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

Ex Parte Appeal - Serial No.	90441532
Appellant	Laxamentum Technologies, LLC
Applied for mark	GAMEGUARDIAN
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Date	09/12/2022

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

IN RE LAXAMENTUM
TECHNOLOGIES, LLC

Applicant.

Serial No. **90/441,532**

Mark: GAMEGUARDIAN

Examining Attorney: William T.
Verhosek

Application filed: December 31, 2020

Appeal filed: September 12, 2022

APPLICANT'S APPEAL BRIEF

[EX PARTE APPEAL]

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INTRODUCTION

The examining attorney (“Examiner”) had the burden to evidence a likelihood of confusion under Section 2(d) of the Lanham Act. However, the Examiner failed to meet this burden. Specifically, Laxamentum Technologies, LLC (“Applicant”) responded to the Office Action by arguing and evidencing that the two marks are not identical (GAMEGUARDIAN versus GUARDIAN GAMES), the goods and services are not related, the purchasers of the goods and services were sophisticated and that the trade channels in which the parties operated their respective businesses were distinctly different, such that there was no likelihood of confusion. Examiner relied primarily on only **one** *DuPont* likelihood-of-confusion factor and that was the *Relatedness of Goods* factor. However, the only argument asserted by Examiner in support of this position was that because others have websites and forums in addition to a brick-and-mortar retail store, consumers would likely assume that they come from the same source. This evidence is insufficient to meet the Examiner’s burden to show that there is a likelihood of confusion and when considering all relevant *DuPont* factors, the Examiner simply cannot make the case that Applicant’s mark should not be registered. Accordingly, the Examiner’s refusal to register should be reversed.

Notwithstanding the fact that Examiner’s refusal to register Applicant’s mark was not supported by sufficient evidence that a likelihood of confusion exists, the Examiner erred in concluding that there is a likelihood of confusion, because it would be unreasonable for a consumer to believe that because Applicant and Registrant both relate to “games,” that their goods and services emanate from the same source. In making his argument in the first Office Action, Examiner relied on the existence of clothing and other retail websites owned and

operated by large, famous, international companies as evidence that consumers would assume that Applicant's and Registrant's goods and services emanate from the same source. Examiner ignored the fact that neither Applicant nor Registrant are large, famous, international companies and Registrant's mark is not famous, like those companies referenced in each of the exhibits and cases cited by Examiner.

It is clear by examining Registrant's specimens that its website only promotes its one brick-and-mortar store located in Portland, Oregon for reserving rooms to play games (not video games) and card games in-person at Registrant's store. (October 27, 2016, TSDR, Specimen, Reg. No. 5208681; and December 31, 2020, TSDR, Specimen, Serial. No. 90441532). Examiner did not reference the Applicant's and Registrant's website screenshots that were attached as specimens to their respective applications, which clearly show the goods and services are not likely to cause confusion with any reasonable consumer, such that the consumer would believe that the goods and services emanate from the same source. (October 27, 2016, TSDR, Specimen, Reg. No. 5208681; and December 31, 2020, TSDR, Specimen, Serial. No. 90441532). The two websites share no similarities and do not look anything alike. *Id.* Registrant's specimens show that its domain is www.ggportland.com in contrast to Applicant's domain at <https://gameguardian.net/forum/>. *Id.* Moreover, Applicant's website is the sole location of Applicant's business that allows for users to access, among other things, video game *cheats*, (distinct from board and card games) and engage with one another via electronic forum through its website. (December 31, 2020, TSDR, Specimen, Serial. No. 90441532). Applicant's specimens clearly show how it offers and provides its goods and services through its website at <https://gameguardian.net/forum/>. *Id.* Furthermore, Applicant argued that the user was not the consumer, the advertisers who purchased advertising to be featured on Applicant's website were

the end consumers and as such, they are necessarily sophisticated and are unlikely to be confused as to the source or origin of the goods and services offered by Applicant. (January 7, 2022, TSDR, Response to Office Action, p.4). Therefore, it appears that Examiner is attempting to reserve use of Registrant's goods and services that are not expressly listed in its registration and amounts to a zone of expansion argument, which is not relevant in an ex parte appeal.

For the above-stated reasons and as explained in more detail below, this Board should reverse the Examiner's refusal to register Applicant's mark for **Class 38**: Providing website featuring a forum on video game cheats, video game information, news, game play strategies, frequently asked questions about video games, journals, previews, reviews and commentary on video games and order that Applicant's mark for Classes 38 and 09 be registered on the principal registry.¹

SUMMARY OF THE RECORD

A. The Application and First Office Action

On December 31, 2020, Applicant filed its Application under Section 1(a) of the Lanham Act to register the mark, GAMEGUARDIAN for **Class 38**: Providing website featuring a forum on video game cheats, video game information, news, game play strategies, frequently asked questions about video games, journals, previews, reviews and commentary on video games; and **Class 09** for: Downloadable computer application software for mobile phones and tablets to educate and inform users how to edit memory values while videogame is running. (December 31, 2020, TSDR, Application, p. 1). On July 7, 2021, Examiner issued an Office Action refusing to register the GAMEGUARDIAN mark for **Class 38** citing a likelihood of confusion with the

¹ Applicant previously agreed to amend **Class 09** for: Downloadable computer application software for mobile phones and tablets to educate and inform users how to edit memory values while videogame is running.

mark GUARDIAN GAMES in U.S. Reg. No. 5208681. (July 7, 2021, TSDR, Office Action Outgoing). Goods and Services were listed as follows: “The applicant’s mark is GAMEGUARDIAN for “providing website featuring a forum on video game cheats, video game information, news, game play strategies, frequently asked questions about video games, journals, previews, reviews and commentary on video games; computer application software for mobile phones and tablets to educate and inform users how to edit memory values while videogame is running.” *Id.* Examiner suggested a slight amendment to Applicant’s wording for goods and services identified for **Class 09** for registration in this class. *Id.* The registrant’s mark is GUARDIAN GAMES for “retail game stores; retail store services featuring games.”” On May 23, 2017, GUARDIAN GAMES was registered to Registrant, with its first use on July 1, 2005. (May 23, 2017, TSDR Registration Certificate for Reg. No. 5208681, p. 1). The Examiner attached website screenshots from large, international, famous clothing companies to show that it was likely that Applicant’s mark could be confused as to coming from one source. (July 27, 2021, TSDR, Office Action Outgoing, Attachments on p. 1).

Applicant responded to the Office Action on January 7, 2022, refuting the Examiner’s analysis on the issue of likelihood of confusion, submitting evidencing in support thereof and agreeing to amend Class 09 identification of goods and services. (January 7, 2022, TSDR Response to Office Action).

B. The Final Refusal

On January 27, 2022, despite Applicant’s submission of evidence and argument in response to Examiner’s Office Action, the Examiner issued a final refusal (“Final Refusal”) to register Applicant’s mark, GAMEGUARDIAN for class 38. (January 27, 2022, TSDR, Office

Action Outgoing, pp. 4-6). In the Final Refusal, the Examiner cited as the bases for continued refusal only three (3) of the *DuPont* likelihood-of-confusion factors as follows:

1. The Examiner compared the marks and concluded that they were similar in appearance, sound, connotation, and commercial impression, because they shared the words, “GAME” and “GUARDIAN” and dismissed the fact that Applicant’s mark was singular and one word, rather than plural and two words like Registrant’s mark. (January 27, 2022, TSDR, Office Action Outgoing, pp. 4-6).
2. The Examiner compared whether the marks were similar, commercially related or traveled in the same trade channels and concluded that “the applicant’s forum services and the registrant’s retail store services featuring video games are closely related such that purchasers who encounter the marks for these services would believe the services emanate from the source.” This was the only factor for which Examiner provided any evidence. Notwithstanding the distinctions between the descriptions of goods/services, he attached various third-party registrations and internet screenshots belonging to companies that he contended showed, “the services listed therein, namely “online forums and retail stores featuring video games,” are of a kind that may emanate from a single source under a single mark.” (January 27, 2022, Office Action, p. 5).
3. The Examiner found that Applicant’s argument concerning the sophistication of the consumers in this case was unpersuasive. (January 27, 2022, TSDR, Office Action Outgoing, p. 6).

C. Applicant's Request for Reconsideration and Notice of Appeal

On June 27, 2022, Applicant filed both its Request for Reconsideration of the Final Refusal and Notice of Appeal to this Board (the appeal was stayed pending the resolution of the request for reconsideration). (June 27, 2022, TSDR, TEAS Request Reconsideration after FOA; TTABVUE, Appeal to Board filed June 27, 2022). Applicant requested that the Examiner explain his position on 2 issues raised in Applicant's Response to first Office Action: (1) Examining Attorney did not adequately address or in some cases, failed to address Applicant's arguments; and (2) Examining Attorney Misunderstands Applicant's Argument Regarding Sophistication of the Consumer Relating to the Likelihood of Confusion. (June 27, 2022, TSDR, TEAS Request Reconsideration after FOA). Despite Applicant's request for the Examiner to analyze case law that Applicant referenced in its response to the first Office Action, the Examiner summarily denied Applicant's Request for Reconsideration and attached the same screenshots originally attached to the first Office Action of large, famous, international companies as evidence that consumers would assume that Applicant's and Registrant's goods and services emanate from the same source. (July 8, 2022, TSDR, Request for Reconsideration Denied). Accordingly, the stay of this appeal was lifted and Applicant was ordered to file this Appeal Brief. (TTABVUE 4-5).

LEGAL STANDARD

When the USPTO examines a mark for a likelihood of confusion between two marks, it reviews all of the relevant factors under the *DuPont* test. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA1973). The likelihood of confusion is determined by inquiring as to whether the purchasing public would mistakenly assume that the applicant's goods or services originate from the same source as, or are associated with, the goods in cited

registrations. *Paula Payne Prods. Co. v. Johnson Publ'g. Co.*, 473 F. 2d 901, 902, 177 USPQ 76, 77 (CCPA 1973). Courts make this “determination on a case-by-case basis, aided by the application of the factors set out in *DuPont*.” *On-Line Careline, Inc. v. Am. Online, Inc.* 229 F.3d 1080,1084, 56 USPQ 2d 1471, 1474 (Fed. Cir. 2000); *DuPont*, 476 F.2d at 1361, 177 USPQ at 567 (CCPA 1973).

The likelihood of confusion is a question of law subject to *de novo* review. *In re Majestic Distilling Co.*, 315 F.3d, 1311, 1314, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003). It is important to remember that it is “*the [e]xamining [a]ttorney’s burden to make out a prima facie case of likelihood of confusion supported by evidence.*” *In Re James Harris*, TTAB Proc. No. 85918970, at p. 8 (T.T.A.B. 2015) (*emphasis added*); *see also In Re Shipp*, 1987 WL 123841, at *2, 4 U.S.P.Q.2d 1174 (T.T.A.B. 1987); and *see In re Brookwood Funding, LLC* , 2016 TTAB LEXIS 69 (Trademark Trial & App. Bd. February 25, 2016).

For the above-stated reasons, if the Board finds that either the Examiner failed to meet its evidentiary burden with respect to Applicant’s Application; or the *DuPont* factors weigh against a determination of likelihood of confusion, the Board must reverse the refusal to register the mark. (January 27, 2022, TSDR, Office Action Outgoing, pp. 4-6)

ARGUMENT

As referenced herein, the Examiner fails to meet his burden to demonstrate a likelihood of confusion supported by evidence, which alone is a sufficient basis for the Board to reverse the refusal to register Applicant’s mark. Nonetheless, even *arguendo*, if the Examiner had met his evidentiary burden, which he didn’t, his legal analysis with respect to the *DuPont* likelihood-of-confusion factors was not correct. (January 27, 2022, TSDR, Office Action Outgoing, pp. 4-6). Further, Examiner failed to address each of Applicant’s arguments and weight of Applicant’s

cited case law as referenced in Applicant's Request for Reconsideration. (June 27, 2022, TSDR, TEAS Request Reconsideration after FOA, pp. 1-2; TTABVUE 4-5). Instead, each of three (3) *DuPont* factors either weighed against a finding of a likelihood of confusion or was neutral on the issue. (January 27, 2022, TSDR, Office Action Outgoing, pp. 4-6). Accordingly, for either of these two reasons, the Board should reverse the refusal to register and direct the Examiner to proceed with registering Applicant's mark.

A. The Examiner Failed to Meet the Burden to Demonstrate a Likelihood of Confusion Between Applicant's and Registrant's Marks

As referenced above, the Examiner presented actual evidence as to only one *DuPont* factor, which was -- "the applicant's forum services and the registrant's retail store services featuring video games are closely related such that purchasers who encounter the marks for these services would believe the services emanate from the source." (January 27, 2022, TSDR, Office Action Outgoing, pp. 4-6). Thus, with no other evidence presented by the Examiner failed to meet his evidentiary burden and the refusal to register should be reversed.

The question of whether goods/services offered by an applicant are substantially similar or "legally related" to those offered by a registrant is generally determined based only on the descriptions in the application and registration at issue. *Coach Servs., Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 1369, 101 U.S.P.Q.2d 1713 (Fed. Cir. 2012). However, when the description of goods/services for a registration "has a specific meaning to members of the trade," the general rule is inapplicable as "it is improper to simply consider that description in a vacuum and attach all possible interpretations to it." *In Re Trackmobile, Inc.*, 1990 WL 354505 at *2, 15 U.S.P.Q.2d 1152 (T.T.A.B. 1990). Here, there is a specific meaning to members of the (video) gaming trade for the term, "*cheats*" as it relates to determining the source code to help others

strategize and play games effectively and in this case, it is only for use on Androids. Therefore, the card games and games referenced in Registrants specimens and goods/service identification are clearly unlikely to be confused with video game cheats or strategies that are also discussed in Applicant’s online forum. (October 27, 2016, TSDR, Specimen, Reg. No. 5208681; and December 31, 2020, TSDR, Specimen, Serial. No. 90441532).

1. Zone of Expansion Is Not Relevant in Ex Parte Appeals.

Furthermore, it appears that without expressly stating it, instead of arguing that there is a likelihood of confusion, Examining Attorney is arguing that there is a zone of expansion reserved for Registrant for use of a “forum” similar to that of Applicant’s. (January 27, 2022, TSDR, Office Action Outgoing, pp. 4-6).

“A zone of expansion is not relevant in an ex parte appeal. In federal infringement litigation or *inter partes* proceedings at the TTAB, one party may claim that its priority of use should extend to include the other party’s goods or services because they are likely to bridge the gap or undergo expansion of trade and go into that part of the market.” 3 Gilson on Trademarks § 9A.04; *see* § 507. This “expansion of trade” doctrine is generally not relevant in *ex parte* proceedings. TMEP § 1207.01(a)(v). *See, e.g., In re RJ Brands, LLC*, 2020 TTAB LEXIS 286, n.5 (T.T.A.B. 2020) (not citable as precedent) (“The doctrine of ‘bridging the gap’ or ‘natural expansion’ ... is not applicable in an ex parte proceeding. ...”); *In re Kysela Pere et Fils, Ltd.*, 98 U.S.P.Q.2d 1261 (T.T.A.B. 2011) (“[N]either the argument by an examining attorney that the applicant’s goods or services are within the natural scope of expansion of the goods or services of the registrant, nor the argument by an applicant that it is not likely that the *particular* registrant that owns the cited registration(s) will so expand its use of its mark, is applicable in an ex parte proceeding.”) (emphasis in original). 3 Gilson on Trademarks § 9A.04 (2022) The TTAB instead looks at the relatedness of goods and services as described above. TMEP § 1207.01(a)(v). *See, e.g., In re IM Production*, 2019 TTAB LEXIS 317 (T.T.A.B. 2019) (not citable as precedent) (“The Board considers [the expansion of trade doctrine] in *ex parte* proceedings through a traditional relatedness of goods and services approach.”); *In re 1st USA Realty Professionals, Inc.*,

84 U.S.P.Q.2d 1581 (T.T.A.B. 2007) . 3 Gilson on Trademarks § 9A.04 (2022). The Board has stated that “in the context of an *ex parte* proceeding the analysis should be whether consumers are likely to believe that the services emanate from a single source, rather than whether the owner of the cited registration has or is likely to expand its particular business to include the goods of applicant.” *In re Kysela Pere et Fils*, 98 U.S.P.Q.2d 1261.

3 Gilson on Trademarks § 9A.04 (2022).

Registrant’s application does not identify anything relating to video games, forums or cheat codes. The websites, as depicted in the screenshots on file as part of the Registrant’s and the Applicant’s specimens are not likely to cause confusion as to the source of origin of Applicant’s goods or services. (October 27, 2016, TSDR, Specimen, Reg. No. 5208681; and December 31, 2020, TSDR, Specimen, Serial. No. 90441532). In fact, it would be unreasonable to believe that any consumer, whether an individual or a business, is likely to be confused as to the origin or source of Applicant’s goods or services. In particular, since Registrant’s registration clearly identifies only games (not video games), card games and games that are played in-person at Registrant’s one brick-and-mortar store located in Portland, Oregon (as depicted in Registrant’s specimen), this Board should find that Applicant’s use of its mark in association with its identified goods and services *is not likely to cause confusion*.

2. Third-Party Registrations Do Not Evidence a Likelihood of Confusion.

Examiner presented a number of third-party marks which were registered for use in connection with online forums also provide retail stores, both featuring video games, like the registrant. However, this Board has previously rejected a similar argument. (January 27, 2022, TSDR, Office Action Outgoing, pp. 4-6).

In the case of *In Re the Pilot Funds*, TTAB Proc. No.74551253 (T.T.A.B. 1998) (“*Pilot*”), the examining attorney had refused registration of the mark, THE PILOT FUNDS for mutual fund investment services, based on a likelihood of confusion with the mark PILOT PLUS for securities brokerage services. *Id.* at pp. 1-2. Like in this case, the examining attorney engaged in a “similarity of services” analysis, which was based on third-party registrations in which these services were listed under the same mark and the examining attorney theorized that, “when a consumer encounters a similar mark on the services of the nature identified by the applicant and the registrant, he is likely to believe that [their] two services, albeit different services, are offered by the same institution.” *Id.* at p. 3. The Board reversed, agreeing with the applicant that the third-party registrations did not provide “any real-world rationale for how confusion is likely to occur, given the parties’ respective identification[s] of services.” *Id.* at p. 4.

Here, as in the *Pilot* case, the Registrant and Applicant’s, consumers are not likely to be confused, as their respective identification(s) of goods/services are clearly different. Specifically, Applicant’s mark is GAMEGUARDIAN used in connection with “providing website featuring a forum on video game cheats, video game information, news, game play strategies, frequently asked questions about video games, journals, previews, reviews and commentary on video games; computer application software for mobile phones and tablets to educate and inform users how to edit memory values while videogame is running.” Compared with Registrant’s mark, GUARDIAN GAMES used in connection with “retail game stores; retail store services featuring games.” (May 23, 2017, TSDR Registration Certificate for Reg. No. 5208681, p. 1). Importantly, while Examiner attached numerous registrations of other trademark holders that own retail stores and have forums, Examiner still fails to show how Registrant is similar to Applicant and to the third-party registrants. (January 27, 2022, TSDR, Office Action Outgoing, pp. 4-6)

If the identification of goods or services does not limit “their nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers.” TMEP § 1207.01(a)(iii). Thus, an examining attorney may present third-party registrations to advance their theory, but in this case, it is not convincing, because Applicant limited the nature and types of goods and services offered as follows: “providing website featuring a forum on video game cheats,” “video game information,” game play strategies,” “frequently asked questions about video games,” “previews, reviews and commentary on video games,” and “computer application software for mobile phones and tablets to educate and inform users how to edit memory values while videogame is running.” Whereas, in contrast, the Registrant provides descriptions of its goods/services as follows: “retail game stores; retail store services featuring games.” (May 23, 2017, TSDR Registration Certificate for Reg. No. 5208681, p. 1).

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board reverse the refusal to register Applicant’s mark, class 38 and proceed with registration for both class 38 and class 09.

Dated: September 12, 2022

By: /Wendy B. Mills/

