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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Francine J. Pine

Serial No. 76/012,710
Serial No. 76/055,646

Jeffrey A. Pine of Baniak, Pine & Gannon for Francine J. Pine.

Glenn Mayerschoff, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Chapman, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

In the above-captioned applications, applicant seeks registration on the Principal Register of the marks TIC-TAC-21 (in typed form)[1] and TIC TAC POKER (in typed form,

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[1] Serial No. 76/012,710, filed March 29, 2000. The application is based on intent to use, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

POKER disclaimed).[2] In both applications, applicant's goods are identified as "gaming equipment, namely, gaming, gambling or slot machines, with or without video output."

In each of the applications, the Trademark Examining Attorney has issued a final refusal of registration on the ground that applicant's mark, as applied to applicant's goods, so resembles the mark TIC TAC DISCO, previously registered on the Principal Register (in typed form) for goods identified in the registration as "currency and/or credit operated slot machines and gaming devices, namely, gaming machines,"[3] 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 in each application. The appeals have been fully briefed, but no oral hearing was requested. Because the appeals involve common questions of law and fact, we shall decide them in this single opinion.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the

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[2] Serial No. 76/055,646, filed May 24, 2000. The application is based on intent to use, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

[3] Registration No. 2,435,675, issued March 13, 2001.

likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We find that applicant's goods, as identified in the respective applications, are legally identical to the goods identified in the cited registration, and that they are marketed in the same trade channels and to the same classes of purchasers. Applicant does not contend otherwise.

We next must determine whether applicant's marks and the cited registered mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. 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 that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the

recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.,* 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.,* 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, where, as in the present case, the marks would appear on legally identical goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698 (Fed. Cir. 1992).

In terms of appearance and sound, applicant’s marks and the cited registered mark obviously are identical to the extent that they begin with TIC TAC (or the equivalent TIC-TAC), yet dissimilar to the extent that applicant’s marks end in 21 and POKER, respectively, and the cited registered mark ends in DISCO.

In terms of connotation and overall commercial impression, we find that applicant’s marks TIC-TAC-21 and TIC TAC POKER, as applied to gaming machines, would be

understood to refer to the theme, subject matter or object of the game depicted or featured on the gaming machines and/or the manner in which the games are played, i.e., as a combination of the games "tic-tac-toe" and, respectively, "21" (or blackjack),[4] and poker.

The term DISCO in the cited registered mark connotes "discotheque" rather than a gambling game like "21" or poker. However, when viewed as a whole, the cited registered mark, like applicant's marks, connotes that the theme or object of the game featured on registrant's gaming machines involves the alignment of symbols in a manner suggested by the game "tic-tac-toe." We find that this shared "tic-tac-toe" theme in the marks renders the marks more similar than dissimilar, and outweighs the specific differences in the marks. Even if the specific differences in the marks are perceived and recalled, purchasers are likely to assume that the games bearing these marks are all

[4] We take judicial notice that "21" is another name for the game of blackjack; "blackjack" is defined, *inter alia*, as "a card game the object of which is to be dealt cards having a higher count than those of the dealer up to but not exceeding 21 – called also *twenty-one, vingt-et-un*." Webster's Ninth New Collegiate Dictionary at 156 (1990). The Board may take judicial notice of dictionary definitions. *See, e.g., University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.,* 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); see also TBMP §712.01.

part of a series of “tic-tac-toe”-themed gaming machines produced by a single source.

This conclusion is bolstered by the fact that, on this record, registrant is the only entity in the marketplace employing a “tic-tac-toe” theme in connection with gaming machines. Applicant asserts that there are numerous third-party registrations and applications involving “tic-tac” marks, but that assertion is unsupported by the record. The Board does not take judicial notice of third-party registrations and applications residing in the Patent and Trademark Office. *See In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *In re Hub Distributing, Inc*., 218 USPQ 284 (TTAB 1983); *In re Duofold, Inc*., 184 USPQ 638 (TTAB 1974). In any event, it is settled that even if evidence of the existence of third-party registrations and applications is properly made of record, such evidence does not prove that the cited registered mark is weak or entitled to a narrowed scope of protection in our likelihood of confusion analysis. *See Olde Tyme Foods Inc. v. Roundy’s Inc*., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In summary, we have reviewed the evidence of record pertaining to the *du Pont* factors, and conclude that a likelihood of confusion exists. We find that applicant’s

marks are more similar than dissimilar to the cited registered mark, and that they certainly are sufficiently similar to the cited registered mark that source confusion is likely to result if these marks were to be used on the identical goods involved in this case. Any doubt as to this conclusion must be resolved against applicant. *See In re Hyper Shoppes (Ohio) Inc.,* 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc*., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register in each application is affirmed.

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Bucher, Administrative Trademark Judge, dissenting:

In its appeal briefs, applicant implies that there is widespread third-party usage of the "tic tac" formative in conjunction with the naming of gaming machines having similarities to the tic tac toe game. (Applicant's briefs, pp. 4 – 7) Unfortunately, I have to agree with the majority that applicant has failed herein to document this charge with copies of federal trademark registrations, Internet evidence of common law usage, etc. Hence, we have no probative evidence as to the *du Pont* factor focusing on

the relative strength of the cited mark, or the prevalence of the "tic tac" formative within trademarks used by other manufacturers/merchants of gaming machines.[5]

With the diminished standard on similarity of marks that flows from having legally-identical goods, the instant decision turns on one's treatment of the first *du Pont* factor: the confusing similarity of the respective marks.

In this context, I take judicial notice of several dictionary entries:

> **tick-tack-toe** n. 2. a children's game consisting of trying, with the eyes shut, to bring a pencil down upon one of a set of circled numbers, as on a slate, the number touched being counted as a score.[1865-70, imit. of sound, as of bringing a pencil down on slate; see TICKTACK]. The Random House Dictionary of the English Language (1st Ed. 1987).

This older and less familiar game of "tick-tack-toe" (or "tic-tac-toe" or "tic tac toe") got its name from the compound word "ticktack" (or "tictac"):

> **tick•tack** n. 1. a repetitive sound, as of ticking, tapping, knocking or clicking … -- v.i. 3. to make a repeated ticking or tapping sound… Also, **tictac**. The Random House Dictionary of the English Language (1st Ed. 1987).

Moving quickly from 19th Century slate to 21st Century electronic games, a mark having a "tic tac" formative may

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[5] *du Pont* factor 6: "The number and nature of similar marks in use on similar goods."

well suggest a game of blind chance ("with the eyes shut") where one counts the score upon hearing the repetitive sounds ("tick tack") of the gaming machine's soundtrack.

> **tick-tack-toe** n. 1. a simple game in which one player marks down only X's and another only O's, each alternating in filling in any of the nine compartments of a figure formed by two vertical lines crossed by two horizontal lines, the winner being the first to fill in three marks in any horizontal, vertical, or diagonal row. The Random House Dictionary of the English Language (1st Ed. 1987).

This entry reflects the game of "tic-tac-toe" (or "tic tac toe") with which we are more familiar. Based on this description, marks for gambling machines having a "tic tac" formative may well suggest something about the pattern of the active windows or the playing grid, or even a suggestion that the game on this slot machine contains an element of skill on the part of the player.

Using the latter interpretation, it is unlikely that these microprocessor-controlled slot machines involve games of alternate X's and O's placed into nine compartments. In either case, it appears from these dictionary entries that the etymological roots of the term "tic tac" predated the simple game we all grew up with, and has retained significance within the gambling industry.

This excursion into the historical origins and current usage of the term "tic tac" suggests to me: (1) that

registrant's consumers and applicant's potential consumers (e.g., large gambling enterprises) will accord little source-indicating significant to the term "tic tac," and (2) that no one vendor of gaming machines should have a monopoly on the "tic tac" designation.

In speaking to this point, applicant argues consistently that the term "tic tac" should receive no more (and arguably less) emphasis than the other wording in these composite marks. Contrariwise, the Trademark Examining Attorney argues that the term "tic tac" is clearly the dominant term in these composite marks.[6]

As to the third word added to each mark after the "tic tac" designation, applicant argues that words like DISCO and POKER[7] are arbitrary and hence serve as the most prominent source indicating matter in this composite. By contrast, the Trademark Examining Attorney argues that the third word is less dominant – that the word "Poker" is merely descriptive and that the word "Disco" is suggestive.

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[6] The majority finds that because these marks convey a "shared 'tic-tac-toe' theme," purchasers are likely to assume a single source with "tic tac" formatives. Hence, the majority accords registrant extremely broad proprietary rights in the "tic tac" designation.

[7] After initially arguing a disclaimer was not appropriate, applicant nonetheless complied with the requirement of the Trademark Examining Attorney to disclaim the word "Poker."

Conceding that "[t]he term DISCO in the cited registered mark connotes 'discotheque' rather than a gambling game like '21' or poker," the majority herein nonetheless concludes that TIC-TAC-21 and TIC TAC POKER are likely to be confused with TIC TAC DISCO after conducting a comparison of these respective marks based upon the trilogy of appearance, sound and meaning. Based upon the stated logic, presumably the majority would also find that hypothetical marks as disparate as TIC TAC CASH, TICK-TAC-TWO, TIC TAC HOLD'EM and TIC TAC NOEL applied to electronic gaming devices would also result in a likelihood of confusion with registrant's TIC TAC DISCO.

Employing a somewhat convoluted analysis, the majority finds that applicant's marks will be "understood to refer to the theme, subject matter or object of the game depicted or featured on the gaming machines and/or the manner in which the games are played, i.e., as a combination of the games "tic-tac-toe" and, respectively, "21" (or blackjack), and poker." To be consistent, then, I assume that potential consumers of gaming machines marketed under registrant's mark, will, with the same ease, likely think of TIC TAC DISCO as a combination of tic-tac-toe and disco dancing, while forming the same commercial impression as if

the mark were TIC TAC plus any well known designation for a traditional playing card game, parlor game, etc.

I would argue that one does not need to adopt completely applicant's relative weighing of the respective elements of its composites (i.e., arguably "tic tac" should receive decidedly less emphasis than the other wording in these composite marks) to be uncomfortable with the majority's methods and results herein:

(1) As to methodology, if the first and second portions of these composite marks are accorded equal prominence, and the respective marks are all considered in their entireties, how can one find that TIC TAC DISCO has a confusingly similar overall commercial impression to TIC TAC POKER and to TIC-TAC-21?

(2) As to results, should Anchor Gaming's single registration for its TIC TAC DISCO nickel slot machines be able to preclude all other gaming machine manufacturers and/or merchants from adopting any mark containing a "Tic Tac" formative?

Accordingly, given the fact that I do not find the cited mark to be confusingly similar to applicant's marks, I would reverse the refusals of the Trademark Examining Attorney and send these marks to publication in the *Trademark Official Gazette* for potential oppositions.