

This Opinion is not a
Precedent of the TTAB

Mailed: August 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Prologue Games LLC

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Serial No. 86354701

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Harold L. Novick of Novick, Kim & Lee, PLLC,
for Prologue Games LLC.

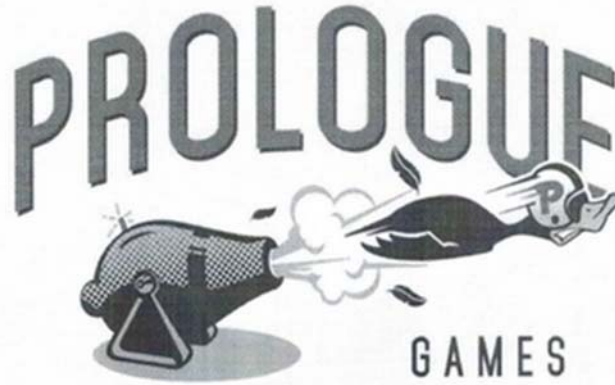
Michael W. Baird, Law Office 121,
Managing Attorney.¹

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Before Ritchie, Kuczma and Adlin,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Prologue Games LLC (“Applicant”) seeks registration on the Principal Register of the mark PROLOGUE GAMES and design, as shown below

¹ The case was reassigned to the Managing Attorney of the Law Office after the appeal was filed.



for:

computer game software for use with personal computers; computer game software for personal computers and home video game consoles; computer programs for video and computer games; interactive video game programs; Video and computer game programs; video game software; Computer game programs downloadable via the Internet; downloadable computer game programs; downloadable electronic game programs,² in International Class 9.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when applied to the identified goods, so resembles the previously registered mark SECOND PROLOGUE, in standard character format, for the goods set forth below, as to be likely to cause confusion, mistake, or to deceive:

computer game programs for mobile phones; downloadable software for use as game programs on mobile telephones and other telephone apparatus; computer game programs for personal computers; downloadable software for use as computer game programs for personal computers;

² Application Serial No. 86354701 was filed on August 1, 2014 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intention to use the mark in commerce, and disclaiming the exclusive right to use the term "GAMES" apart from the mark as shown.

computer game software; video game software; and computer game programs,³ in International Class 9.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *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 (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). We consider the *du Pont* factors for which arguments or evidence were presented. The other factors, we consider to be neutral.

We consider first the relatedness of the goods. Applicant identifies, *inter alia*, “computer game software for use with personal computers” and “video game software,” both of which are also identified in the cited registration. Applicant’s “computer programs for video and computer games” is also encompassed in the “computer game programs” identified in the cited registration. Thus Applicant’s identified goods overlap with, and are identical-in-part to, the goods in the cited

³ Registration No. 4380373 issued August 6, 2013.

registration. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

Because the goods identified in the application and in the cited registration are in-part identical, we must presume that the channels of trade and classes of purchasers are also the same. *See In re Viterra Inc.*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). Applicant does not dispute the relatedness or indeed the identity of the goods, and the channels of trade, and we find that these *du Pont* factors weigh heavily in favor of finding a likelihood of consumer confusion.

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In comparing the marks, we are mindful that 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. *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 mem.*, 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 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). Indeed, when, as here, the goods at issue are identical in part, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than if the goods were not identical. *In re Viterra Inc.*, 101 USPQ2d at 1912.

The mark in the cited registration is SECOND PROLOGUE. Applicant's mark consists of the literal element "PROLOGUE GAMES" as well as a design depicting a duck shooting out of a canon and wearing a helmet that bears the letter "P." The marks are similar in sight and sound to the extent that they both contain the term "PROLOGUE." Applicant submitted a required disclaimer of the term "GAMES," which Applicant acknowledged is merely a "generic term in this context."⁴ As to the term "PROLOGUE," the Examining Attorney submitted a definition indicating that the term means "An introductory act, event, or period."⁵ The resulting commercial impression from Applicant's mark is likely to be that of opening games, while the commercial impression of the mark in the cited registration is, similarly, likely to be perceived as a second set of opening games, or perhaps to a second look at those opening games. Applicant also refers to the "prominent design feature" in its mark.⁶ While we consider this in our analysis of the mark as a whole, we note that a duck shooting out of a canon, bearing a "P" on its helmet, does not detract from the

⁴ May 18, 2015 Response to Office Action.

⁵ June 2, 2015 Final Office Action, at 6. The American Heritage Dictionary (5th ed. 2014).

⁶ 10 TTABVUE 3.

connotation or commercial impression of the commencement of the opening games. We further note that the most prominent feature of Applicant's mark would appear to be the term "PROLOGUE," in large, upper-case letters, placed prominently above the rest of the mark. *See In re Viterra Inc.*, 101 USPQ2d at 1911. As such, we find the marks to be similar in sight, sound, connotation, and commercial impression, and this *du Pont* factor also favors finding a likelihood of confusion.

Applicant argues that to make this conclusion would be inconsistent with prior Board rulings and Office proceedings. However, Applicant refers to a nonprecedential Board case, and to unregistered applications that do not bind us, and are not availing in our analysis.⁷

On balance, after considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that the goods are legally identical and would travel through the same channels of trade to the same consumers, and

⁷ While applicants may cite to non-precedential decisions, such decisions are not binding on the Board and the Board does not encourage this practice. *In re Fiat Grp. Mktg. & Corporate Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014); *In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1121 (TTAB 2012); *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1151 n.7 (TTAB 2011); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1875 n.5 (TTAB 2011). As to the third-party applications, even prior registrations are not binding on Board determinations as the USPTO must examine each application on its own merits based on the record in the application under consideration and neither the USPTO's examining attorneys nor the Board are bound by the decisions of other examining attorneys in other applications. *See In re Cordua Restaurants, Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) ("The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement . . ."); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) ("Even if all of the third-party registrations should have been refused registration . . . , such errors do not bind the USPTO to improperly register Applicant's marks.") (citation omitted); *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.").

that the marks, when viewed in their entireties, are similar enough in sight, sound, connotation and commercial impression for confusion to be likely.

Decision: The refusal to register Applicant's mark is affirmed.