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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WMS Gaming Inc.

Serial No. 78278183

Steven P. Macaluso of WMS Gaming Inc. for WMS Gaming Inc.

Sonya B. Stephens, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Hairston, Grendel and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

WMS Gaming Inc. filed an intent-to-use application to register the mark CASCADING REELS for "currency and credit operated slot machines and gaming devices, namely, gaming machines for use in gaming establishments" (hereinafter "slot machines").¹ Registration was refused on the ground

¹ Application Serial No. 78278183, filed July 24, 2003. The application was published for opposition on March 24, 2004. The Notice of Allowance issued on July 6, 2004. On September 2, 2004, applicant filed a statement of use asserting September 16, 2003 as its date of first use anywhere and first use in commerce.

that CASCADING REELS for slot machines is merely descriptive.² Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1). When the refusal was made final, applicant appealed. Both the applicant and the examining attorney filed briefs.

We affirm.

The examining attorney contends that the mark is merely descriptive because CASCADING REELS refers to a technology featured in applicant's slot machines in which

² The registration was refused as being merely descriptive for the first time after the review of the statement of use. TMEP §1102.01 provides, so far as pertinent, as follows:

To the fullest extent possible, the examining attorney will examine an intent-to-use application for registrability under Trademark Act §§1051 and 1052(a), (b), (c), (d), and (e) . . . That is, the examining attorney must make all appropriate refusals with respect to issues such as ownership, deceptiveness, mere descriptiveness, geographic significance, and surname significance. [Citations omitted]. The examining attorney cannot issue a requirement or refusal under these sections during examination of the statement of use if the issue could or should have been raised during initial examination, unless the failure to issue the refusal or requirement would be a clear error.

Our determination on appeal is limited to the merits of the underlying refusal, not whether the failure to make the descriptiveness refusal was clear error. *In re Sambado & Son Inc.*, 45 UPSQ2d 1312, 1314-1315 (TTAB 1997); TMEP §1109.08. The Examination Organization makes the determination of "clear error." That determination is reviewable on petition to the Commissioner. *Id.* Applicant could have filed a petition after the issuance of the final refusal to determine whether the descriptiveness refusal after review of the statement of use was "clear error." However, applicant failed to do so, and we will not, on this appeal, review the examining attorney's application of the "clear error" standard.

symbols appearing in the game's "reels" disappear after a winning combination has been tallied and are replaced by new symbols which "cascade" down from the top of the screen. The examining attorney argues that the symbols are displayed on "reels" which "cascade" down the screen and, therefore, CASCADING REELS immediately describes a characteristic, function and feature of the slot machines. The examining attorney supported her refusal with the following evidence:

1. A web page from applicant's website describing KABOOM!, a five-reel video slot machine with the CASCADING REELS feature (specifically listed as a feature):

In place of traditional reel spins, symbols drop down into the reels from above. The 1st reel drops first, then the 2nd, and so on until all 5 reels have dropped the symbols. Once the symbols have dropped, all winning combinations are highlighted and paid as normal. Then the added feature kicks in! Each symbol that takes part in a winning combination disappears, and the symbols above them drop down to take their place. New symbols drop onto the screen to fill any gaps. If any new winning combinations are formed because of this shift, they are banged-up into the pay meter and awarded the player. This process continues as long as the drop-down symbols create winning combinations.

2. An excerpt from the Southern Gaming and Destinations website (www.impactimagination.com) regarding applicant's ALL THAT GLITTERS 5-reel video slot machine:

This machine features WMS Gaming's CASCADING REELS feature where, instead of traditional reel spins, jewel symbols will cascade down onto the reels from above.

3. Web pages from applicant's website describing various slot machines by listing "5RV cascading reels" or "Cascading reels" as a feature of the slot machine.

4. A press release posted on applicant's website with the following description of the CASCADING REELS game:

[A] new experimental game from WMS, All That Glitters(TM) features WMS' new Cascading Reels(TM) bonus element. This 5-reel game allows players to win additional pays as common reel symbols disappear after the initial pay with a second pay on new winning combinations.³

5. A series of articles dated November, 2004, posted on www.strictlyslots.com, entitled *Video Poker Optimum Play* by Dan Paymar that describes CASCADING REELS as follows:

[W]hen a winning combination hits, the reel symbols disappear and new symbols cascade down from the top of the screen to refresh the grid of symbols.

³ The examining attorney posted this press release a second time from the ClariNet website.

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6. A posting from the September 13, 2005 Steve's Everything Las Vegas website (www.everythinglv.com) discussing applicant's All That Glitters slot machine and the CASCADING REELS feature as follows:

Hitting the spin button does not display the usual whirling reels, but a blank opening from which the sparkling jewels cascade from the top of the screen into reel positions.

7. A posting from the November 30, 2005 Best Online Casinos website (<http://pokermachine.com/managearticle.asp?c=10&a=2242>)

discussing the introduction of "cascading reels":

A couple of years ago it [WMS] introduced the "cascading reels" concept of video slot play whereby symbols fall into place from the top of the screen instead of landing in place as the reels stop one by one left to right.

8. A series of dictionary definitions for the word "Cascade." A representative definition from the MSN.ENCARTA dictionary is the noun a "downward flow of something" or the intransitive verb to "move on to the next thing: to move on to others in succession."

9. A definition of "Reel" from the gambling glossary from the www.winyourwager.com website: "a wheel inside a slot machine window on which the slot machine symbols are

printed. The number of reels per slot machine may vary but are usually three."

Applicant argues that CASCADING REELS for slot machines is not merely descriptive because applicant's slot machines do not have reels and, therefore, do not have reels that "cascade" or fall in any way. Applicant submitted screen shots from its slot machines to illustrate how they work.

To explain, many of Applicant's goods are video slot machines that imitate spinning mechanical slot machine reels by means of computer graphics. However, unlike many of Applicant's other video slot machines, the goods bearing Applicant's Mark are unique because their graphics *do not* imitate spinning reels. . . In this way, instead of imitating reels (i.e. spinning cylinders), Applicant's at-issue machines utilize columns of symbols where empty voids are left when symbols disappear, causing the symbols residing immediately above the dissolved symbols to fall into the empty voids in the columns. Importantly, all symbols residing in column spaces below dissolved symbols do not drop, fall, cascade or move in any way, they remain stationary.

(Applicant's Brief, p. 7). In other words, only the symbols "cascade," not the reels. "Therefore, had Applicant branded its machines as 'Cascading Symbols,' 'Falling Symbols,' or 'Disappearing Symbols,' such names might, arguably, have had some descriptive significance."

(Applicant's Brief, p. 10). Applicant concludes that its use of the term "Reel" suggests a general style of slot machine (*i.e.*, a five-reel video machine) or the visual style of play.⁴

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods or services with which it is used, or intended to be used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used, or is intended to be used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the goods or services are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537,

⁴ Applicant submitted the Declaration of Robert Bone, applicant's Vice President of Marketing, to explain that applicant refers to CASCADING REELS as a five-reel video machine to provide a point of reference for its customers. In this way, the customers can analogize or understand CASCADING REELS video slot machines as an alternative to older slot machines. (Bone Dec., ¶8).

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1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 UPSQ 365, 366 (TTAB 1985).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See, *In re Tower Tech, Inc., supra* (SMARTTOWER merely descriptive of commercial and industrial cooking towers); *In re Sun Microsystems Inc.*, 59 USPQ 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of new information services in the food processing industry).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive. *In re Tennis in the Round, Inc.*, 199 USPQ

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496, 497 (TTAB 1978). *See also, In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

In many instances, such as this case, the line between descriptive and suggestive marks is not clear. Determining whether a mark is merely descriptive or suggestive may require the drawing of fine lines similar to making distinctions among many shades of gray. In any given situation, this process may be hazy, subjective, and difficult to articulate. Accordingly, doubts as to registrability are resolved in favor of applicants. *In re American Standard Inc.*, 223 USPQ 353, 355 (TTAB 1984); *In re Micro Instrument Corp.*, 222 USPQ 252, 255 (TTAB 1984); *In re The Officers' Organization*, 221 USPQ 184, 186 (TTAB 1983).

In determining whether a mark is merely descriptive, it is necessary to understand the products that the mark purportedly describes. We have gleaned the following background information from The Best Online Casinos, the Casino City Times,⁵ the Win Your Wager.com online gambling glossary websites, and the Robert Bone Declaration:⁶

⁵ <http://brokpoo.casinocitytime.com/articles/272442.html>.

⁶ www.winyourwager.com/gambling_glossary.html#r.

1. There are hundreds of different types and variations of slot machines (e.g., single line, three line, 3 or 5 reel, progressives, bonus games, etc.).
2. Three reel slot machines are the classic slot machines.
3. A "reel" is a wheel inside a slot machine window on which the slot machine symbols are printed.
4. Many slot machines also have two or more horizontal rows across the vertical reels. The additional rows, above and below the payout row or pay line, allow players to see how close they came to winning.
5. A slot machine can have one or more pay lines on its reels. The pay line is where the winning combinations of symbols line up.
6. On the classic slot machines, the pay line is the center row of symbols across the vertical reels.
7. If a machine has more than one pay line, a player can activate additional pay lines by increasing the bet.
8. The spinning reel play action and the sequential left to right stops of video slot games are an illusion created to stimulate the player's senses and add an additional element of intrigue.
9. The columns on video slot machines are referred to as "reels" to provide a point of reference to customers and players.

We find that CASCADING REELS is merely descriptive of applicant's slot machines because it directly and immediately identifies a feature of the slot machine games: that is, the reel symbols cascade (or appear to cascade) into the pay lines.

The fact that applicant's slot machines do not have actual mechanical reels does not eliminate the descriptiveness of the word "Reels" because the video displays are representations of reels. In fact, applicant refers to the video displays as reels so that its customers and players have a point of reference or comparison. (Bone Dec., ¶8). In its KABOOM! web page, applicant states that "In place of traditional reels, the symbols drop down into the reels from above." In other words, the video graphics replace the reels. In addition, many video slot machines simulate the spinning action of the mechanical reel. (Casino City Times web page). Accordingly, when used in connection with slot machines, the term "reels" encompasses both mechanical reels and simulated video reels.

The word "Cascade" has the following meanings:

1. "downward flow of something" (MSN.Encarta Dictionary);
2. "move on to the next thing: to move on to others in succession • If it is not claimed, the jackpot will cascade down to the holder of the next numbers drawn"; (MSN.Encarta Dictionary);
3. "to fall from one level to the next."
(www.wordsmyth.net).

Applicant's description of how the KABOOM! slot machine works set forth below encompasses the preceding

definitions, particularly "to fall from one level to the next."

In the place of traditional wheel spins, **the symbols drop down into the reels from above**. The 1st reel drops first, then the 2nd, and so on until all 5 reels have dropped symbols. Once the symbols have all dropped, all winning combinations are highlighted and paid as normal. Then the added feature kicks in! Each symbol that takes part in a winning combination disappears, and **the symbols above them drop down to take their place**. (Emphasis added).

When used in connection with slot machines, the term CASCADING REELS describes a significant feature of the slot machine game (*i.e.*, the reels or the reel symbols drop down or cascade). The combination of the two words "Cascading" and "Reels" keep their ordinary meaning. They do not form a new or incongruous meaning.

The applicant's own promotional material illustrates the descriptive character of the mark. In its web pages, applicant refers to "Cascading Reels" as a feature or part of the game. For example, in the KABOOM! web page, the game features are listed as follows:

Kaboom™!

- Five-reel video slot available in 20 line, 20/40/100/180/200/400 coin versions
- *Cascading Reels™* Feature
- Built on *CPU-NXT™* technology

In other web pages, "Cascading Reels" is displayed in the features section as "Cascading reels" (no italics, no ™) or "5RV cascading reels." Because "Cascading Reels" is listed as one of several features, the impact of that use will be perceived as a descriptive use, rather than as a trademark.⁷

The web pages with reviews of slot machines submitted by the examining attorney and noted above evidence the descriptive nature of the term CASCADING REELS because they demonstrate that the writers understand the concept of cascading reels vis-à-vis a slot machine. Those web pages include the following excerpts:

[i]nstead of traditional wheel spins, jewel symbols will cascade down on the reels from above. . . The cascade will repeat until there are not any winning combinations formed.

[n]ew symbols cascade down from the stop of the screen to refresh the grid of symbols.

Hitting the spin button does not display the usual whirling wheels, but

⁷ Use of the superscript ™ does not make unregistrable matter into a trademark. *In re Remington Products Inc.*, 3 UPSQ2d 1714, 1715 (TTAB 1987).

a blank opening from which the sparkling jewels cascade from the top of the screen into reel positions.

Applicant's argument by analogy that if the application for the mark TUMBLING REELS for gaming machines⁸ is not descriptive and has been approved for publication, then CASCADING REELS is not descriptive and should be approved for publication is unavailing. We must decide each case on its own merits. Even if some other applications with characteristics similar to CASCADING REELS have been approved for publication, or registered, the allowance of such applications does not bind the Board. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Moreover, the fact that applicant is the first or only user of the term CASCADING REELS, this is does not justify registration of the term where the only significance projected by the term is merely descriptive, as we find to be the case here. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

Upon reviewing all of the evidence, we find that CASCADING REELS used in connection with slot machines is merely descriptive. The words "Cascading" and "Reels"

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describe features of the slot machine game (*i.e.*, the game depicts reel symbols that cascade). The combination of the words does not create an inherently distinctive combination because both words keep their commonly understood meaning. Applicant's own descriptive use of CASCADING REELS and third-party reviews of the slot machine games that use the words "Cascade" and "Reels" in their ordinary sense to describe the slot machine games, persuade us that the mark is merely descriptive.

Decision: The refusal to register is affirmed.

⁸ Application Serial No. 78757454, filed November 18, 2005, under Section 1(b). The examining attorney required a disclaimer of the word "Reels."