

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 6/11/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Casino Data Systems

Serial No. 74/654,198

Bernhard Kreten, Esq. for applicant.

David H. Stine, Trademark Examining Attorney, Law Office 103
(Michael Szoke, Managing Attorney).

Before Simms, Cissel and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Casino Data Systems has filed an application to register the mark GRAPHIT for "computer programs namely software for use in a gaming environment for player tracking."¹

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so

¹ Serial No. 74/654,198, in International Class 9, filed March 31, 1995, based on use in commerce, alleging first use and first use in commerce as of September 26, 1994.

resembles the mark GRAPH IT, previously registered for computer programs in the form of magnetic tapes,² that, as used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Additionally, the Examining Attorney has finally refused registration on the ground that the specimens of record, promotional press releases, are unacceptable evidence of actual trademark use.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register on both grounds.

We turn first to the question of whether the specimens herein are acceptable evidence of actual trademark use. A copy of the top half of the promotional page submitted as the specimen is shown below.

² Registration No. 1,259,253 issued November 23, 1983, to Atari, Inc., in International Class 9. According to the records of the PTO, the present owner is Atari Corporation. The registration includes a disclaimer of GRAPH apart from the mark as a whole. [Section 8 and 15 affidavits accepted and acknowledged, respectively.]

Applicant contends that its specimens are acceptable for the following reasons:

Appellant sells its goods to casino owners and operators. Appellant's goods are not the type of computer software that one would encounter packaged on the shelf of a computer supply store or outlet . . . Rather, Appellant's goods are directed to an insular group of purchasers. These purchasers are exposed to Appellant's goods through such material as that that was originally filed with this application. Just because Appellant's goods are software programs, it does not necessarily mean that there are labels, tags, containers, etc. associated with these goods. The GraphIT trademark appears on the screens of the computer display as well on printed material developed thereby. The GraphIT program is an interface to Appellant's Oasis hardware and as such is sold as a unit. The GraphIT trademark appears on the screens of the computer display as well on printed material developed thereby.

Applicant's specimens are clearly advertising material. As the Board stated in *In re Mediashare Corp.*, 43 USPQ2d 1304, 1307 (1997):

Such material, generally speaking, is not acceptable as specimens for goods. This is because any material whose function is simply to tell a prospective purchaser about the goods or to promote the sale of the goods is unacceptable to support trademark use.

In certain circumstances advertising material may function, also, as a display associated with the goods, in which case the material is, essentially, point-of-sale material designed to catch the attention of prospective purchasers and serve as an inducement to consummate a sale. *In re*

Bright of America, Inc., 205 USPQ 63 (TTAB 1979). Applicant states that it sells its goods as part of a hardware system to a specific class of purchasers rather than selling its goods "off the shelf" in computer supply stores and the like. Applicant further discloses that its mark appears on the computer screen when the program is called up, but no examples of this are provided.³

On the other hand, applicant offers no explanation of whether or how its advertising material, submitted as specimens herein, may be used as a point-of-purchase display in connection with the sale of its goods. As such, we find that the specimens of record do not function as displays associated with applicant's goods. Therefore, the specimens are not acceptable to demonstrate trademark use of the mark GRAPHIT for "computer programs namely software for use in a gaming environment for player tracking."

Turning, next, to the issue of likelihood of confusion, two key considerations in our analysis in this case are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). The marks herein are identical in pronunciation and connotation. Registrant's mark, GRAPH IT, and applicant's mark, GRAPHIT,

³ Thus, this is not a situation where it is difficult to affix the mark to the goods or to displays associated therewith. See, *In re Griffin Pollution Control Corp.*, 517 F.2d 1356, 186 USPQ 166 (CCPA 1975).

are substantially similar in appearance, the only difference being that registrant's mark appears as two words, whereas the two words are telescoped into a single word in applicant's mark. We find this difference to be insignificant.

The test for likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). Due to the consuming public's fallibility of memory, the emphasis is on the recollection of the average customer, who normally retains a general rather than a specific impression of trademarks or service marks. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd*. No. 92-1086 (Fed. Cir. June 5, 1992); and *In re Steury Corporation*, 189 USPQ 353 (TTAB 1975). Thus, the proper test for determining the issue of likelihood of confusion is the similarity of the general commercial impression engendered by the marks. In this case, we find the overall commercial impressions of the marks to be substantially similar, if not identical.

Turning to the goods, we note that while applicant's software is limited to "use in a gaming environment for player tracking", it is not limited as to the form in which

it is sold. Thus, applicant's software could be sold on diskettes, CD-ROM or magnetic tape, or pre-loaded on computer hardware. Like the goods of applicant, registrant's goods are software. Registrant's software, as identified, is limited in form to magnetic tape, but the scope of its subject matter is not limited. In this regard, applicant's goods fall squarely within the scope of goods identified in the registration.

Therefore, we conclude that, in view of the substantial similarity in the commercial impressions of applicant's mark, GRAPHIT, and registrant's mark, GRAPH IT, their contemporaneous use on the same goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: Both the refusal under Section 2(d) of the Act on the ground of likelihood of confusion and the refusal on the ground that the specimens of record are not acceptable evidence of trademark use are affirmed.

R. L. Simms

R. F. Cissel

C. E. Walters

Serial No. 74/654,198

Administrative Trademark Judges,
Trademark Trial and Appeal Board