THIS DECISION IS NOT
A PRECEDENT
OF THE TTAB

Mailed: March 3, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Imagination Holdings Pty., Ltd.

Serial No. 78635569

Vincent M. Amberly of Litman Law Offices, Ltd. for Imagination Holdings Pty., Ltd.

Maria-Victoria Suarez, Trademark Examining Attorney, Law Office 102 (Karen Strzyz, Managing Attorney).

Before Rogers, Mermelstein, and Wellington, Administrative Trademark Judges.

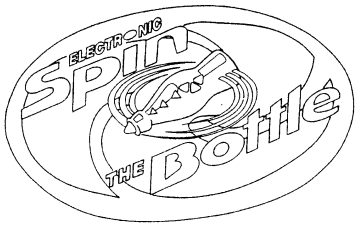
Opinion by Mermelstein, Administrative Trademark Judge:

Imagination Holdings Pty., Ltd., seeks registration of the mark SPIN THE BOTTLE (standard characters) on the Principal Register for

> DVDs and CD-ROMS containing games, board games, interactive games, video games, computer games, game shows, and games containing interactive questions and answers; all the foregoing containing instructions; video games from television shows, cartoon and films; multimedia games that may be played via a DVD machine, computer and television or monitor; software, namely multimedia software recorded on DVD or CD-ROM to provide the above functions.

International Class 9.

The examining attorney issued a final refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the marks in the registrations set out below that it would, if used on or in connection with the identified goods, be likely to cause confusion.

Registration	Mark	Goods/Services
2267325[1]	SPIN THE BOTTLE (typed mark)	Entertainment in the nature of ongoing television programs featuring musical, variety and general interest segments dealing with events and personalities. International Class 41.
2669446[2]		Electrical and mechanical toys; action games; and puzzles. International Class 28. ELECTRONIC and SPIN THE BOTTLE disclaimed

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm.

I. Applicable Law

We base our determination under Trademark Act § 2(d) on an analysis of all of the probative evidence of record bearing on the issue of likelihood of confusion. *See In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *Palm Bay Imports, Inc. v. Veuve Clicquot*

[1] Registered August 3, 1999, to Spin the Bottle, Inc. Affidavits under Trademark Act §§ 8 & 15 accepted and acknowledged.
[2] Registered December 31, 2002, and currently owned by Character Games, Ltd.

Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rest., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 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); *In re Azteca Restaurant Enter., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

II. Record on Appeal

The examining attorney submitted the records of nineteen third-party registrations based on use in commerce, to "suggest that the goods and/or services listed therein ... are of a kind that may emanate from a single source."

Applicant submitted the following evidence:

- Search result lists from Google and MSN search engines revealing web sites that include the phrase "spin the bottle." Applicant has submitted the first ten of "about 615,000" entries from Google and the first eleven of "752,492" entries from MSN.

- The declaration of David P. Johnson, an employee in the offices of applicant's counsel. Mr. Johnson recounts his efforts (including two hours of Internet research) to learn whether the mark in the '325 Registration is actually in use. Attached to the declaration were the following:

  - Specimens submitted with the cited registrant's Trademark Act §§ 8 & 15 filings;

  - The results page from a "Hoovers" report returning information allegedly concerning the cited registrant, indicating that it did business in New York under the trade name Tad2000;

  - A reference on AskMen.com stating that "SpinTheBottle.com is a cool interactive site that'll keep you entertained with wacky features."

  - A Wikipedia article which, according to Mr. Johnson, indicates that the cited registrant created a television show (airing in Canada and Europe) called "*Pop-Up Video*." (While we have examined this page carefully, the Board is unable to discern any reference to the registrant on this exhibit.)

  - Articles from WINDU.com and www.thefutoncritic.com purporting to refer to the cited registrant or its principals. (The Board is unable to find a reference to the registrant in the first article; the second contains the reference quoted below.)

    > The music channel is set to go ahead with the series, a pseudo-sequel to the networks popular "Pop-Up Video" series. Woody Thompson and his Spin the Bottle production company is behind the project, which is set to roll out in the spring or early summer.

III. Preliminary Matter

Applicant suggests that the owner of the '325 Registration never used (or is not currently using) its registered mark, and that the registrant's Trademark Act

§ 8 filing was defective. Applicant urges that the refusal should be reversed, "given that doubt exists in the record as to the use of [Registration No. 2267325] in regard to television services."

Contrary to applicant's argument, an examination of the validity of the cited registration or of the registrant's use of its mark lies well beyond the scope of this appeal. By statute, an issued registration is

> prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate....

Trademark Act § 7(b).

It is long-settled that an attack on the validity of a registration will not be heard in an *ex parte* proceeding, in which the owner of the cited registration has no right to appear. *See, e.g., Dixie Rest.*, 41 USPQ2d at 1534-35 (Fed. Cir. 1997); *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971); *In re Pollio Dairy Prod. Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988). The examining attorney was correct to disregard these arguments, and we have too.

IV. Likelihood of Confusion

We consider the question of likelihood of confusion with respect to each of the cited registrations.

A. Registration No. 2267325

1. Similarity of the Marks

The marks at issue with respect to the '325 Registration consist of the identical words SPIN THE BOTTLE. Moreover, both marks are registered without respect to any particular typeface, stylization, or color. Accordingly, we must consider the marks to be identical in every respect. *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971); *Jockey Int'l Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992).

Applicant argues that both cited registrants' marks are weak, relying on its Google and MSN searches for "spin the bottle." We agree with the examining attorney, however, that result summaries from search engines are of very little probative value. They do not necessarily reflect the way a term is used on the webpage itself, nor do they show use of a particular term in context.[3] *In re*

[3] Further, it is quite possible that at least some of the displayed hits refer to (or are owned by) the '325 Registrant. *E.g.*, "Spin the Bottle - Cast, Crew, Reviews, Plot Summary...." us.imdb.com/title?0131596; "Spin The Bottle" www.spinthebottle.com. But without further examination of the webpage itself, even this cannot be determined.

Bayer Aktiengesellschaft, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002). This case is no exception; most of the references on the Google and MSN results lists include just a few words in which the term is embedded, and some offer no words purportedly appearing on the web page. And as the examining attorney notes, just because a term is often used does not demonstrate that the mark is weak in *this* context.

The identical marks at issue is a factor which strongly supports the refusal to register with respect to the '325 Registration. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

2. Similarity of the Goods and Services

We begin our analysis of the respective goods and services with the premise that, because applicant's mark is identical to that in the '325 Registration, the extent to which the applicant's and registrant's goods and services must be similar or related to support a finding of likelihood of confusion with respect to that registration is lessened. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). It is only necessary that there be a viable relationship between the two to support a finding of

likelihood of confusion. *See In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Further, our analysis is limited to the goods or services set out in the application and those in the cited registration. Where those goods or services are identified broadly, we must construe them as such, despite any extrinsic evidence purporting to show that the applicant or registrant is engaged in different or more limited activities than would be covered by its registration. *See, e.g., Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Linkvest S.A.,* 24 USPQ2d 1716, 1717 (TTAB 1992).

In the case at bar, applicant identifies its goods as:

> DVDs and CD-ROMS containing games, board games, interactive games, video games, computer games, game shows, and games containing interactive questions and answers; all the foregoing containing instructions; video games from television shows, cartoon and films; multimedia games that may be played via a DVD machine, computer and television or monitor; software, namely multimedia software recorded on DVD or CD-ROM to provide the above functions.

The cited registration recites entertainment services in the form of television programs, specifically featuring musical, variety and general interest segments dealing with events and personalities.

We find that applicant's goods and the '325 Registrant's services are significantly related, at least in part. For instance, applicant's goods include "DVDs and CD-ROMs containing ... computer games, game shows, ... games containing interactive questions and answers...; [and] video games from television shows," while the cited registrant provides musical, variety, and general interest "television programs." Although the cited registration does not specifically include game shows, we find that consumers would nonetheless be likely to believe that recordings of game shows and video games from television shows on the one hand and musical, variety, and general interest television shows on the other, emanate from or are sponsored by a common source.

Our conclusion is further buttressed by the examining attorney's evidence of several registrations indicating the offering of both computer games and television programs and production under the same mark. Third-party registrations which individually cover a number of different items and which are based on use in commerce may serve to suggest that the listed goods are of a type that may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd* No. 88-1444 (Fed. Cir.

Nov. 14, 1988). We find the following registrations relevant here:

Reg. No.	Mark	Class	Goods/Services
3006625	DARK AGE OF CAMELOT: CATACOMBS	9	game software...; computer game cartridges; computer game disks; ... video game cassettes
		41	production and distribution of motion pictures and television programs; entertainment in the nature of on-going television programs in the field of ... entertainment
2557042	RUTHLESS.COM	9	computer game cartridges, computer game programs; video game cartridges, video game programs
		41	Entertainment in the nature of on-going television shows featuring action/adventure programs, ... television show production ....
3007341	JUDGE DREDD	9	Video game discs, cartridges, software, tape cassettes and electronic games programs; ... computer game programs
		41	Production of films for cinema, television and DVD
2886015	DUALSTAR	9	Computer software for video games and computer games; video game cartridges and disks
		41	Production of and distribution of motion pictures, films, television shows; .... production of videotapes

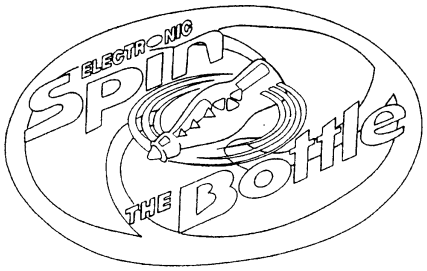
These registrations tend to suggest that applicant's goods and the services in the '325 Registration are of a type which can and do emanate from a common source.

In light of the identical marks at issue, consumers are likely to assume that the goods and services involved here share a common source or sponsorship, and we find that confusion is likely with respect to the '325 Registration.

B. Registration No. 2669446

1. Similarity of the Marks

The '446 Registration is for the words ELECTRONIC SPIN THE BOTTLE as incorporated into the following design:



The words SPIN and BOTTLE dominate this mark; they are visually larger than either the image of the spinning bottle or the words ELECTRONIC and THE. Moreover, the drawing image of a spinning bottle clearly reinforces the literal phrase SPIN THE BOTTLE, rather than providing a distinguishing commercial impression. Finally, the literal portion of the mark is likely to be the most significant to the relevant purchasers, because it is that portion they will use in requesting the goods. *Dixie Rest.*, 41 USPQ2d at 1534.

With respect to the '446 Registration, applicant argues that

> [t]he disclaimer made to the exclusive right to use the "SPIN THE BOTTLE" term or words apart from the entire mark ... is critical. The owner of the ['446 Registration] does not have rights to the mark SPIN THE BOTTLE separate and apart from use of those words as part of the overall design mark for that registration. ... [B]ecause the owner of the ['446 Registration] has disclaimed the term "SPIN THE BOTTLE" separate and apart from its mark, [this registration] should not be cited as an obstacle to Applicant's registration of its SPIN THE BOTTLE trademark.

Appl. Br. at 4.

To the extent applicant argues that the disclaimed matter in the cited mark must be ignored, it is simply incorrect. Disclaimed matter is not removed from a mark, and must be considered with the rest of the marks as a whole in assessing their similarity. As the Court of Appeals put it,

> it is well settled that the disclaimed material still forms a part of the mark and cannot be ignored in determining likelihood of confusion. Such disclaimers are not helpful in preventing likelihood of confusion in the mind of the consumer, because he is unaware of their existence. Therefore, the disclaimed portions of the mark must be considered in determining the likelihood of confusion.

Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); *see also In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751-52 (Fed. Cir. 1985); *V-M Corp. v. Mayfair Sound Prod.*, Inc., 480 F.2d 898, 178 USPQ 477, 477-78 (CCPA 1973).

Nonetheless, applicant is correct to the extent that it attempts to argue that a descriptive or highly suggestive element of a mark is typically of less significance in forming a commercial impression. Since many disclaimers are made because the disclaimed term is descriptive, disclaimed matter is <u>frequently</u> entitled to relatively less weight in an overall comparison of marks.

But this is not true as a rule, because disclaimers may be entered for a variety of reasons or – at least as far as the USPTO is concerned – for no reason at all. *See In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r 1991) (applicant may voluntarily disclaim any portion of a mark, whether registrable or not); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1213.01(c) (5th ed. 2007). Applicant has not submitted evidence of the term's descriptiveness, nor has it even offered a theory as to how the term is descriptive or should otherwise be entitled to less weight in this context in determining commercial impression.

But even accepting applicant's premise for the sake of argument (and we make no such finding), it is undeniable that even weak marks are entitled to protection. *King Foods, Inc. v. Town & Country Food Co.*, Inc., 159 USPQ 44 (TTAB 1968). Here, we are presented with substantially similar marks used for closely related goods and services. Under these circumstances, the mere weakness of the mark does not obviate confusion, because it is the common portion of the marks (and the whole of applicant's mark) that is allegedly weak.

Applicant's mark is substantially similar to the dominant, albeit disclaimed, portion of the '446 Registration. While we have not overlooked the design

elements or applicant's arguments regarding the weakness of SPIN THE BOTTLE, we nonetheless conclude that – as a whole – applicant's mark shares significant similarities with the mark in the '446 Registration.

The similarity of the marks is thus a factor which supports the refusal to register as to both registrations.

B. Similarity of the Goods and Services

Applicant's computer games and related items are closely related to the goods identified in the '446 Registration. Applicant's goods include

> DVDs and CD-ROMS containing games, board games, interactive games, video games, computer games, game shows, and games containing interactive questions and answers; ... video games from television shows, cartoon and films; multimedia games ...; software, namely multimedia software recorded on DVD or CD-ROM to provide the above functions.

The cited registrant's goods are "electrical and mechanical toys[,] action games[,] and puzzles."

Neither registrant's nor applicant's games and puzzles are limited to any particular type, and thus must be considered to include all such goods. As such, we must consider applicant's game software to include computer implementations of registrant's electrical and mechanical toys, action games and puzzles in a different medium, and thus very closely related.

The close similarity of the respective goods and services involved supports the examining attorney's refusal to register. We find that, in light of the substantially similar marks and the close relationship of the goods and services, confusion is likely with respect to the '446 Registration.

V. Conclusion

After careful consideration of the briefs and of all the evidence of record, we conclude that, in view of the substantial similarity in the commercial impressions of applicant's mark, SPIN THE BOTTLE, and registrants' marks, their contemporaneous use on the closely related goods and services involved in this case is likely to cause confusion as to the source or sponsorship of applicant's goods.

Decision: The refusal under Trademark Act § 2(d) is affirmed.