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February 26, 2004
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Califon Productions, Inc.
v.
Bob Stupak

Opposition No. 91116967 to application Serial No. 75499364 filed on June 11, 1998

Opposition No. 91116968 to application Serial No. 75499363 filed on June 11, 1998

Lynn S. Fruchter of Cowan, Liebowitz & Latman, P.C. for Califon Productions, Inc.

Philip J. Anderson of Anderson & Morishita, LLC for Bob Stupak.

Before Seeherman, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Bob Stupak, a United States citizen, has filed applications to register the mark "WHEEL OF MISFORTUNE" for "electronic gaming machines"[1] in International Class 9 and

[1] Ser. No. 75499364, filed on June 11, 1998, which is based on an allegation of a bona fide intention to use such mark in commerce.

"disposable printed scratch-off, tear-off and pull tab tickets for playing games of chance"[2] in International Class 28.

Registration has been opposed by Califon Productions, Inc. on the ground that, as set forth in the notices of opposition respectively filed in connection with these consolidated proceedings,[3] applicant's mark "so resembles Opposer's [previously used and registered] mark WHEEL OF FORTUNE as to be likely, when used in connection with the Applicant's goods, to cause confusion, or to cause mistake or to deceive." In particular, opposer alleges among other things that for many years, opposer and "its predecessors in interest and/or related companies have been engaged in the business of producing, distributing and licensing audiovisual entertainment properties in various media, including television programs"; that as early as January 6, 1975, opposer's "predecessor began using the WHEEL OF FORTUNE mark in the United States in connection with the most popular game show in the history of television and the highest rated series ever in national syndication"; that "[t]he WHEEL OF FORTUNE series has been and is viewed nationwide by tens of millions of U.S. consumers and has been and is extensively advertised and promoted"; and that "[f]urther increasing the widespread recognition and fame of the WHEEL OF FORTUNE mark, Opposer and Opposer's predecessor have licensed it for use on and in connection with a wide variety of products including, but not

[2] Ser. No. 75499363, filed on June 11, 1998, which is based on an allegation of a bona fide intention to use such mark in commerce.
[3] Pursuant to a consented motion therefor, proceedings herein were consolidated by the Board in an order dated February 1, 2001.

limited to, slot machines in operation in Las Vegas and other locations."

In addition, opposer alleges that "[a]s a result of the foregoing efforts, by Opposer and Opposer's predecessors and related companies, Opposer has achieved a goodwill of incalculable value in the WHEEL OF FORTUNE mark which is exclusively associated with Opposer and the WHEEL OF FORTUNE game show"; that opposer is the owner of registrations for the "WHEEL OF FORTUNE" mark for, *inter alia*, the following goods and services:[4] "board games";[5] "entertainment services rendered through the media of television, namely, a television series game show";[6] and "computer game programs";[7] that such registrations "are all valid, subsisting, [and] in full force and effect"; and that "the goods for which Applicant seeks registration of the mark WHEEL OF MISFORTUNE will be offered through the same channels of distribution and/or to the same classes of purchasers as the goods and services offered ... by Opposer under the mark WHEEL OF FORTUNE."

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[4] Although opposer also pleaded ownership of two additional registrations for such mark, because it offered no proof with respect thereto, those registrations will not be given further consideration.

[5] Reg. No. 1,149,261, issued on June 7, 1988, which sets forth a date of first use anywhere of January 1985 and a date of first use in commerce of June 25, 1985; combined affidavit §§8 and 15.

[6] Reg. No. 1,149,571, issued on June 7, 1988, which sets forth a date of first use anywhere of June 1974 and a date of first use in commerce of January 6, 1975; combined affidavit §§8 and 15.

[7] Reg. No. 1,542,716, issued on June 6, 1989, which sets forth a date of first use anywhere and in commerce of April 29, 1988; combined affidavit §§8 and 15.

Opposer also alleges, as a second ground for its oppositions, that its "WHEEL OF FORTUNE mark is distinctive and famous and has enjoyed such distinctiveness and fame since long prior to the filing date of Applicant's application[s] for the WHEEL OF MISFORTUNE mark"; and that "the use and/or registration of the WHEEL OF MISFORTUNE mark [by Applicant] will dilute the distinctiveness of Opposer's famous WHEEL OF FORTUNE mark."[8]

Applicant, in its answers, has denied the salient allegations of the notices of opposition. Briefs have been filed, but neither party requested an oral hearing.

The record includes the pleadings; the file of each of the opposed applications; and, as part of opposer's case-in-chief, the declaration, with exhibits, of Gregory K. Boone, opposer's executive vice president and assistant secretary, which opposer filed pursuant to a stipulation by the parties.[9] The

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[8] While opposer further alleges that applicant's use of his mark is likely "to falsely suggest a connection with opposer," such allegation appears to pertain to its contention that there is a likelihood of confusion rather than to an attempt to plead, as a third ground for opposition, that applicant's mark consists of or comprises matter which may falsely suggest a connection with opposer within the meaning of Section 2(a) of the Trademark Act, particularly since opposer offered no evidence at trial or argument in its briefs in support of a putative third ground for opposition. Fed. R. Civ. P. 8(f).

[9] Such stipulation recites that the parties agree, "pursuant to [Trademark] Rule 2.123(b) ..., that the testimony of the parties in this proceeding will be submitted in the form of affidavits or declarations ... which are stipulated to be as the affiant or declarant would have testified by testimonial deposition" and provides that the parties "reserve their rights to make objections to any testimony submitted in this proceeding as to relevancy, competency or other proper ground for objection." Although applicant, in accordance therewith, has objected in his brief to certain statements in Mr. Boone's testimony on the ground that, under Fed. R. Evid. 701 and 702, the statements constitute "inadmissible opinion testimony of a lay witness or an opinion by a lay witness who has not been qualified by his knowledge, expertise, skill, experience, training or education," the objection is overruled inasmuch as it is obvious that the witness

rest of opposer's case-in-chief consists of a notice of reliance upon certified copies of various registrations for its "WHEEL OF FORTUNE" mark,[10] including registrations thereof for both "slot machines"[11] and "promoting the sale of the goods and services of others through the distribution of printed materials and advertising designed for promotional contests,"[12] as well as for those goods and services specifically mentioned previously.[13]

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was not testifying as an expert on the matters on which he expressed his opinions as to the issues of likelihood of confusion and dilution. Nonetheless, it is well settled that the opinions expressed by a witness (whether that of a layperson or an expert) on such issues are not controlling or binding on the Board. See, e.g., Jones & Laughlin Steel Corp. v. Jones Engineering Co., 292 F.2d 294, 130 USPQ 99, 100 (CCPA 1961); and Quaker Oats Co. v. St. Joe Processing Co., Inc., 232 F.2d 653, 109 USPQ 390, 391 (CCPA 1956). In particular, the Board has stated that it is "the long-held view that the opinions of witnesses ... are entitled to little if any weight and should not be substituted for the opinion of the tribunal charged with the responsibility for the ultimate opinion on the question" of likelihood of confusion, Mennon Co. v. Yamanouchi Pharmaceutical Co., Ltd., 203 USPQ 302, 305 (TTAB 1979), and the same is likewise the case with respect to deciding the question of dilution.

[10] Although such notice additionally contains a certified copy of a registration owned by opposer for the mark "WHEEL OF FORTUNE 2000" for "entertainment services in the nature of a television game show," no further consideration need be given thereto inasmuch as it is clear that, for purposes of likelihood of confusion, it is the mark "WHEEL OF FORTUNE" for "entertainment services rendered through the media of television, namely, a television series game show" which is closer to applicant's mark in terms of sound, appearance, connotation and overall commercial impression.

[11] Reg. No. 2,228,652, issued on March 2, 1999, which sets forth a date of first use anywhere and in commerce of December 10, 1996.

[12] Reg. No. 950,508, issued on January 9, 1973, which sets forth a date of first use anywhere and in commerce of April 1969; second renewal.

[13] In view of the fact that applicant, in his brief, states that he "agrees with and repeats the Opposer's recitation of the Record" as including its notice of reliance on, *inter alia*, "Reg. No. 2,228,652 for WHEEL OF FORTUNE for 'slot machines'" and "Reg. No. 950,508 for WHEEL OF FORTUNE for "promoting the sale of the goods and services of others through the distribution of printed materials and advertising designed for promotional contests,'" the pleadings are hereby deemed to be amended, pursuant to the express consent of the parties, to conform to such evidence. Fed. R. Civ. P. 15(b).

Applicant's case-in-chief consists of his notice of reliance on copies of five third-party registrations, an excerpt from a printed publication and printouts of two website pages.[14] Applicant did not take testimony of any kind or submit any additional evidence,[15] and opposer did not offer any rebuttal evidence.

Turning first to the ground of priority of use and likelihood of confusion, priority of use is not in issue in this proceeding with respect to opposer's "WHEEL OF FORTUNE" mark for the goods and services which have been specifically set forth above and are the subjects of five of its pleaded registrations since those registrations have been established by its notice of reliance to be subsisting and owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Accordingly, the focus of our determination is on the issue of whether applicant's "WHEEL OF MISFORTUNE" mark, when used in connection with the goods set forth in his

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[14] Ordinarily, printouts of website pages are not proper subject matter for a notice of reliance. See, e.g., Michael S. Sachs Inc. v. Cordon Art B.V., 56 USPQ2d 1132, 1134 (TTAB 2000) [inasmuch as a printout retrieved from the Internet does not qualify as a printed publication under Trademark Rule 2.122(e), its "introduction ... by way of a notice of reliance is improper"]; and Raccioppi v. Apogee Inc., 47 USPQ2d 1368, 1370 (TTAB 1998) ["[t]he element of self-authentication which is essential to qualification under [Trademark] Rule 2.122(e) cannot be presumed to be capable of being satisfied by Internet printouts"]. However, because opposer specifically indicates in its main brief that it regards such printouts as forming part of the record, such evidence is deemed to be stipulated into the record pursuant to Trademark Rule 2.123(b).

[15] While opposer, in its reply brief, has objected "to the introduction of Nevada Statute §463.0152" as additional evidence which is referred to by applicant in his brief, the objection is overruled since such statute is properly the subject of judicial notice. Fed. R. Evid. 201.

applications, so resembles opposer's "WHEEL OF FORTUNE" mark for one or more of its various goods and services as to be likely to cause confusion, mistake or deception as to source or sponsorship.

The record reveals that, according to the declaration of Mr. Boone and exhibits thereto, opposer is the copyright proprietor of the "WHEEL OF FORTUNE" television game show and the owner of the "WHEEL OF FORTUNE" mark. Such show was created by Merv Griffin in the mid-1970's, based loosely on the parlor game Hangman. The "colorful logo, game play, and other distinctive features of the show have become easily recognized by the public as parts of the highest-rated game show in the history of American television." (Boone dec. at ¶3.) In its 28th season on the air (as of the November 26, 2002 date of Mr. Boone's declaration), "WHEEL OF FORTUNE has been recognized as 'one of the most popular game shows in television history,'" according to an excerpt from Ryan & Wostbock, Encyclopedia of TV Game Shows at 250 (3rd ed. 1999). (Id. at ¶4; Opposer's Ex. A.) In particular, Mr. Boone declared that:

> Indeed, since its first-run syndication launch in the 1983-1984 television season, WHEEL OF FORTUNE® has enjoyed the highest audience ratings of any syndicated television show according to the ratings of services Arbitron and A.C. Nielsen Company. An estimated thirty-six million people watch the program weekly in the U.S. where it is available in more than 99% of the country. So phenomenal has been the show's success that it is renewed through the 2004/2005 broadcast season in over 99% of the country, including all of the top 10 markets. ....

(Boone dec. at ¶4.)

Opposer's "WHEEL OF FORTUNE" television game show has received 43 Emmy award nominations and has won five Emmy awards, including awards for Best Direction in 1985 and 1996. Such show "was chosen (along with JEOPARDY!®) as an Official Game Show of the 1996 Atlanta Olympic Summer Games, the first time in history a television game show obtained an official Olympic designation." (Id. at ¶5.) "The virtually unparalleled success of WHEEL OF FORTUNE® has lead [sic] to many licensing opportunities" for opposer, with the "WHEEL OF FORTUNE" mark being licensed (as of November 26, 2002) "for a wide variety of products including slot machines, computer games, hand held electronic games, board games, internet games, and state lottery games in eleven states." (Id. at ¶6.) Retail sales of such licensed products "amount to millions of dollars annually, and have produced revenues unequalled by any other game show." (Id.)

Among the most successful of opposer's licensed products "have been the WHEEL OF FORTUNE® slot machines, which have been marketed since 1996." (Id. at ¶7.) In this regard, Mr. Boone specifically noted that:

> WHEEL OF FORTUNE® slot machine are currently in operation at casinos and other gaming establishments in Nevada, New Jersey, Mississippi, Missouri, Louisiana, Iowa, Indiana, Illinois, Michigan, Colorado, Rhode Island, and New Mexico, as well as on cruise ships operating out of Florida. Wheel of Fortune is also in the following states operating as Native American Gaming: Arizona, California, Connecticut, Iowa, Kansas, Louisiana, Michigan, Minnesota, Mississippi, New Mexico, North Dakota, Oregon, South Dakota, Washington, and Wisconsin. All of these machines prominently feature the WHEEL OF FORTUNE® trademark,

> which is registered for "slot machines" ... by Registration No. 2,228,652. ....

(Id.) Furthermore, according to Mr. Boone's testimony:

> The WHEEL OF FORTUNE® slot machines have achieved virtually unprecedented market penetration since their introduction. According to public data collected by IGT, the leading supplier in the world to the casino industry, and [opposer] Califon's exclusive licensee for WHEEL OF FORTUNE gaming machine products since 1995, in 2001 in North America alone, slot machines generated over Thirty-one Billion Dollars ($31,000,000,000.00) in revenue for casino operators. Within that share, WHEEL OF FORTUNE slots, with their unique and distinctive features and mark[ing]s, have become and still maintain their place as the most successful participation games in history, creating more value than any other licensed brand in this industry. Indeed, the WHEEL OF FORTUNE® reel slot machine was chosen #1 Best Progressive Reel Slot, Best Reel Slot Theme, Most Innovative Reel Slot, Best Reel Slot Bonus Round, and Best Reel Slot Sound by slot machine players, according to the first-ever "Best of Slots" Survey published in *Strictly Slots* magazine in October 2001. The WHEEL OF FORTUNE® video slot machine, introduced in 2000, received a #4 ranking in the Favorite Video Slot category in the 2002 "Best of Slots" Survey. ....

(Id. at ¶8.) Moreover, besides supporting the above statements, it is interesting to observe that an exhibit accompanying Mr. Boone's declaration not only indicates that "IGT has begun ... releasing video slot versions of several pop culture television shows among other new games," but also notes that "[f]ourth place winner Wheel of Fortune was virtually a no-brainer from the start, considering the game's universal appeal, but in video format manages to introduce the fill-in-the blank word game, which was by necessity left out of the reel version." (Opposer's

Ex. D.) It would appear, therefore, that not only do the newest slot machines licensed by opposer utilize its "WHEEL OF FORTUNE" mark, but such video machines even replicate the word puzzle format of opposer's "WHEEL OF FORTUNE" television game show.

Mr. Boone also testified with respect to opposer's common law rights in its "WHEEL OF FORTUNE" mark with respect to the use thereof by MDI Entertainment Inc. "as a brand of licensed lottery product." (Id. at ¶9.) Specifically, he declared that:

> Likewise, WHEEL OF FORTUNE has been among the most popular licensed state lottery games in North America in the past several years, and is currently available in Colorado, Florida, Indiana, Kansas, Missouri, New Jersey, New York, Oregon, Pennsylvania, Virginia, Wisconsin, and British Columbia. In addition to the regular cash prizes on scratch-off tickets, purchasers have second opportunities to win prizes including cash, travel, hotel stays, and even contestant auditions for the WHEEL OF FORTUNE® game show by tuning in to the WHEEL OF FORTUNE® game show to see if his or her lottery ticket number is read on the air. Sales of WHEEL OF FORTUNE lottery tickets brought in tens of millions of dollars to the economies of the states where they have been sold. ....

(Id.)

Opposer's "WHEEL OF FORTUNE game show and licensed products have been extensively advertised and promoted," with "[m]illions of dollars" having been spent by opposer to promote its "WHEEL OF FORTUNE" game show in the past five years alone and its licensing partners having "spent many millions of dollars more in the same time period." (Id. at ¶10.) The primary means of opposer's advertising, including national advertisements, is through the media of television, newspaper and radio ads. Its

"WHEEL OF FORTUNE® game show and licensed products also have been the subject of widespread media coverage, including numerous magazine and newspaper articles, as well as television stories, commenting on the success of the WHEEL OF FORTUNE® entertainment property." (Id. at ¶11.) Mr. Boone concluded that, as a result thereof, "the term WHEEL OF FORTUNE has become inextricably and exclusively associated with [opposer] Califon's famous game show and its licensed products." (Id. at ¶12.) As an example thereof, he noted that, as shown by Opposer's Ex. 8, "a LEXIS® NEXIS® Freestyle search of 'Wheel, Fortune' found that all 50 of the retrieved stories referred to the WHEEL OF FORTUNE® game show or licensed products."

Finally, in addition to asserting that the respective "marks of the parties are virtually identical in sound, appearance, commercial impression and meaning, [inasmuch] as both parties' marks link the concept of good or bad 'fortune' with the spin of a wheel," Mr. Boone stated that "slot machine games and lottery-type ticket games ... are traditional impulse purchases." (Id. at ¶14 and ¶15.) Because, in view thereof, "consumers will be unlikely to exercise particular care in their buying decisions," he indicated the belief that "the minor distinction in the parties' marks thus will not avert confusion." (Id. at ¶15.)

The record contains no information about applicant or how he intends to use the "WHEEL OF MISFORTUNE" mark in connection with the goods for which registration thereof is sought. Instead, the evidence offered by applicant which is even

arguably relevant herein[16] consists of information concerning five third-party registrations for the following marks and associated goods or services, which applicant presumably submitted in an attempt to demonstrate the weakness of opposer's "WHEEL OF FORTUNE" mark:[17] "BIG WHEEL OF GOLD" for "currency and/or credit operated slot machines and gaming devices, namely, gaming machines" (Reg. No. 2,533,253, issued on January 29, 2002); "WHEEL OF PHONICS" for "computer game software" (Reg. No. 2,582,534, issued on June 18, 2002 with a disclaimer of

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[16] As noted previously, applicant's notice of reliance also included an excerpt from a printed publication and printouts of two website pages in an attempt to show, as argued in his brief, that opposer's mark "for gaming equipment and accessories cannot acquire distinctiveness or fame inasmuch as the words and phrase 'wheel of fortune' are [merely] descriptive or generic for a gaming device using a spinning wheel." It is pointed out, however, that a contention that opposer's mark is merely descriptive of any of the goods or services set forth in its pleaded registrations constitutes a collateral attack on the validity of such registrations which will not be entertained in the absence of a counterclaim for cancellation thereof. Trademark Rules 2.106(b)(2)(i) and (ii). Thus, as to his mere descriptiveness assertion, the additional evidence offered by applicant is irrelevant. Moreover, as to those registrations pleaded by opposer which were over five years old as of the commencement of each of these proceedings on February 2, 2000, such registrations could not in any event be canceled on the ground of mere descriptiveness. See Sections 14(1) and (3) of the Trademark Act, 15 U.S.C. §§1064(1) and (3). However, even if applicant's additional evidence were to be given further consideration as to both his mere descriptiveness assertions (in respect to those of opposer's registrations which were not over five years old at the start of these proceedings) and his genericness contentions, suffice it to say that such evidence demonstrates only that the term "wheel of fortune" designates a casino "side game" which is entirely different from the class of gaming machines designated by the term "slot machines." Thus, with the possible exception of opposer's "computer game programs," applicant's additional evidence fails to establish that the term "wheel of fortune" is generic for, or at least merely descriptive of, any of the goods and services which are the subjects of opposer's pleaded registrations, including its registration of the "WHEEL OF FORTUNE" mark for slot machines.

[17] Curiously, while applicant asserts in his brief that the relevant "factors which may be considered in resolving the issue of likelihood of confusion" in this proceeding "include ... the number and nature of similar marks in use on similar goods," no specific discussion of such factor is set forth in applicant's brief.

"PHONICS"); "WHEEL OF MADNESS" for "gaming products, namely, gaming wheels and gaming tables" (Reg. No. 2,458,096, issued on June 5, 2001 with a disclaimer of "WHEEL"); "WHEEL OF WISDOM" for "organizing and conducting a general knowledge game that uses a game show format" (Reg. No. 2,013,705, issued on November 5, 1996); and "WHEEL OF GOLD" for "promotional game cards for use in supermarkets and other stores" (Reg. No. 1,722,995, issued on October 6, 1992).

Upon consideration of the pertinent factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether there is a likelihood of confusion herein, we find that confusion is likely inasmuch as such factors favor opposer in each instance. In particular, starting with the *du Pont* factor of the fame of the prior mark, applicant concedes in his brief that he "does not dispute that Opposer's game show bearing the mark is popular" nor "does Applicant dispute that slot machines bearing the mark have generated large gambling revenues." Applicant argues, instead, that he "dispute[s] the contention that the mark is famous and distinctive in at least the gaming industry and particularly in regards to 'electronic gaming machines' or 'disposable printed scratch-off and pull tab tickets for playing games of chance.'"

The record herein, however, clearly establishes that opposer's mark "WHEEL OF FORTUNE" is a famous mark for its "entertainment services rendered through the media of television, namely, a television series game show," and that such fame

extends to the use thereof on various collateral products, including "slot machines." Among other things, opposer's "WHEEL OF FORTUNE" television series game show, as indicated earlier, is the highest-rated game show in the history of American television; it has been on the air for 28 seasons; it is watched by an estimated 36 million persons a week in the United States; it is so successful that the show has been renewed through the 2004/2005 broadcast season in over 99% of the country, including all of the top 10 markets; and it has received nominations for 43 Emmy awards and won five such awards.

Such virtually unparalleled success, as also noted previously, has in turn led to many licensing opportunities for opposer with respect to the "WHEEL OF FORTUNE" mark, including in particular the use thereof in connection with slot machines as well as state lottery games. Retail sales of opposer's licensed products, as noted above, involve millions of dollars annually and produce revenues unequalled by any other game show; opposer's slot machines, which have been marketed since 1996 and prominently feature the "WHEEL OF FORTUNE" mark, are in fact among the most successful of its licensed products; such slot machines have achieved virtually unprecedented market penetration since their introduction, with the reel versions thereof becoming the most successful participation games and creating more value than any other licensed brand in the history of the industry, while the video versions thereof, which appear to introduce the fill-in-the blank word game of opposer's television game show, have similarly managed to achieve a fourth place ranking in the

industry. Likewise, as previously mentioned, when licensed for use in connection with state lottery products, the mark "WHEEL OF FORTUNE" has in recent years been among the most popular of such games, bringing tens of millions of dollars in sales thereof to 11 states and awarding prizes which even include contestant auditions for opposer's "WHEEL OF FORTUNE" game show.

Consequently, given the tie-in of opposer's licensed products to its "WHEEL OF FORTUNE" television game show, it is plain that the fame of the latter extends to such former products as slot machines and lottery items, which are goods encompassed by applicant's "electronic gaming machines" and "disposable printed scratch-off, tear-off and pull tab tickets for playing games of chance." Opposer's "WHEEL OF FORTUNE game show and licensed products, as the record shows, have been extensively advertised and promoted, with millions of dollars having been spent by opposer to promote its "WHEEL OF FORTUNE" game show in just the past five years and its licensing partners having spent many millions of dollars more in the same period. Further promotion thereof has occurred as the result of widespread media coverage, including numerous magazine and newspaper articles, as well as television stories, with the result that "the term WHEEL OF FORTUNE has become inextricably and exclusively associated with [opposer] Califon's famous game show and its licensed products." (Boone dep. at ¶12.)

As noted by our principal reviewing court in Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862,

113 S.Ct. 181 (1992), "the fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." The Federal Circuit reiterated these principles in Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000), stating that "the fifth *DuPont* factor, fame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *DuPont* factors," *citing*, inter alia, *Kenner Parker Toys*, 22 USPQ2d at 1456, and reaffirmed that "[f]amous marks thus enjoy a wide latitude of legal protection." This factor, therefore, weighs heavily in favor of opposer.

Turning next to consideration of the similarity or dissimilarity of the respective marks in their entireties as to appearance, sound, connotation and commercial impression, we find that this *du Pont* factor favors opposer. Applicant asserts that the inclusion of the syllable "MIS" in his "WHEEL OF MISFORTUNE" mark not only distinguishes such mark in sound and appearance from opposer's "WHEEL OF FORTUNE" mark, but "the connotation of 'misfortune' is a direct opposite of fortune,'" thereby further distinguishing the respective marks. Applicant additionally maintains, although notably without any reference to any evidentiary support in the record, that his mark "may also be understood by consumers to represent an [sic] parody of Opposer's mark," thereby decreasing any likelihood of confusion since, to be effective, a parody must call to mind and hence distinguish the mark being parodied. "The contrary connotation of Applicant's mark fostered by 'misfortune,'" applicant insists in

his brief, "would not create confusion and would, in fact, distinguish Applicant's mark from that of the Opposer."

We concur with opposer, however, that the marks at issue are substantially the same in their overall sound, appearance, connotation and commercial impression. Both marks, obviously, begin with the phrase "WHEEL OF" and end with either the word "FORTUNE" or the word "MISFORTUNE." As to the meaning of such words, we judicially notice, for example, that in relevant part The American Heritage Dictionary of the English Language (4th ed. 2000) at 693 defines "fortune" as "**1a.** The chance happening of fortunate or adverse events; luck .... **3.** ... A hypothetical, often personified force or power that favorably or unfavorably governs the events of one's life" and at 1124 lists "misfortune" as "**1a.** Bad fortune or ill luck. **b.** The condition resulting from bad fortune or ill luck."[18] It is clear, therefore, that the term "fortune" can connote either good fortune or luck, on the one hand, or "misfortune," that is, bad fortune or luck, on the other. Thus, and particularly when, as here, such words are used as part of marks which are indicative of an element of chance, it is apparent that the marks at issue are also substantially the same in overall connotation. In their entireties, the marks "WHEEL OF FORTUNE" and "WHEEL OF

[18] It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

MISFORTUNE" consequently engender a substantially identical commercial impression, especially when used in connection with the same goods (slot machines and electronic gaming machines) and products commercially related thereto (e.g., lottery game tickets). Moreover, even if the users of the parties' gaming products were to view applicant's "WHEEL OF MISFORTUNE" mark as nevertheless a parody or other play on opposer's "WHEEL OF FORTUNE" mark, the overall similarities between the marks are so substantially the same (for the reasons indicated above) that, if used in connection with the same and/or closely related goods and/or services, confusion as to source or sponsorship would be likely to occur. See, e.g., Columbia Pictures Industries, Inc. v. Miller, 211 USPQ 816, 820 (TTAB 1981) [mark "CLOTHES ENCOUNTERS" for items of men's and women's clothing including T-shirts held likely to cause confusion with mark "CLOSE ENCOUNTERS OF THE THIRD KIND" for T-shirts and perfume inasmuch as such marks "conjure up the same thing since one is an obvious play on the other"; "right of the public to use words in the English language in a humorous and parodic manner does not extend to use of such words as trademarks if such use conflicts with the prior use and/or registration of the substantially same mark by another"].

It appears, however, from applicant's introduction of several third-party registrations for marks which share the formative phrase "WHEEL OF" that applicant is attempting to argue that opposer's "WHEEL OF FORTUNE" mark is nonetheless a weak mark in that consumers have become so accustomed to encountering marks

which begin with or include the formative phrase "WHEEL OF" that they will look to and distinguish such marks by the differences therein. The problem with such an argument, however, is that it is well settled that third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of the subject marks. See, e.g., National Aeronautics & Space Administration v. Record Chemical Co., 185 USPQ 563, 567 (TTAB 1975). The reason therefor is that third-party registrations simply do not show that the marks which are the subjects thereof are actually being used, or that the extent of their use is so great that customers have become accustomed to seeing the marks and hence have learned to distinguish them. See, e.g., Smith Brothers Manufacturing Co. v. Stone Manufacturing Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and In re Hub Distributing, Inc., 218 USPQ 284, 285-86 (TTAB 1983). Consequently, the co-existence of the third-party registrations with opposer's pleaded registrations does not justify registration of a confusingly similar mark by applicant since, as indicated in AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973):

> [L]ittle weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.

The *du Pont* factor of the number and nature of similar marks in use on similar goods thus favors opposer in view of the absence of any evidence demonstrating that the marks which are the subjects of the third-party registrations made of record by applicant are actually in use.

The remaining *du Pont* factors which are pertinent concern the similarity or dissimilarity in the nature of the respective goods and services, as identified in applicant's applications and opposer's pleaded registrations; the variety of goods and services on which opposer's mark is used; the similarity or dissimilarity of established, likely to continue channels of trade for the goods and services at issue; and the conditions under which and buyers to whom sales are made (i.e., "impulse" rather than careful, sophisticated purchasing). In particular, it is plain that as identified, applicant's "electronic gaming machines" encompass, and hence are legally identical in part to, opposer's "slot machines" and that his "disposable printed scratch-off, tear-off and pull tab tickets for playing games of chance" are clearly similar, and thus related in a commercial sense, to opposer's slot machines inasmuch as both constitute forms of gambling commonly available for play by ordinary consumers. Also, because of the particular facts in these consolidated proceedings, applicant's goods are considered similar in nature to opposer's "entertainment services rendered through the media of television, namely, a television series game show." The popularity of opposer's entertainment services has been so great that it has allowed opposer to expand,

through the licensing of its "WHEEL OF FORTUNE" mark, into the offering of a variety of different goods, including the same kinds of gaming equipment and products as those in connection with which applicant intends to use his "WHEEL OF MISFORTUNE" mark, namely, slot machines and lottery game tickets. The fact, moreover, that opposer uses or licenses for use its "WHEEL OF FORTUNE" mark on a variety of different goods and services also favors a finding of likelihood of confusion.

In addition, it is clear that in light of their identity in part, applicant's electronic gaming machines and opposer's slot machines would be sold in the same channels of trade to the same class of purchasers, specifically, those in charge of buying gaming equipment for casinos. Furthermore, and contrary to opposer's assertions in its main and reply briefs, it is plain that the actual *purchasers* of applicant's tickets for playing games of chance would, in the first instance, be state lottery officials and that the actual *purchasers* of opposer's television series game show services would be those in charge of programming for television stations and cable television systems. While such classes of persons clearly would constitute sophisticated and discriminating purchasers, nonetheless it is still the case that the ultimate consumers of applicant's goods and opposer's goods and services are members of the general public. Such consumers plainly are akin to ordinary purchasers and would not, therefore, be expected to exercise a great deal of care or deliberation in their selection of such common forms of entertainment as picking what slot or other electronic gaming

machines to play; deciding whether to purchase tickets for lotteries and other games of chance; or choosing which television game shows to watch. Consequently, with respect to at least the ultimate consumers or users of the parties' goods and services, it is the case that this remaining pertinent *du Pont* factor favors opposer.

We accordingly agree with opposer that contemporaneous use by applicant of his "WHEEL OF MISFORTUNE" mark in connection with "electronic gaming machines" and "disposable printed scratch-off, tear-off and pull tab tickets for playing games of chance" would be likely to cause confusion with the use by opposer of its "WHEEL OF FORTUNE" mark in connection with, *inter alia*, "slot machines" and "entertainment services rendered through the media of television, namely, a television series game show."

In view of our holding that opposer is entitled to the relief it seeks on the ground of priority of use and likelihood of confusion, we need not reach the remaining ground of dilution. Cf. American Paging Inc. v. American Mobilphone Inc., 13 USPQ2d 2036, 2039 (TTAB 1989), *aff'd in op. not for pub.*, American Mobilphone Inc. v. American Paging Inc., 17 USPQ2d 1726, 1727 (Fed. Cir. 1990).

Decision: The opposition is sustained on the ground of priority of use and likelihood of confusion.