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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Aruze Corporation

Serial No. 77053890

Nate A. Garhart of Coblentz, Patch, Duffy & Bass LLP for Aruze Corporation.

Brian Pino, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Hairston, Bergsman and Ritchie, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Aruze Corporation ("applicant") filed an intent-to-use application to register the mark RAISE DRAW JOKER'S WILD, shown below, for goods ultimately identified as follows:

> Video poker machines and replacement parts therefor; **slot machines** and replacement parts therefor; video slot machine and replacement parts therefor; **gaming machines** and replacement parts therefor; video gaming machines and replacement parts therefor; media storage computer software and computer software for controlling slot machines or game machines and computer software for game machines or slot machines, in Class 9. (Emphasis added).

During the prosecution of the application, the Trademark Examining Attorney required applicant to disclaim the exclusive right to use the term "Joker's Wild" on the ground that it is merely descriptive (*i.e.*, "the wording immediately tells customers that applicant offers goods and/or services that offer games in which the jokers are wild"). Accordingly, applicant disclaimed the exclusive right to use the term "Joker's Wild."

The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to cause confusion with the mark JOKERS WILD, in typed drawing format, for "Gaming machines, namely slot machines with or without video output," in Class 9.[1]

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177

[1] Registration No. 2888275, issued September 28, 2004 on the Principal Register without a claim of acquired distinctiveness.

USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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").

A. <u>The similarity or dissimilarity and nature of the goods described in the application and registration</u>.

Applicant is seeking to register its mark for, among other things, gaming machines and slot machines. The description of goods in the cited registration is "gaming machines, namely slot machines." Accordingly, the goods are identical in part. Moreover, the remaining products in applicant's description of goods (*i.e.*, video poker machines, media storage for computer software and software for slot and game machines) are otherwise related to the registrant's products.

B. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

Because the products identified in the application and the cited registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See Genesco Inc. v. Martz,* 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey,* 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

C. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co., supra.* In a particular case, any one of these means of comparison may be critical in finding the

marks to be similar. *In re White Swan Ltd.,* 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.,* 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation,* 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated,* 207 USPQ 443, 449 (TTAB 1980).

In addition, in comparing the marks, 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 unpublished,* 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 a

specific impression of the 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). In this case, the relevant public comprises casinos and other consumers who purchase and use slot machines and gaming machines.

Applicant's mark and the registered mark are similar in terms of appearance, sound, meaning and commercial impression because they share the term "Joker's Wild" (*i.e.*, applicant's mark incorporates the entire registered mark). Moreover, the manner in which applicant's mark is displayed, shown below, with the term "Raise Draw" depicted above and in larger print than "Joker's Wild," makes it appear as if "Raise Draw" is a variation of the "Joker's Wild" line or brand of gaming machines.

Applicant contends that the marks create distinct commercial impressions because the term "Joker's Wild" is merely descriptive, and thus consumers would not look to that portion of applicant's mark as a source indicator. However, despite applicant's disclaimer of the term, we find that the term "Joker's Wild" is suggestive, not merely

descriptive. However, even if the evidence of record convinced us that the term "Joker's Wild" is merely descriptive, we must still consider the term "Joker's Wild" in our likelihood of confusion analysis because it is part of the mark. *V-M Corporation v. Mayfair Sound Products, Inc.*, 480 F.2d 898, 178 USPQ 477 (477-478 (CCPA 1973) (the disclaimer of part of a mark has no legal significance in determining likelihood of confusion of the marks in their entireties); *In re Panavision, Inc.*, 183 USPQ 557, 558 (TTAB 1974) (Board must consider the applicant's mark in its entirety, even disclaimed matter). Thus, as indicated above, we believe that consumers would believe that "Raise Draw" is a variation of the "Joker's Wild" line of gaming machines.

To further support its argument that the term "Joker's Wild" is a weak term entitled to only a narrow scope of protection or exclusivity of use, applicant references Registration No. 1859277 for the mark JOKERS WILD for "casino services." The problem with this argument is two-fold. First, applicant did not include a copy of the registration.[2] The Trademark Trial and Appeal Board does

[2] Applicant first referenced the registration, without submitting a copy of it, in its request for reconsideration. Although the Examining Attorney did not object to the registration in his denial of the request for reconsideration, he did lodge an objection in his appeal brief. In view of the fact that

not take judicial notice of registrations, and the mere reference to a registration does not make it part of the record. *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). To make registrations of record, soft copies of the registrations or the complete electronic equivalent (*i.e.*, printouts or electronic copies of the registrations taken from the electronic search records of the USPTO) must be submitted. *Racciopp*i *v. Apogee Inc.,* 47 USPQ2d 1368, 1370 (TTAB 1998); *In re Volvo Cars of North America Inc.,* 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992).

Second, even if applicant had properly submitted the third-party registration into evidence, the third-party registration would be entitled to only limited probative value. The registration is not evidence that the mark is in use. Accordingly, it is not proof that consumers are familiar with the mark so as to be accustomed to the

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applicant does not have an opportunity to respond to the denial of its request for reconsideration if submitted, as here, at the end of the allotted six month period, the Examining Attorney did not waive his objection when he failed to raise it in the denial of applicant's request for reconsideration. Moreover, as discussed below, even if we considered the registration, it would not change our opinion.

existence of the same mark in the marketplace. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 462-463 (CCPA 1973); *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Thus, applicant's proffered third-party registration simply indicates that the U.S. Patent and Trademark Office has registered one other JOKERS WILD service mark in connection with casino services. Such evidence fails to establish that the relevant public has been exposed to third-party use of similar marks on similar goods or services, such that consumers would distinguish applicant's mark from the mark in the cited registration.

Third-party registrations may be used like dictionary definitions to show that a term has significance in a particular field. In this regard, the third-party registration, as well as the application and the cited registration, suggest that "Joker's Wild" means that that jokers in the game are wildcards. However, even if we were to conclude that registrant's mark is entitled to only a narrow scope of protection, the registered mark is still entitled to prevent the registration of a highly similar mark, as in this case, for identical products. *See In re Farah Manufacturing Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

D. Balancing the factors.

In view of the facts that the marks are similar and the goods are identical in part, and that we must presume that the goods move in the same channels of trade and are sold to the same classes of consumers, we find that applicant's registration of the mark RAISEDRAW JOKER'S WILD and design is likely to cause confusion with the registered mark JOKERS WILD.

Decision: The refusal to register is affirmed.