

This Opinion is not a
Precedent of the TTAB

Hearing: April 21, 2016

Mailed: June 2, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Atari Interactive, Inc.

v.

Andrew N. Greenberg

—
Opposition No. 91202952
—

Susan Progoff, Fara S. Sunderji, and Kaydi L. Osowski of Dorsey & Whitney LLP for
Atari Interactive, Inc.

Andrew N. Greenberg, *pro se*.

—
Before Quinn, Mermelstein, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Andrew N. Greenberg (“Applicant”) filed an application to register on the Principal Register the mark HAUNTED HOUSE TYCOON in standard characters for “Computer game software,” in International Class 9.¹

¹ Application Serial No. 85268906, filed on March 16, 2011, based on Applicant’s asserted *bona fide* intention to use the mark under Trademark Act Section 1(b), 15 U.S.C. 1051(b). Applicant disclaimed the exclusive right to use HAUNTED HOUSE apart from the mark as shown.

Atari Interactive, Inc. (“Opposer”) opposed registration of the mark on the ground that it so resembles Opposer’s earlier used and registered mark HAUNTED HOUSE as to be likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer pleaded ownership of Reg. No. 4037222 for the mark HAUNTED HOUSE in standard characters, issued under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), for the following goods:²

Downloadable electronic games via the internet and wireless devices; electronic, video and multimedia game software for use on personal computers and for use on electronic game playing machines; recorded computer software featuring video games; game software for computers; and prepaid downloadable video game and video game software, in International Class 9.

Applicant denied the salient allegations of the notice of opposition. The case is fully briefed. A hearing was held on April 21, 2016, at which both parties were heard by this panel.

I. The record.

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the application file for the opposed mark.

Opposer has made of record the following testimony and evidence:

- Testimonial deposition of Todd Shallbetter, Opposer’s Chief Operating Officer, and exhibits thereto (“Shallbetter I”) (23 TTABVUE).
- Rebuttal testimonial deposition of Todd Shallbetter and exhibits thereto (“Shallbetter II”) (34 TTABVUE).
- Notice of reliance (22 TTABVUE) upon:

² Reg. No. 4037222 issued October 11, 2011.

- Opposer's pleaded registration;
 - Applicant's responses to select interrogatories;
 - Published news items;
 - Excerpts from the discovery deposition of Applicant, with exhibits thereto.
- Notice of reliance upon USPTO records and Office Action relating to Opposer's Application Serial No. 86464337 (40 TTABVUE).

Applicant has made of record the following evidence:

- Notice of reliance (24 TTABVUE) upon:
 - An Office Action relating to Opposer's Application Serial No. 85087894;
 - Opposer's responses to select interrogatories;
 - A LinkedIn profile of Opposer's Chief Operating Officer;
 - Excerpts from Shallbetter I;
 - A Wikipedia entry for "Business simulation game";
 - A copy of U.S. Reg. No. 3640720.
 - Internet evidence relating to third-party games entitled "Haunted House" or involving a haunted house.

II. Evidentiary objection.

Opposer moves to strike Applicant's Exhibit A3 on the ground that it is irrelevant.³ The exhibit is a copy of a profile, on the website <linkedin.com>, of Todd Shallbetter, who testified twice in this proceeding on behalf of Opposer. The objection is overruled and the evidence will be admitted for what it shows on its face.

³ Opposer's brief at 4, 41 TTABVUE 11.

III. Standing.

Opposer has properly made of record its pleaded registration⁴ by filing a current printout of information from the electronic database records of the USPTO showing the status and title of the registration. Opposer has thus established its standing to oppose registration of Applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

IV. Opposer's claim under Section 2(d).

We turn, then, to the merits of Opposer's claim on the ground of priority and likelihood of confusion, under Trademark Act Section 2(d). In view of Opposer's ownership of a valid and subsisting registration of its pleaded mark, priority is not in issue with respect to the mark and the goods identified in the registration. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion is based on an analysis of all 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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

⁴ 22 TTABVUE 6-9.

A. The goods.

We will consider first the similarity or dissimilarity of the parties' respective goods as they are identified in the application and registration at issue. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014); *Octocom Syst. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant seeks to register his mark for "Computer game software." These goods are identical to Opposer's "game software for computers." Applicant's identification of goods is also broad enough to encompass within its scope the other more specific forms of computer game software identified in Opposer's registration. Accordingly, Applicant's goods, as identified, are legally identical to all, or nearly all, of the goods identified in Opposer's registration.

Applicant has argued vigorously that the parties' goods are, in actuality, obviously very different in nature, because Applicant's goods are a "tycoon" type of game and Opposer's goods are an "adventure" type of game.⁵ These facts are not relevant to the analysis of the similarity or dissimilarity of the parties' goods, because Applicant seeks to register his mark for "Computer game software," not merely software for tycoon games. We must presume that Applicant's goods encompass all goods of the nature and type identified in the application, including adventure games. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *see also Octocom*, 16 USPQ2d at 1787.

⁵ Applicant's brief, 42 TTABVUE 14-15, 22, 26.

As the parties' goods are legally identical, the *du Pont* factor of the similarity or dissimilarity of the goods heavily favors a finding of likelihood of confusion.

B. Trade channels; customers.

Because the goods at issue are identical, we must presume that the goods of Applicant and Opposer move in the same channels of trade and are offered to the same classes of consumers. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Applicant argues that he intends to offer his game through his own website, where Opposer's games would not be offered.⁶ However, because Applicant has identified his goods without restriction as to the trade channels through which they will be offered, we must give consideration to the full range of ordinary trade channels for computer games, including third-party distribution channels where computer games are offered. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

Applicant discusses in his brief the types of persons who might purchase and play a "tycoon" game and those who might purchase and play an "adventure" game, contending that they are somewhat different.⁷ As we have noted above, Applicant's goods are not limited to tycoon games; and Opposer's mark is registered for "game software for computers," without limitation to adventure games. Accordingly, in

⁶ 42 TTABVUE 22.

⁷ 42 TTABVUE 8, 18, 22.

accordance with *Viterra, supra*, we must presume that the marks and goods of both parties might be marketed to all customers having an interest in purchasing or playing any type of computer game. As the parties' trade channels and classes of customers are presumed to be identical, these *du Pont* factors weigh in favor of a finding of likelihood of confusion.

C. The marks.

Next we consider the similarity or dissimilarity of the marks HAUNTED HOUSE and HAUNTED HOUSE TYCOON in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (citation omitted). Moreover, marks must be considered in light of the fallibility of memory. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014).

The two marks are similar in appearance, sound and meaning to the extent that each has, as its initial component, the term HAUNTED HOUSE. The other wording of Applicant's mark, TYCOON, is a point of difference in appearance, sound, and meaning. The parties agree that TYCOON designates a genre of computer games, also known as “business simulation games” and “economic simulation games,” which

are “games that focus on the management of economic processes, usually in the form of a business.”⁸ Applicant, in his discovery deposition, referred to tycoon games as “a very big genre of games, pretty well-explored class of games.”⁹ He further stated, “Tycoon had become a genre, as opposed to anything anyone could claim the mark on. ... It’s pretty well seen as a genre of games now, as opposed to a name element.”¹⁰ Because TYCOON identifies a genre of computer game, it does little to distinguish Applicant’s mark from Opposer’s mark. *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (generic term had “nominal commercial significance,” and was “properly accorded ... less weight in assessing the similarity of the marks”). Applicant’s mark, viewed in its entirety, could be perceived as Opposer’s mark followed by a generic name for goods of a type that might be offered by either Applicant or Opposer. In that regard, the two marks create highly similar commercial impressions.

While there are differences in appearance, sound and meaning between the parties’ marks, we find that the similarities outweigh the differences and that the two marks

⁸ See Wikipedia entry for “business simulation game,” Shallbetter II, Ex. 20, 34 TTABVUE 44-46; Applicant’s notice of reliance, Ex. A7, 24 TTABVUE 38-40.

⁹ Greenberg Dep. 19:13-14, 22 TTABVUE 110. See also Shallbetter I 33:9-12, 23 TTABVUE 36 (“A ‘Tycoon’ game is typically a simulation game where users can construct a world or an environment using assets and tools to create a simulated environment.”)

¹⁰ Greenberg Dep. 21:4-5, 15-16, 22 TTABVUE 112. Applicant, in describing his own game, stated, “In Haunted House Tycoon, the player has the ability to put together game assets, such as floors, walls, scenery elements, employees, and the like, to construct a Haunted House, which would then attract a customer base, based on how well they’ve build [*sic*] it ...” *Id.* at 33:14-18, 22 TTABVUE 135.

create similar commercial impressions overall. This *du Pont* factor favors a finding of likelihood of confusion.

D. Strength or weakness of Opposer's mark.

Applicant has made two arguments relating to the weakness of Opposer's mark as a source-indicator, suggesting that the mark is entitled to a narrow scope of protection.

First, Applicant contends that HAUNTED HOUSE is a genre of computer games.¹¹ This claim is unsupported by evidence. It is true that HAUNTED HOUSE has descriptive meaning in connection with Opposer's goods, because Opposer's games involve an imaginary quest for pieces of a broken magic urn that are hidden in a house filled with "ghouls, ghosts, bats, and other adversaries that challenge you in this quest."¹² However, when Opposer sought registration of its mark, it overcame this lack of inherent distinctiveness by demonstrating acquired distinctiveness, so that Opposer's pleaded registration issued under Trademark Act Section 2(f).¹³ Now that Opposer's mark is registered, it is entitled to a presumption of validity under Trademark Act Section 7(b), 15 U.S.C. § 1057(b). Applicant contends that "a presumption of a valid mark may be rebutted if that mark is not inherently distinctive ..."¹⁴ However, Applicant has not counterclaimed for cancellation of Opposer's

¹¹ Applicant's brief, 42 TTABVUE 11-14.

¹² Shallbetter I 8:8-21, 23 TTABVUE 11.

¹³ Although Opposer need not, in this proceeding, demonstrate that its mark has acquired distinctiveness, Opposer has made of record press notices referring to its mark and goods from 1982, 1983, 2004, 2010, 2011, and 2012. 22 TTABVUE 16-98.

¹⁴ Applicant's brief, 42 TTABVUE 13.

registration, and an opposer's pleaded registration must be considered valid unless the applicant seeks to cancel it by way of a counterclaim or a separate petition to cancel. Trademark Rule 2.106(b)(2)(ii); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 165 USPQ 515, 517 (CCPA 1970) ("As long as the registration relied upon by an opposer in an opposition proceeding remains uncanceled, it is treated as valid and entitled to the statutory presumptions."); *see also In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) ("inasmuch as the cited mark is registered on the Principal Register, we must assume that it is at least suggestive and we cannot entertain applicant's argument that the registered mark is descriptive of registrant's services."). Absent a counterclaim for cancellation, we cannot consider Applicant's argument that Opposer's mark is generic or otherwise unregistrable.

Applicant also argues that Opposer's mark is weak because many other computer games have been issued by third parties under the name or title HAUNTED HOUSE. Under *du Pont*, a relevant consideration is "The number and nature of similar marks in use on similar goods." 177 USPQ at 567. The Federal Circuit has held that evidence of third-party use is relevant to show that a term "may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that [term] is relatively weak," and "can show that customers have been educated to distinguish between different marks on the basis of minute distinctions." *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (internal quotation marks omitted). Here, Applicant has shown that the mark HAUNTED HOUSE is registered

in the name of a third party for “Gaming machines, namely, electronic slot and bingo machines; Video lottery terminals.” U.S. Reg. No. 3640720, issued June 16, 2009.¹⁵ Applicant has also made of record evidence, found on the internet, relating to the following seven products:¹⁶

“Haunted House” for the Magnavox Odyssey “The World’s First Horror Video Game.”

“Haunted House,” “an early tape-based text adventure.”

Entry in “C64 Game Database” listing “1983, Alligata Software” game, “HAUNTED HOUSE (ALLIGATA VERSION). Genre: Arcade; Media: Tape.”

“Harry and the Haunted House,” “number sixth Living Books PC Rom Game from 1996 based on the 1991 book by Mark Schlichting...”

“Remake 04 Competition Entry” called “Haunted House.” Genre: Adventure. Released 2004. “RETROREMAKES Competition Entry,” Winner – 8th Place Overall.”

“A spooky adventure game” released in 1997, based on a pop-up book. “The owner of the Haunted House is not well...”

“The Ultimate Haunted House.” “Gahan Wilson’s The Ultimate Haunted House is a computer adventure game developed by Byron Preiss.” Published in 1993 and 1994.

Opposer’s witness, in rebuttal testimony, testified extensively with respect to the above-listed evidence. Regarding the registered mark for gaming machines, he testified that he had never seen a gaming machine marked with the HAUNTED HOUSE mark in the marketplace; that such machines would typically be found “in bars and restaurants where video gaming, you know, gambling wagering is allowed,

¹⁵ Applicant’s notice of reliance, 24 TTABVUE 23.

¹⁶ Applicant’s notice of reliance, Exs. 11-17, 24 TTABVUE 6-21.

casinos and ... locations or standalone businesses where municipal or, you know, pari-mutuel gambling is allowed”; and that they would be purchased by “Casino proprietors, business proprietors.”¹⁷

With respect to the other evidence of third-party uses, Opposer’s witness testified persuasively that several of them are games designed for obsolete equipment that is no longer in the market. He testified that the Magnavox Odyssey product was designed for a console that “was discontinued in the 1970’s so you would have to procure a console from a collector or an aficionado site somehow to get a system that you could play this game on”;¹⁸ that the “early tape-based text adventure” was designed for play on the Tandy TRS-80 computer “which is a very very early computer from the late 70’s and early 1980’s. ... It is a very antiquated home computer”;¹⁹ that the Alligata product was a “tape media” product to be played on the Commodore 64 computer released in 1983, which would be available only “[t]hrough collectors or aficionado sites as with these other antiquated platforms ...”;²⁰ and that the “Living Books PC Rom Game” “is not a game we think of as games. We wouldn’t consider it a game ... I would consider it more of an interactive reading product.”²¹ With respect to all of the eight third-party products adduced by Applicant, Opposer’s witness stated that he had never seen them offered in Opposer’s trade channels, while

¹⁷ Shallbetter II 11:17-12:9, 34 TTABVUE 14-15.

¹⁸ *Id.* 24:5-15, 34 TTABVUE 27.

¹⁹ *Id.* 25:18-26:8, 34 TTABVUE 28-29.

²⁰ *Id.* 28:4-14, 34 TTABVUE 31.

²¹ *Id.* 19:2-8, 34 TTABVUE 22.

maintaining that his job was to watch such trade channels and be aware of such products.²²

The evidence does not persuade us that a significant number of third-party uses of HAUNTED HOUSE are *currently* present in the marketplace. It is too sparse to demonstrate that relevant customers have been exposed to so many different HANTIED HOUSE marks that they have become alert to “minute distinctions” between them. We find that Applicant has failed to demonstrate that Opposer’s mark suffers from any meaningful weakness as a source-indicator. But even if the record supported the argument that Opposer’s mark is weak, it is well settled that even weak marks are entitled to protection. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 182 USPQ at 109 (“Confusion is confusion. The likelihood thereof is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and a ‘strong’ mark.”).

E. Careful selection of the goods.

Applicant argues that game buyers exercise enough care to avoid confusion as between the marks at issue, stating that gamers are “famously loyal to publishers” and that they “follow the upcoming releases of their favorite games with great devotion, and ... have famous loyalty to brands and game types. ... Gamers are renowned for their devotion to their hobby and to the amount they study, follow and anticipate their games.”²³ The parties have argued extensively over whether their

²² *Id.* 12:17-13:22, 34 TTABVUE 15-16.

²³ Applicant’s brief, 42 TTABVUE 25.

specific games are targeted toward children or adults; however, there is no substantial evidence to show the actual conditions under which the goods are sold, the prices of the goods, and the degree of care exercised by the purchasers in selecting the goods. Accordingly, we find this *du Pont* factor to be neutral.

F. Absence of actual confusion.

Opposer has admitted that it is not aware of any confusion involving the two marks at issue.²⁴ Applicant argues that this lack of actual confusion is one of the most relevant factors in our analysis.²⁵ The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of his mark for a significant period of time in the same markets as those served by Opposer under its mark. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). In this case, the evidence indicates that Applicant is not actively marketing his goods; and that he has expended only very small amounts in promoting his goods.²⁶ Thus, there is no indication that there has been a meaningful opportunity for confusion to occur. Under the circumstances, we find the lack of evidence of actual confusion to be a neutral factor in our analysis of likelihood of confusion.

²⁴ Opposer's response to Interrogatory 11, 24 TTABVUE 55.

²⁵ Applicant's brief, 42 TTABVUE 20, 24.

²⁶ Applicant's responses to Interrogatories Nos. 1(b), 2, and 3, 22 TTABVUE 15.

G. Fair use.

In connection with his arguments regarding the lack of distinctiveness of Opposer's mark, Applicant contends that his use of his mark is "protected as fair use."²⁷ The principle of fair use, set forth in Trademark Act Section 33(b)(4), applies to the use of a term "otherwise than as a mark" and "only to describe the goods" of the user. 15 U.S.C. § 1115(b)(4). This principle is inapplicable by its terms to the present case, because Applicant specifically seeks registration of his mark *as a trademark*. The fair use doctrine provides a defense to a claim of infringement; it does not grant Applicant a right to *register* a mark which would otherwise be likely to cause confusion. *See Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1338 (TTAB 2006).

H. Balancing the factors.

We have considered all of the evidence of record and all arguments of the parties relevant to the issues before us, including those not specifically discussed herein. Applicant's mark is highly similar to Opposer's mark; and the parties' goods, trade channels, and customers are legally identical. Although Opposer's mark is not inherently distinctive, it is presumed to have acquired distinctiveness and there is corroborating evidence of actual market recognition of the mark. Applicant has not successfully shown that Opposer's mark is meaningfully weakened by third-party use. We find that Applicant's mark, as intended to be used in connection with the identified goods, so closely resembles Opposer's mark as to be likely to cause confusion, mistake or deception as to the source of Applicant's goods. We hasten to

²⁷ Applicant's brief, 42 TTABVUE 20-21.

add that we have made a determination of *registrability* only, a determination that in some regards does not take into consideration all of the current market realities affecting the businesses of Applicant and Registrant.

Decision:

The opposition is SUSTAINED on grounds of likelihood of confusion under Trademark Act Section 2(d).