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Paper No. 20
TEH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **adp Gauselmann GmbH**

Serial No. 75/371,661

Horst M. Kasper for adp Gauselmann GmbH

Robin S. Chosid, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Simms, Bucher and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, adp Gauselmann GmbH, has appealed from the final
refusal of the Trademark Examining Attorney to register the mark
VOLCANO ISLAND for the following goods:

Coin-operated gambling machines, namely slot machines, video
slot machines, video gaming machines, electronic card and
poker machines, electronic backgammon; casino apparatuses,
namely computers and computer programs that account for
gambling wagers, computer programs for use in a gaming

environment to improve communication; casino video slot machine accounting software."¹

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the registered mark VOLCANO for "gaming machines, namely, slot machines with or without a video output" as to be likely to cause confusion."²

When the refusal was made final, applicant appealed.³ Briefs have been filed, but an oral hearing was not requested.⁴

¹ Application Serial No. 75/371,661, filed October 6, 1997, based on a claim of priority under Section 44(d) of the Trademark Act and alleging a bona fide intention to use the mark in commerce. Applicant submitted a certified copy of the foreign registration on May 26, 1998 and an amendment to allege use on January 28, 1999 alleging a date of first use on September 13, 1994 and first use in commerce in October 1994.

² Registration No. 1,775,080; issued June 8, 1993; Sections 8 and 15 affidavits filed.

³ The application was assigned to a different Examining Attorney for the appeal brief.

⁴ Applicant's brief was filed on January 28, 2000. On February 3, 2000, applicant filed a declaration in support of acquired distinctiveness under Section 2(f) of the Act. The Board, noting the untimeliness of the request, the failure of applicant to offer any explanation for the delay, and the fact that a claim of acquired distinctiveness is not relevant to the likelihood of confusion basis for refusal, stated in an order mailed May 30, 2000, that the application would not be remanded for consideration of the claim of acquired distinctiveness. Accordingly, any arguments in applicant's brief relating to the acquired distinctiveness of the mark have not been considered. On June 2, 2000, applicant filed another declaration, this time attesting to the lack of "any confusion anywhere relating to the trademark 'Volcano Island'." The declaration is signed by a person identified as the marketing manager of Atronic International GmbH, which, from the references to that entity in applicant's brief, appears to be applicant's own company. This evidence is also untimely and will

Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the relatedness of the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976) and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

The respective goods are in part identical, applicant's goods fully encompassing those in the cited registration. Because the goods are legally identical, they must be deemed to travel in the same channels of trade to the same ultimate users and purchasers. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Applicant does not dispute the identity of the goods but, instead, essentially argues that because of the dissimilarity of the marks and the sophistication of the purchasers, confusion is not likely to occur.

Thus we turn our attention to the marks, keeping in mind that when marks would appear on virtually identical goods or services, the degree of similarity between the marks necessary to support a finding of likely confusion declines. *Century 21 Real*

not be considered, and even if considered would not affect the outcome of this case.

Ser. No. 75/350,146

Estate v. Century Life, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant argues that the differences in meanings associated with the two marks distinguishes the marks and avoids confusion. Applicant claims that VOLCANO and VOLCANO ISLAND are different "geographical concepts," the term VOLCANO referring to "a certain type of mountain" and conveying a sense of "danger" and "menace," and the term VOLCANO ISLAND conveying the meaning of "a quiet place" of "leisure."

We find that the marks VOLCANO and VOLCANO ISLAND are similar in sound, appearance and meaning. Except for the word ISLAND in applicant's mark, the two marks are identical. It has been held that the addition of another word to one of two otherwise similar marks will not serve to avoid a likelihood of confusion particularly where additional word does not significantly change the meaning the terms convey. See *In re Champion International Corporation*, 196 USPQ 48 (TTAB 1977). See also *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), affirmed in unpublished opinion, Appeal No. 92-1086 (Fed. Cir. June 5, 1992); *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985) and *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979).

While the two marks do not project identical images, the combination of VOLCANO and ISLAND only slightly alters the

meaning conveyed by the word VOLCANO alone. Instead of a single volcano, the term VOLCANO ISLAND simply evokes the very compatible image of one or more volcanoes on an island, a place where volcanoes are known to appear. This minor difference in meaning is not sufficient to avoid confusion particularly when we consider that the marks are applied to identical goods. In the context of these goods, the word ISLAND, if noted or remembered at all, is likely to suggest a different version of registrant's VOLCANO game rather than a different source for the game. Moreover, applicant's own specimens, depicting an exploding volcano and the words "explosive volcano bonus," contradict the peaceful, restful image applicant claims the term VOLCANO ISLAND conveys.

Applicant's claim that the presence of its corporate name on the gaming machines serves to indicate the source of the machines in applicant is irrelevant inasmuch as that name is not part of the mark sought to be registered. *Blue Cross and Blue Shield Association v. Harvard Community Health Plan Inc.*, 17 USPQ2d 1075, 1077 (TTAB 1990). Applicant further argues that "even without trademarks, consumers would be expected to distinguish the origin of a gaming machine based on the features of such gaming machine [e.g., a television screen simulating five reels on applicant's machines as distinguished from the mechanical three reels that applicant claims registrant's slot

machines use] even in a complete absence of a trademark." (Brief, pp.8-9). First, the question is not whether purchasers can differentiate the goods themselves but rather whether purchasers are likely to confuse the source of the goods. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Moreover, the question of likelihood of confusion is determined on the basis of the identification of goods set forth in the application and registration, without regard to special features of the goods or other limitations which are not reflected therein. See *J & J Snack Foods Corp. v. McDonalds' Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991) and *Octocom Systems inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Thus, for purposes of this analysis, we must presume that the gaming machines offered by registrant are identical to applicant's machines in all respects.

We recognize that the actual purchasers for these goods would be casino owners or operators or other sophisticated business purchasers who are knowledgeable about the products they are buying. As applicant appears to contend, slot machines are not technically consumer goods "like sugar or salt." Nevertheless, the sophistication of the actual purchasers for these products is not sufficient to avoid confusion in this case.

It is established that confusion among ultimate users of products as well as purchasers is proscribed by Section 2(d) of the Act. In re Artic Electronics Co., Ltd., 220 USPQ 836 (TTAB 1983) and In re Star Pharmaceuticals, Inc., 221 USPQ 84 (TTAB 1984). The ultimate users of slot machines include ordinary members of the general public who are not likely to be sophisticated. In any event, the respective marks and products in this case are so similar that even the sophisticated, knowledgeable purchasers of these machines are likely to believe that the machines come from the same source. See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

We conclude that purchasers familiar with registrant's gaming machines sold under its mark VOLCANO would be likely to believe, upon encountering applicant's mark VOLCANO ISLAND for directly competitive products, that such goods originated with or are somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.