

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Nintendo of America Inc.

v.

Allan Schwartzberg

Opposition No. 91163873
to application Serial No. 76548918
filed on October 6, 2003

Jerald E. Nagae of Christensen O'Connor Johnson Kindness
PLLC for Nintendo of America Inc.

Daniel Crupain of Law Offices of Daniel Crupain for Allan
Schwartzberg.

Before Grendel, Bergsman, and Wellington, Administrative
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Allan Schwartzberg filed an intent-to-use application
for the mark GOLFBOY, in standard character form, for goods
ultimately identified as "portable electronic viewer
apparatus and related software for use with image display
units, computer disks and cartridges, films, videos and
other image display devices and for use with computer
software; all featuring topics relating to golf, golf
swings, sports."¹

¹ Application Serial No. 76548918, filed October 6, 2003.

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Nintendo of America Inc. opposed the registration of applicant's mark on the grounds of priority of use and likelihood of confusion and dilution in accordance with Sections 2(d) and 43(c) of the Lanham Act.

Applicant filed an answer denying all allegations in the notice of opposition.

Opposer timely filed a trial brief on December 20, 2006. Applicant filed a "response" to opposer's trial brief on March 19, 2007, without any accompanying motion for leave to accept a late trial brief. The response consists in substance of three short paragraphs. In its reply brief, opposer objected to the timeliness of applicant's submission. Because applicant's submission was filed approximately two months after the time allowed for filing a trial brief, it is untimely and not considered by the Board. Trademark Rule 2.128(a)(1).

The Record

By operation of the rules, the record includes the pleadings and the application file for the GOLFBOY trademark. Opposer timely filed a copy of the trial deposition transcript, with exhibits, of George S. Harrison ("Harrison deposition"), opposer's Senior Vice President of Marketing. Opposer also filed a notice of reliance on

applicant's responses to interrogatories pursuant to Trademark Rule 2.120(j)(3)(i).²

As an evidentiary matter, opposer seeks to rely on several registrations but has not properly made them of record. Specifically, opposer pleaded ownership of twelve (12) registrations in the notice of opposition and attached photocopies of the registrations thereto. Also, exhibit L to the Harrison deposition includes photocopies of sixteen (16) registrations, purportedly owned by opposer, with corresponding TARR database printouts for each registration.³ However, at no point during this proceeding has opposer submitted status and title copies for any of the registrations (pleaded or not), or properly authenticated the registrations through testimony, in order to make them of record. See the discussion *infra*.

Trademark Rule 2.122 provides that a pleaded registration will be received in evidence and made part of the record if two copies thereof (prepared and issued by the Office) showing both current status and title to the registration accompany either the complaint or a timely-

² Opposer's notice of reliance also identifies applicant's response to opposer's requests for production of documents. Although it appears that no copies of responsive documents were actually filed with the notice of reliance, such documents generally can not be made of record by notice of reliance. Trademark Rule 2.120(j)(3)(ii).

³ Exhibit L's sixteen registrations encompass all but two of the pleaded registrations.

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filed notice of reliance.⁴ Otherwise, the plaintiff must properly identify and introduce the registration into evidence as an exhibit during a trial deposition.

Again, opposer has not submitted status and title copies for any of the registrations. Moreover, during his deposition, Mr. Harrison did not testify to the current status of the registrations referenced in Exhibit L in order to establish that any of the registrations are valid and subsisting. In view thereof, opposer's pleaded registrations and the registrations identified in Exhibit L are not in evidence and will not be considered in the record. For purposes of standing, priority and the likelihood of confusion analysis, opposer may not rely on the registrations but, instead, must rely on its common law rights as shown by the record.

Applicant did not take testimony or otherwise introduce any evidence. The Board notes that applicant is not required to take testimony, introduce evidence, or file a trial brief. Instead, it is opposer, as plaintiff in this proceeding who must prove its standing and either of the two grounds for opposition, namely, likelihood of confusion and dilution, by a preponderance of the evidence.

⁴ The rule was amended recently to allow the submission of copies of records from Office electronic databases, such as TARR, to prove the status and title of the registration. However, the amendment is applicable to Board proceedings commenced on or after August 31, 2007.

Opposer's Common Law Rights

By way of the Harrison deposition, with exhibits, opposer has established common law rights to the following marks: GAME BOY, GAME BOY COLOR, GAME BOY CAMERA, and GAME BOY ADVANCE (hereinafter collectively referred to as "the GAME BOY marks"). This is not to say that opposer did not establish common law rights to other marks; we merely concentrate on these marks because they are the most relevant to our decision.

Beginning with GAME BOY, opposer has continuously used this mark since 1989 on a "hand-held electronic video game machine that takes interchangeable cartridges." Harrison dep., pp. 12, 14 and 16. Opposer began using the mark GAME BOY COLOR in 1995 on the same type of goods, but with a color viewing screen. Harrison dep., p. 13. In 2001, opposer began using the mark GAME BOY ADVANCE on the same type of goods, but with faster coprocessors and improved color screens. Harrison dep., p. 15. The mark GAME BOY CAMERA was first used by opposer in 1998 on an accessory device that allowed the GAME BOY user to take a photograph of the video screen for the GAME BOY hand-held game. Harrison dep., pp. 14-15.

Since 1989, opposer (and its licensees) has offered a wide variety of software programs that are designed to be played with the hardware bearing the GAME BOY marks.

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Harrison dep., p. 16-19. See Exhibit B to the Harrison deposition containing a list of such programs that have been available since 1989. These software programs involve many sports-themed games, including golf, as well as software that provides a "realistic simulation" golf game targeted to adult consumers. Harrison dep., pp. 36-42. The software programs designed for the hardware bearing the GAME BOY marks are either published by opposer itself or by a third party publisher via a licensing agreement with opposer. Harrison dep., p. 19-20. With all of the licensed software programs, opposer exerts control over and "maintain(s) a standard of quality in giving packaging guidelines on how [the third party publishers] need to present any of [opposer's] marks on their products." Harrison dep., p. 19.

Standing

Opposer's aforementioned common law rights in the GAME BOY trademarks are sufficient for purposes of standing, i.e., that opposer has a real interest to challenge the involved application. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028, 213 USPQ 185 (CCPA 1982).

Section 2(d) Claim

We turn first to opposer's Section 2(d) ground of opposition. In order to prevail on such ground, opposer must prove priority of use and likelihood of confusion.

Priority

As to priority, the earliest date upon which applicant may rely on for priority purposes is October 6, 2003, which is his constructive use date or filing date of his application. Thus, opposer has priority of use of the GAME BOY marks as established by its common law rights on hand-held electronic video game machines.

Likelihood of Confusion

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 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 or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These two factors, along with other relevant *du Pont* factors, are discussed below.

Fame or relative strength of opposer's marks

Opposer pleaded in the notice of opposition and argued in its trial brief that its GAME BOY marks are famous. In view of the extreme deference that is accorded to a famous

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mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we will analyze this *du Pont* factor first. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public...recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). In the present case, the relevant class of customers and potential customers for portable electronic gaming hardware or devices which use interchangeable software are the general consuming public looking for such goods. Based on the record, including evidence designated "confidential" by opposer, we conclude that opposer's GAME BOY mark is famous for said goods.

Before discussing the reasons for finding opposer's mark GAME BOY famous, we note that opposer argues that applicant "conceded the fame of [opposer's] GAME BOY mark," referencing an exchange between the parties' counsel during the Harrison Deposition. Brief, at p. 11. Specifically,

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opposer relies on counsel for applicant's statement that, "if we agreed on [GAME BOY being a famous mark], do we have to prolong [opposer's counsel eliciting testimony on a specific topic]?" Harrison dep., at pp. 31-32. While we do not find this question or exchange between the parties' counsel as constituting a concession by applicant that GAME BOY is a famous mark, we note that applicant makes no attempt to contest this assertion either in its cross-examination of the witness or in its untimely response to opposer's trial brief. More importantly, as mentioned, there is sufficient evidence showing that opposer's GAME BOY mark is indeed famous.

Opposer's GAME BOY mark has been continuously in use for over 18 years. During this time, over 188 million hardware units bearing one of the GAME BOY marks have been sold worldwide, approximately 50-55% of which were shipped to customers in the United States. Over 1 billion units of GAME BOY compatible software have been sold in the United States.

Since 1989, opposer's GAME BOY goods have been promoted heavily by opposer at consumer electronics trade shows; by placement of advertisements in every issue of "Nintendo Power," a magazine published by opposer with a monthly circulation of nearly 400,000 copies in the United States and Canada; through articles, advertisements, products

reviews in independent electronic gaming magazines as well as other magazines targeting a younger audience; and through consistent advertising campaigns on television and in print media. Opposer's total marketing budget exceeds \$200 million per year, half of which goes toward paid advertising on television, print, online media. And approximately 30-40% of this number is used to promote its GAME BOY goods.

Also, going to the strength of opposer's GAME BOY mark, we note again that the record is devoid of any evidence relating to any third-party use or registrations of marks similar to opposer's GAME BOY mark. The lack of this type of evidence adds support to opposer's claim that its GAME BOY mark is strong.

In view of the above, we conclude that the *du Pont* factors of fame (of the GAME BOY mark) and strength of opposer's marks favor opposer.

Similarity of the goods/ trade channels

The goods involved in this case are, at the very least, highly similar and may be identical. The application's identification of goods, "portable electronic viewer apparatus and related software for use with image display units...featuring topics relating to golf, golf swings, sports," is broad enough in scope to include the same goods bearing opposer's GAME BOY marks. In other words, both parties' products are essentially portable electronic

devices that may be used with software cartridges to play either a sports-themed game, including golf, or provide instruction in the fields of golf and other sports.

Because applicant's identification of goods is not restricted as to trade channels or classes of purchasers, we must presume that applicant's goods are marketed in all of the normal trade channels for such goods and bought by the usual classes of purchasers. *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Moreover, the evidence of record shows that opposer's goods bearing GAME BOY marks are advertised to and purchased by not just a younger audience, but includes adult consumers. See Harrison dep., p. 36 and Exhibit J (identifying magazines where said advertisements have been placed). Opposer's goods may be purchased in a variety of retail stores. Accordingly, we find that the parties' goods are advertised in the same magazines, sold in the same channels, and bought by the same class(es) of purchasers.

In view of the above, the *du Pont* factors of the similarity of the goods, trade channels, as well as the conditions under which sales are made, weigh in favor of a finding of likelihood of confusion.

Similarity of the marks

In considering the marks, we initially note that when marks are used in connection with identical goods, as in this case, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1692. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Finally, while the marks must be considered as a whole in determining 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,

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provided the ultimate conclusion rests on consideration of the marks in their entirety." *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000). Because all of applicant's and opposer's marks are comprised of descriptive or generic terms followed by the term "boy", i.e., "golf" is descriptive of the subject matter of applicant's goods and "game" is generic for opposer's goods inasmuch as they consist, in part, of games, the parties marks share the same dominant term, "boy." Again, we must consider the marks in their entirety, we may give greater weight to the dominant portion of the marks in determining whether there is a likelihood of confusion. See *National Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752.

Applicant's mark, GOLFBOY, is also similar in appearance and sound to opposer's mark, GAME BOY. Both marks begin with the letter "g" and contain the same number of letters. In addition, as described above, the marks are structured the same: a descriptive or generic term followed by the word "boy." Consumers familiar with opposer's well-known GAME BOY mark upon encountering applicant's GOLFBOY game may mistakenly believe that the GOLFBOY game is a variation of the GAME BOY product line.

In sum, we find that opposer's marks, GAME BOY in particular, and applicant's GOLFBOY are more similar than

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dissimilar. We thus resolve this *du Pont* factor against applicant.

In summary, we have carefully considered all of the evidence in the record which pertains to the relevant *du Pont* factors, and we conclude that opposer met its burden in proving priority and the likelihood of confusion ground of opposition. Specifically, based on the fame of opposer's mark GAME BOY and commercial strength of opposer's other marks, the similarity in the parties' marks and goods, and the overlap in trade channels and customers, we find that applicant's mark GOLFBOY is sufficiently similar to opposer's GAME BOY marks that confusion is likely.

Decision: The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused. Because we find in favor of opposer on this ground, it is not necessary to reach a decision on the dilution ground for opposition.