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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cordaire & Partners Company Inc.

Serial Nos. 78369090 and 78369803

Kenneth F. Florek of Hedman & Costigan for applicant.

Kelly A. Choe and Kristin M. Dahling, Trademark Examining Attorneys, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Quinn, Hairston and Drost, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Cordaire & Partners Company Inc. to register the mark MVP for "online betting services"¹ in Class 36, and MVP SPORTSBOOK ("SPORTSBOOK" disclaimed) for "Internet betting services"² in Class 36.

¹ Application Serial No. 78369090, filed February 17, 2004, alleging first use anywhere in 1998 and first use in commerce in March 1999. Ms. Choe handled this application in its entirety.

² Application Serial No. 78369803, filed February 17, 2004, alleging first use anywhere in 1998 and first use in commerce in March 1999. Ms. Choe handled the examination of this application; the only action taken by Ms. Dahling was the writing of the appeal brief.

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The trademark examining attorney³ refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's marks MVP and MVP SPORTSBOOK, when used in connection with applicant's services,⁴ so resemble the previously registered mark MVP for "casino services offered to preferred customers identified by special identification cards"⁵ in Class 41 as to be likely to cause confusion.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs.

Inasmuch as the appeals involve common issues of law and fact, the Board is consolidating the appeals. The Board herein issues a single opinion in these consolidated appeals.

Applicant admits that each of the involved marks include MVP, but contends that the cited mark is weak. In this connection, applicant has relied upon a printout of a summary from the USPTO's TESS database that lists third-party registrations and applications of MVP and MVP formative marks. Applicant further points out that MVP is a common abbreviation for "most valuable player."

³ Although two examining attorneys are involved in this appeal, the opinion will refer to them in the singular.

⁴ In this decision, "online betting services" and "Internet betting services" are used interchangeably.

⁵ Registration No. 1572506, issued December 19, 1989; renewed.

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Applicant also contends that the services are different, asserting that its online betting services are accessed from the comfort and privacy of one's own home, while registrant's services require a physical presence to show an identification card. In this regard, applicant introduced two exhibits to show that registrant's services are directed to complimentary services such as discounted hotel rooms, food and beverage services, and other entertainment offerings, including sporting events, musical concerts or the theatre, all requiring a physical presence. Applicant also contends that registrant is unlikely to expand into online betting services and, in support of this contention, introduced an article from a printed publication and a press release. According to applicant, purchasers of the respective services are sophisticated who would not avail themselves of the services on impulse. Applicant also claims that it adopted its mark in good faith, and that there has been no actual confusion between the marks during a six-year period of contemporaneous use.

The examining attorney maintains that the MVP marks are identical, and that the MVP and MVP SPORTSBOOK marks are substantially similar. Further, according to the examining attorney, the services are related in that online betting and casino services both involve gambling. In

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addition, the examining attorney contends that traditional casino games, as well as wagering on sporting events, are often offered online and, in support of this contention, she has submitted evidence retrieved from the websites of third parties.

Before turning to the merits of the appeal, there are evidentiary matters requiring our attention. Applicant submitted evidence with its reply brief in application Serial No. 78369090; applicant submitted the same evidence with its appeal brief in application Serial No. 78369803.

Applicant, in connection with a request for reconsideration in each application, filed a printout of third-party registrations and applications of MVP and MVP formative marks taken from the USPTO's TESS database. The examining attorney, in denying the request for reconsideration, made no mention of this evidence. In its brief in application Serial No. 78369090, applicant, in arguing that the cited mark is weak, referred to the third-party registrations and applications. The examining attorney, in her brief, objected to the evidence, contending that a mere listing of third-party registrations and applications, as shown in the TESS printout, is insufficient to make these official records part of the record on appeal. Applicant, in its reply brief, argued

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against the objection. In addition, applicant accompanied its reply brief with copies of "a representative sample" of the registrations listed in the TESS printout. Applicant also submitted, for the first time with its reply brief, excerpts from registrant's website (exhibit G), and information regarding ownership of the cited registration (exhibit H--an excerpt from registrant's website; and exhibit I--assignment information for the cited registration retrieved from the Office's database).

Applicant, as noted above, accompanied its appeal brief in application Serial No. 78369803 with the same exhibits that it filed with its reply brief in application Serial No. 78369090.

With respect to the third-party registration evidence, TBMP § 1207.03 (2d ed. rev. 2004) provides as follows:

Copies of third-party registrations that are submitted with an applicant's brief may be considered in certain circumstances, even if the examining attorney objects to the registrations or does not discuss them in the examining attorney's brief. If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise applicant that a listing is insufficient to make such registrations of record at a point when the applicant could cure the insufficiency, the

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examining attorney will be deemed to have waived any objection as to improper form.

Thus, the examining attorney, by failing to apprise applicant of the deficient introduction when she denied the request for reconsideration, is deemed to have waived the objection raised in her brief. In view of the above, we have considered both the TESS printout, as well as the copies of certain of the listed registrations.

The excerpts from registrant's website, submitted for the first time by applicant at the briefing stage, are untimely. Trademark Rule 2.142(d). Accordingly, this evidence has not been considered. We hasten to add, however, that even if considered, this evidence would not change the outcome of this appeal.

We have considered the assignment information about the cited registration inasmuch as it was retrieved from the automated records of the Assignment Branch and merely updates ownership information about the cited registration.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the 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

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1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Insofar as applicant's and registrant's MVP marks are concerned, they are identical in every respect. That is to say, the marks are identical in appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Use of identical marks is a fact that "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984); see also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

We also find that applicant's MVP SPORTSBOOK mark and registrant's MVP mark are similar. In comparing the marks, we find that MVP is the dominant element of applicant's mark, and accordingly it is entitled to more weight in our

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analysis. The word "sports book" is merely descriptive for applicant's services, and has been properly disclaimed. The mere telescoping of the word in applicant's mark MVP SPORTSBOOK does not detract from its merely descriptive nature. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The MVP portion of applicant's mark is identical to the entirety of registrant's mark. The mere addition of a term (especially when it is merely descriptive as in case of "SPORTSBOOK") to a registered mark does not avoid a similarity between the marks. See In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); In re El Torito Restaurants Inc., 9 USPQ2d 2002 (TTAB 1988); and In re Corning Glass Works, 229 USPQ 65 (TTAB 1985). The marks MVP and MVP SPORTSBOOK, when considered in their entirety, are similar in sound, appearance, meaning and commercial impression.

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We next turn to a consideration of the services. We note, at the outset of considering this du Pont factor, that the greater the degree of similarity between applicant's mark and the cited registered mark, the lesser the degree of similarity between applicant's services and registrant's services that is required to support a finding of likelihood of confusion. In re Opus One Inc., 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks are the same or nearly so, as in this case, it is only necessary that there be a viable relationship between the services in order to support a finding of likelihood of confusion. In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

With respect to the services, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services identified in the cited registration. In re Shell Oil Co., 26 USPQ2d at 1690 n. 4; and Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Where the services in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the

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classes of purchasers, it is presumed that in scope the recitation of services encompasses not only all the services of the nature and type described therein, but that the identified services are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Applicant's "online betting services" and "Internet betting services," and registrant's "casino services offered to preferred customers identified by special identification cards" are related services in the gambling field. Registrant's services are broadly identified, and registrant's casino services are presumed to encompass all of the normal types of games of chance, including poker, blackjack and roulette, as well as handling bets on sporting events. As shown by the Internet evidence furnished by the examining attorney, casino games such as those mentioned are commonly offered and played via online betting websites. As for example, "Island Casino, one of the first pioneers in the Online Casino and Sports Book Industry, offers Las Vegas style Casino Games." (www.islandcasino.com); and "Don't gamble with Casinos. Gamble at Casinos. Play over 148 casino games." (www.secure-online-casinos.com); "All you are looking for

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you will find here, best online casino, betting and sports.

Online Casino Entertainment! Here you find Video Poker, Blackjack, Slots, Online Casino bonuses and comps."

(www.casino-betting-sports.com); and "Bubba's Casino features casino-style games such as Blackjack and Roulette and a sportsbook with real-time betting lines from Las Vegas and Europe. Bubba's Casino services provided by Largest Public Internet Gaming Company in the World."

(www.bubbascasino.com). The Internet evidence also shows that gamblers have many options in betting on a wide variety of sporting events. Applicant itself offers "casino" games for gambling, as well as betting on sporting events. Registrant's recitation of services does not include any limitation to a physical location. Further, registrant's recitation cannot be limited, as urged by applicant, to complementary services such as hotel rooms, food and beverage services, or other entertainment offerings.

In addition, at least two of the online gambling websites highlighted by the examining attorney would appear to have a type of rewards program for its best or "preferred" customers: "Be a Bubba Buddy and get a 10% Bonus!" (www.bubbascasino.com); and "Online Casino bonuses and comps." (www.casino-betting-sports.com).

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The relatedness of the services weighs in favor of the affirmance of the refusal.

Applicant, relying on certain materials about registrant's business activities, contends that it is unlikely that registrant will engage in Internet gambling operations. As discussed above, the materials were untimely submitted and, thus, do not form part of the appeal record. In any event, applicant's attempt to essentially limit the scope of registrant's services is to no avail. An applicant may not restrict the scope of the services covered in the cited registration by argument or extrinsic evidence. In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986). Applicant further contends that registrant has been phasing out the special identification cards described in registrant's recitation of services. To the extent that applicant is suggesting that the registered mark has been abandoned, no consideration has been given to applicant's argument in this specific regard. Applicant's allegation constitutes an impermissible collateral attack on registrant's registration. Section 7(b) of the Trademark Act provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive

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right to use the mark in connection with the goods or services identified in the certificate. During ex parte prosecution, including an ex parte appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., a registrant's nonuse of the mark). In re Dixie Restaurants, 41 USPQ2d at 1534; and In re Peebles Inc., 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992). See TMEP § 1207.01(d)(iv) (4th ed. 2004).

Applicant claims, without any supporting evidence, that purchasers of the involved services are sophisticated. More specifically, applicant claims that in order to utilize registrant's services, "a consumer must physically travel to a specific location (which could conceivably be hundreds of miles), sign up to become a 'preferred customer' and spend time at that specific casino rather than any other casino." Further, applicant contends, "since the 'preferred' status signals a sophisticated customer, the customer is knowledgeable in the field of gaming and will have no difficulty distinguishing between the two services." According to applicant, in order to utilize its services, "one must log onto the Internet, log onto applicant's website, and create an account before playing." In either case, applicant claims that the services are available only after going through numerous

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steps, and that the purchase of either registrant's or applicant's services "can hardly be considered the equivalent of purchasing a pack of gum." (Brief in application Serial No. 78369090, pp. 7-8).

As with most of applicant's other arguments, it has failed to provide any evidence to support the proposition that purchasers of the services identified in either the applications or the registration are sophisticated. Accordingly, we have no reason to assume that the potential purchasers could not include any individual interested in gambling, a rather large segment of the population, including persons of varying levels of sophistication. In any event, even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving identical or very similar marks and closely related services. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."]. See also *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

The third-party registration evidence does not persuade us that confusion is not likely. With respect to

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the TESS printout, this list does not show the goods and/or services covered by the registrations and applications. Therefore, the list, standing by itself, has extremely limited probative value, since we cannot determine whether the marks are for services similar to those of applicant and registrant.⁶ See TBMP § 1208.02 (2d ed. rev. 2004) ["The Board will not consider more than the information provided by applicant. Thus, if applicant has provided only a list of registration numbers and marks, the list will have very limited probative value."]. As indicated above, however, applicant submitted copies of certain of the third-party registrations listed in the TESS printout.

The third-party registrations are not evidence of use of the marks shown therein. Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks*,

⁶ In this connection, even if complete copies of these third-party registrations had been submitted, any registrations covering services far removed from the services of applicant and registrant would be irrelevant to the present likelihood of confusion analysis. *Conde Nast Publications, Inc. v. American Greetings Corp.*, 329 F.2d 1012, 141 USPQ 249, 252 (CCPA 1964). Further, third-party applications, even if copies had been furnished, have no probative value other than as evidence that the applications were filed. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

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Inc. v. Franklin Mint Corp., 216 USPQ 989 (TTAB 1982). We should add that it would appear that registrant's and applicant's marks are the only ones for services in the gambling field (although, admittedly, one of the registrations covers lottery services). In any event, even if we were to find, as applicant urges, that registrant's mark is weak and entitled to a narrow scope of protection, the scope is still broad enough to prevent the registration of an identical mark and a similar mark for related services. See *In re Farah Mfg. Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

The absence of actual confusion, as reported by applicant's attorney, is of little moment. There is no evidence that there has been an opportunity for confusion to occur between the marks. Furthermore, particularly in an ex parte proceeding, "uncorroborated statements of no known instances of actual confusion are of little evidentiary value." *In re Majestic Drilling Co.*, 65 USPQ2d at 1205. See also *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). In any event, it is unnecessary to show actual confusion in establishing a likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

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Likewise, applicant's good faith adoption is of little consequence. Good faith adoption does not necessarily mean that confusion is not likely. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Hydra Mac, Inc. v. Mack Trucks, Inc.*, 507 F.2d 1399, 184 USPQ 351 (CCPA 1975); and *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).

We conclude that consumers familiar with registrant's "casino services offered to preferred customers identified by special identification cards" rendered under its mark MVP would be likely to believe, upon encountering applicant's "online betting services" and "Internet betting services" offered under the marks MVP and MVP SPORTSBOOK respectively, that the services originated with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re *Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re *Martin's Famous Pastry Shoppe, Inc.*, 223 USPQ at 1290.

Decision: The refusal to register is affirmed.