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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Casino Data Systems

Serial No. 76221529

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(Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Casino Data Systems has filed an application to register on the Principal Register the mark "BIG SHOT" for "gaming devices, namely, gaming machines and computer game software therefor."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "BIG SHOT 21," which is registered for "apparatus for

¹ Ser. No. 76221529, filed on March 6, 2001, which is based on an allegation of a bona fide intention to use such mark in commerce.

playing casino card games featuring a progressive jackpot, said apparatus comprised of a modified card table, computer, computer monitors and displays, and associated computer software,"² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.³

Turning first to the similarity or dissimilarity in the goods at issue, applicant concedes in its brief that "the Examiner's statement that the goods are related is true," but asserts that "the only relation in common between the goods is that they are games to be played in a casino." Applicant

² Reg. No. 2,376,008, issued on the Principal Register on August 8, 2000, which sets forth a date of first use anywhere and in commerce of February 23, 2000. The number "21" is disclaimed.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

insists, however, that the respective goods "are used to play decidedly different games and more importantly the registrant has restricted the goods under its mark specifically to card games, namely, the game of '21'." By contrast, applicant maintains that its goods "have nothing to do with the game [of] 21" and, instead, "[o]ne challenge of the game is to line up 3 'Mr. Big Shot' symbols for three spins on the bonus 'reel'." Applicant also notes, by way of background, that (emphasis in original):

Applicant is a developer and manufacturer of gaming machines, including the games played thereon. These gaming machines are marketed to owners and managers of casinos and no one else. Ultimately, the gaming machines are placed on the casino floor for use by the casino's patrons. However, the casino's patrons are never exposed to applicant and are not applicant's target customer. Rather, the target customer is a professional buyer of equipment for placement in a casino environment. The player of the machine, the casino patron who has patronized the casino most likely with the specific purpose of gambling therein, must wager currency to play the game "slot" machines.

Conversely, the registrant ... provides an "apparatus for playing casino *card* games . . . said apparatus comprised of a *modified card table*, computer, computer monitors and displays, and associated computer software["]. Thus ... the registrant's ... goods are only used to play card games, specifically, the card game [of] "21" (also known as "blackjack"). Applicant's goods have nothing to do with the card games, and specifically, have nothing to do with the card game "21" or "blackjack".

We agree with the Examining Attorney, however, that the respective goods are related, such that their sale and/or use under the same or similar marks would be likely to cause confusion as source or sponsorship. As the Examining Attorney

correctly observes in her brief, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as respectively identified in the involved application and the cited registration. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, as the Examining Attorney properly points out, it is indeed the case that, "despite the applicant's description [in its brief] of the specific game intended to be played on its gaming machines, it is presumed that the [applicant's] gaming machines are to be used for playing a variety of games including a version of 'blackjack' or '21'--the game the applicant presumes is played when using the registrant's gaming-type goods."

Moreover, as the Examining Attorney correctly observes, it is well established that in any event the goods at issue need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the respective goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the

marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Here, as the Examining Attorney emphasizes, both applicant and registrant, in the respective identifications of their goods, "identify gaming-type goods for use in casinos--in other words, goods used in gambling or in the play for stakes."⁴ Accordingly, we agree with the Examining Attorney that "even though the goods [at issue] are arguably used to play different games, they are related because they are gaming-type goods for use in casinos."

Turning, therefore, to consideration of the respective marks, applicant concedes that "while these marks may be similar in some respects," confusion is nevertheless not likely to occur from the contemporaneous use thereof because the number "21," which registrant has disclaimed apart from its "BODY SHOT 21" mark apparently on the basis that it is a generic term for the game of blackjack, "is in fact clearly a dominant feature of the

⁴ We judicially notice in this regard that, as requested by the Examining Attorney in her brief, The American Heritage Dictionary of the English Language (3d ed. 1992) defines "gaming" as meaning "[t]o play for stakes; gamble." 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).

registrant's mark and acts to distinguish the goods under the respective marks." Specifically, applicant argues that:

[J]ust because the term "21" has been disclaimed does not necessarily indicate that it is not dominant in the mark, particularly with respect to casino gaming. Patrons of casinos are generally particular and/or finicky as to the particular game to be played when gambling. A gambler who believes that his/her luck is only good when that gambler plays "21" will not likely play any other game in the casino. Conversely, the patron who believes that they will always lose at "21" would likely never play the game. Thus, while at first it may appear that the disclaimed matter is less significant in the registrant's mark because it has been disclaimed, in practice this statement cannot be true. "21" in fact is just as dominant, if not more dominant[,] than "big shot" because it immediately tells the end user what game is to be played. The purchaser of games utilized in casinos is sensitive to these nuances of its patrons and purchases gaming equipment accordingly.

Applicant maintains, in view thereof, that the marks at issue "cannot create the same commercial impression" because "[t]he connotation of applicant's mark of perhaps a 'Big Shot' gambler winning bonus rounds does not create the same commercial impression in the minds of the consumer" as does registrant's mark, which "focuses the casino patrons' attention to the fact that the game to be played is 21 (and no more, no less)."

We concur with the Examining Attorney, however, that when considered in their entirety, applicant's mark "BIG SHOT" is "highly similar" to registrant's mark "BIG SHOT 21" in sound, appearance, connotation and commercial impression due to the fact that the marks, obviously, share the term "BIG SHOT," which contrary to applicant's assertions constitutes the dominant and

source-indicative element of registrant's mark rather than the disclaimed term "21." The latter term, as the Examining Attorney persuasively points out, is at least merely descriptive of, if not generic for, registrant's goods and thus, since it is essentially lacking in source-indicative significance, cannot serve to distinguish the respective marks. See, e.g., In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) [dominant portion of mark "THE DELTA CAFE" and design ("CAFE" disclaimed) for restaurant services is the word "DELTA" since the term "CAFE" is generic and background design element is an ordinary, nondistinctive geometric shape; such mark is so similar in appearance, sound, and meaning to registered mark "DELTA" for, *inter alia*, restaurant services, as to be likely to cause confusion inasmuch as neither the generic term "CAFE" nor the background design element offers sufficient distinctiveness to create a different commercial impression from the registered mark].

Specifically, as the Examining Attorney correctly notes, while the marks at issue must be compared in their entireties, it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of 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, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, "that a particular

feature is descriptive or generic with respect to the involved goods ... is one commonly accepted rationale for giving less weight to a portion of a mark" 224 USPQ at 751. Here, it is precisely because the term "21" identifies a game which may be played with registrant's goods that, as indicated above, causes it to be virtually devoid of any trademark significance as used as part of registrant's mark. It is therefore the case that, as contended by the Examining Attorney, confusion is likely because, overall, the respective marks convey the same commercial impression:

Indeed, it is the fact that the term ["21" in registrant's mark] is descriptive and is of little, if any, trademark significance that causes it to be less significant than the nondescriptive terminology BIG SHOT in communicating the commercial impression. Therefore, as a disclaimed, descriptive element on which the applicant relies in distinguishing its mark from the cited registered mark, the number "21" is incapable of obviating the confusion inherent in the close similarity of the ... marks at issue. It [instead only] serves to clearly identify the type of game played by the registrant's apparatus For this reason, the examining attorney has determined that BIG SHOT dominates the registered mark with respect to the commercial impression communicated. Consequently, the applicant's mark is the same [in commercial impression] as the dominant portion of the cited registered mark.

Applicant urges, nonetheless, that confusion is not likely since the "purchasers of applicant's goods are highly discerning as to the quality and nature of the goods." As mentioned earlier, applicant stresses that its gaming devices, namely, gaming machines and computer game software therefore,

"are used and sold to managers and owners of casinos." In view thereof, applicant argues that:

Purchasers of applicant's gaming devices, who are owners of gaming establishments, purchase with the expectation that the device will generate a particular amount of income for the gaming establishment. Each gaming device is purchased at a cost of thousands of dollars, and owners of such machines generally own thousands of machines. Such an investment requires that the purchasers of such goods approach the purchase with care and sophistication. The buyer inherently must be a discriminating purchaser.

Applicant therefore concludes that its "targeted customers are not likely to be confused as to the source of applicant's goods with respect to registrant's goods."

We agree with the Examining Attorney, however, that applicant's assertions are not persuasive. As the Examining Attorney correctly notes in her brief, even assuming that the closely related gaming apparatus offered by applicant and registrant under their respective marks is purchased only after careful consideration, it nevertheless is well settled that the fact that buyers may exercise deliberation in choosing such goods "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). Moreover, as tellingly pointed out by the Examining Attorney:

[A]pplicant identifies itself as a developer and manufacturer of gaming machines[,]
including the games played thereon.

Therefore, these sophisticated purchasers, [namely,] casino owners and managers familiar with the applicant's extensive efforts in the development and manufacture of gaming machines and games played thereon, are likely to believe that [the marks] BIG SHOT and BIG SHOT 21 identify just two of the numerous games developed and manufactured by the applicant. Clearly, a game with a "blackjack" theme is likely to be included in the applicant's medley of games. Consequently, even these sophisticated consumers are likely to believe that the gaming-type goods of both ... [applicant and registrant] originate from a common source because they bear highly similar marks--marks that are the same except for the informational "21," presumably identifying the specific type of game played on the registrant's goods.

Furthermore, even though casino patrons are not the purchasers of applicant's and registrant's gaming products, it is still the case that they are customers in the sense that they choose to spend money to play the games provided by such goods. As the Examining Attorney points out in her brief, not only is there no evidence to substantiate applicant's speculative assertion that casino patrons are "particular and/or finicky" in their gambling patterns or choice of games to play, but there is nothing which suggests that, in light of the relatedness of the respective gaming apparatus and the substantial similarity in the marks at issue, they would not be likely to believe that such products share a common origin or affiliation. In fact, notwithstanding the absence of the term "21" from applicant's "BIG SHOT" mark, there is nothing which would preclude casino patrons from assuming, for example, that applicant's gaming machines feature a fully electronic version of the same

progressive jackpot card games as provided by registrant's "BIG SHOT 21" gaming apparatus.

Accordingly, we conclude that purchasers and casino patrons, familiar with registrant's mark "BIG SHOT 21" for "apparatus for playing casino card games featuring a progressive jackpot," consisting of "a modified card table, computer, computer monitors and displays, and associated computer software," would be likely to believe, upon encountering applicant's substantially similar mark "BIG SHOT" for "gaming devices, namely, gaming machines and computer game software therefor," that such closely related goods emanate from, or are otherwise sponsored by or affiliated with, the same source. In particular, such consumers would be likely to view applicant's "BIG SHOT" goods as a new or advanced product line from the same source as the producers of registrant's "BIG SHOT 21" apparatus.

Decision: The refusal under Section 2(d) is affirmed.