  
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

GMR, LLC (“Applicant”) seeks registration on the Principal Register of the proposed standard character mark **BLACKJACK CHAT** for “Computer game software; computer game programs; electronic game programs” in International Class 9 and “Entertainment services, namely, providing online computer and electronic games through a social networking website” in International Class 41.<sup>1</sup>

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<sup>1</sup> Application Serial No. 86338948 was filed on July 16, 2014, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce.

The Examining Attorney determined that **BLACKJACK CHAT** is merely descriptive of Applicant's identified goods and services, and refused registration of Applicant's mark pursuant to Section 2(e)(1) of the Trademark Act, on the ground that the mark is merely descriptive of computer games that utilize the game play of the traditional card game known as blackjack "for matching users signed up to chat together."<sup>2</sup>

After the refusal was made final, Applicant timely appealed to the Board. The case is fully briefed. We affirm the refusal.

Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), prohibits the registration of a mark which, when used on or in connection with the goods and services of the applicant, is merely descriptive of them. A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods or services it identifies. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a non-descriptive commercial impression. If each component retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (PATENTS.COM

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<sup>2</sup> 6 TTABVUE 5.

merely descriptive of computer software for managing a database of records that could include patents, and for tracking the status of the records by means of the Internet). However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for “bakery products”); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for “a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs”). “If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what characteristics the term identifies, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). *See also In re Shutts*, 217 USPQ at 364-365; *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

The record shows that “blackjack” is defined as a “gambling card game in which players try to acquire cards with a face value as close as possible to 21 without going over.”<sup>3</sup> The word “chat” is defined as to “talk in a friendly and informal way,” but it has a special meaning with respect to online content: to “exchange messages online in real time with one or more simultaneous users of a computer network.”<sup>4</sup> The

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<sup>3</sup> At [http://www.oxforddictionaries.com/us/definition/american\\_english/blackjack](http://www.oxforddictionaries.com/us/definition/american_english/blackjack), accessed 11/04/2014, attached to Office Action of November 4, 2014, p. 2.

<sup>4</sup> At [http://www.oxforddictionaries.com/us/definition/american\\_english/chat](http://www.oxforddictionaries.com/us/definition/american_english/chat), accessed 11/04/2014, attached to Office Action of November 4, 2014, p. 5.

Examining Attorney maintains that the proposed mark BLACKJACK CHAT is merely descriptive of computer games, provided online or as computer software programs “that have features of traditional blackjack games and include the ability to exchange messages online in real time with one or more simultaneous other players.”<sup>5</sup>

Applicant does not argue that “chat” is non-descriptive of the goods or services, and the evidence demonstrates that it is not uncommon for computer games to come equipped with a chat feature. Supporting the finding that “chat” is merely descriptive, the Examining Attorney provided screenshots from eight third-party websites, including:

1. PokerStars.com, offering a “player chat” feature as part of an online poker card game.<sup>6</sup>
2. AppsGoneFree, advertising a “popular strategic word game” entitled “Wordbase” as having “just been updated with a much-requested feature” --

The new feature in question is none other than chat. Now, you can chat with your friends aka your opponents while playing Wordbase by accessing the new chat overlay.<sup>7</sup>

3. Xbox.com, offering “Xbox Live parties on Xbox 360” device:

Learn how to use Xbox Live chat on your Xbox 360 console to hold parties while watching movies or playing games.

The website also explains how to troubleshoot problems with “Xbox Live chat:”

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<sup>5</sup> 6 TTABVUE 2.

<sup>6</sup> At <http://www.pokerstars.com/poker/room/features/tour/>, accessed 11/04/2014; attached to Office Action of November 4, 2014, p. 34.

<sup>7</sup> At <http://appadvice.com/appnn/2014/08/popular-strategic-word-game-wordbase-updated-with-new-chat-feature>, accessed 11/04/2014, attached to Office Action of November 4, 2014, p. 9.

[I]f you can't hear someone when using Xbox Live in-game or party chat on Xbox 360.<sup>8</sup>

4. The Playstation.com website, under the tab "Knowledge Center->Answer List->Answer Detail," advises users how to chat via voice and text:

You can use the Party function to chat via voice and text with up to seven of your Friends and fellow players on the PS4 and PS Vita. The Party function is available while using a game or other application, even if the other people in the chat are using a different game or application. An additional benefit of Parties is they make it easy to invite people into the game you're playing, so you can keep everyone together from game to game."<sup>9</sup>

5. Maid Marian Entertainment Inc. advertises "role playing web games" on its website, touting that players can "chat with players around the world."<sup>10</sup>

Based on the above, we find that prospective consumers would immediately perceive from the proposed mark that Applicant's game software and online games have a chat feature.

With respect to the term BLACKJACK in the proposed mark, Applicant argues that it is "not used in the sense of a game of blackjack. There is no game of blackjack."<sup>11</sup> Rather, Applicant asserts that the word "blackjack" "refers to the clever fashion in which cards are used to match people for communicating"<sup>12</sup> and therefore

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<sup>8</sup> At <http://support.xbox.com/en-US/browse/xbox-360/xbox-live/Features>, accessed 11/04/2014, attached to Office Action of November 4, 2014, p. 31.

<sup>9</sup> At [https://support.us.playstation.com/app/answers/detail/a\\_id/51117/~/ps4-party-and-chat-info](https://support.us.playstation.com/app/answers/detail/a_id/51117/~/ps4-party-and-chat-info), accessed 11/4/2014; attached to Office Action of November 4, 2014, p. 20.

<sup>10</sup> At <http://www.maidmarian.com/>, accessed 11/04/2014, attached to Office Action of November 4, 2014, p. 23.

<sup>11</sup> 7 TTABVUE 8.

<sup>12</sup> 7 TTABVUE 7.

“[a] mental leap is needed to understand that the term ‘blackjack’ relates instead to a fun way to match users at the website who are chatting.”<sup>13</sup>

[T]he games offered through the software do not feature any aspect of traditional blackjack. Instead, the term ‘BLACKJACK’ refers to the use of digital playing cards to ‘match’ users only so they can communicate (as in a blackjack deal that starts with two cards for each player). The actual games offered under the mark are unrelated to blackjack.<sup>14</sup>

We consider whether a mark is descriptive on the basis of the identification of goods or services in the application. The question of whether a particular term is merely descriptive must be determined not in the abstract or on the basis of guesswork, but in relation to the goods for which registration is sought, the context in which the term is used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831. The question is not whether someone presented only with the mark could guess the goods or services listed in the identification. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.

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<sup>13</sup> May 4, 2015 Response to Office Action of November 4, 2014.

<sup>14</sup> 7 TTABVUE 5.

*DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

Because Applicant's identifications provide for electronic games, and "blackjack" is a game, upon encountering the term "blackjack" in the proposed mark BLACKJACK CHAT, users will immediately believe that Applicant's goods and services are a means for playing the game of blackjack, or include significant features taken from the game of blackjack. It is immaterial if, in actual use, Applicant does not offer a traditional game of "blackjack."<sup>15</sup>

In light of the above, we find that the terms BLACKJACK and CHAT in the mark are merely descriptive of features of the goods and services. Moreover, when combined, "each component term retains its merely descriptive significance in relation to the goods [and services]," resulting in a composite phrase that is also merely descriptive. *In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (SMART SERIES merely descriptive of metal gun safes). *See also In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1824 (TTAB 2012) (SEMICONDUCTOR LIGHT MATRIX in its entirety is merely descriptive, "because as the words are combined they do not create a meaning different from the individual elements"); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term "BREATHABLE" retained its ordinary dictionary meaning when

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<sup>15</sup> We note, nonetheless that although Applicant asserts that its users do not play "blackjack," *per se*, there is a game of chance in the matching process offered by Applicant via the digital playing cards employed in its computer games and electronic services.

combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry). Immediately upon encountering the mark BLACKJACK CHAT, users will perceive that Applicant’s computer games involve playing a version of blackjack in order to be matched up with other users with whom they are chatting.

Applicant argues that the prior registrations for the marks GRAND THEFT AUTO and TOMB RAIDER, submitted by Applicant during prosecution, illustrate that “the Examiner’s position is faulty” because “both of these marks are more descriptive of their respective games than BLACKJACK CHAT is here.”<sup>16</sup> We disagree that the registration of these marks compels a different decision. Neither of those marks immediately describes the play of the game or the users’ interactions with each other. Moreover, as is often stated, each case must stand on its own record and the Board is not bound by the actions of prior examining attorneys. *See In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the board or this court.”).

In light of the above, we find that Applicant’s composite term “BLACKJACK CHAT,” when viewed in relation to Applicant’s goods and services, immediately

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<sup>16</sup> 4 TTABVUE 8-9.

conveys that Applicant provides electronic games with cards and the ability for consumers to communicate in real time with other players.

**Decision:** The refusal to register Applicant's mark **BLACKJACK CHAT** is affirmed for both the International Class 9 goods and the International Class 41 services.