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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sierra Design Group

Serial No. 78172916

Kirstin M. Jahn of Jahn & Associates for Sierra Design Group.

Alina Morris, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).¹

Before Walters, Rogers and Walsh, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Sierra Design Group has filed an application to register the mark AMERICAN HEROES, in standard character format, on the Principal Register for "gaming equipment, namely, slot machines with or without video output, electro-mechanical gaming machines, electronic gaming machines."²

¹ The examining attorney originally assigned to this application was Verna Beth Ririe.

² Serial No. 78172916, in International Class 9, filed October 15, 2002, based on an allegation of a bona fide intention to use the mark in commerce. The application as originally filed included "interactive video games of virtual reality comprised of computer hardware and

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark AMERICAN HEROES COLLECTION, in standard character format, previously registered for "computer game software,"³ that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

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.

The examining attorney contends that the marks are "highly similar"; that AMERICAN HEROES is the dominant portion of the mark in the cited registration, as the term COLLECTION has little source-identifying significance and is disclaimed; and that, comparing the marks in their entirety, the points of similarity are of greater significance than the points of difference. In support of her contention that COLLECTION is merely descriptive, the examining attorney submitted a definition from an unidentified dictionary of "collection" as, *inter alia*, "a

software; video game machines for use with televisions" in the identification of goods, but this was deleted following the refusal to register.

³ Registration No. 2768209 issued September 23, 2003, to THQ, Inc., in International Class 9. The registration includes a disclaimer of COLLECTION apart from the mark as a whole.

group of objects or works to be seen, studied or kept together"; and copies of third-party registrations for marks including the term COLLECTION, for various items of computer software and games, either disclaimed or registered under Section 2(f) of the Trademark Act or on the Supplemental Register.

The examining attorney contends that the goods are closely related because "software is used to program and run electronic gaming machines such as those used in casinos, and computer game software with casino games is marketed for home use" (brief, p. 4); that "it is common for the same source to provide both computer game software and gaming machines" (*id.*); and that "gaming machines must be considered part of registrant's natural field of expansion"⁴ (brief, p. 5).

The examining attorney submitted third-party registrations and excerpts from various Internet websites in support of her position that "computer software featuring casino slot machines and other casino games are sold directly to consumers for use on home computers." Of the twelve third-party registrations, nine registrations identified various items of gaming equipment and software used in connection therewith. The nature of the software

⁴ The examining attorney provided no evidence or explanation for the argument regarding zone of natural expansion. It is of no obvious merit and, thus, has not been considered.

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listed in the remaining three registrations, which also included gaming apparatus, is unclear. However, the excerpts from various websites, also of record, show computer software, for sale to general consumers, that essentially simulate casino games. The following are several examples:

Monopoly Casino ... Vegas Edition is a complete casino simulation that features a variety of classic gaming experiences, including blackjack, craps, roulette, and keno, all in an amazing 3-D world. Players will feel like they're standing in front of their favorite gaming tables.

[www.yahoo.com]

Masque 101 Bally Slots - Play 100 of the most popular Bally Gaming slot machines from the casino. [www.clubmac.com]

Sierra On-Line Casino Deluxe 2 - Face the intensity, allure and passion of authentic casino gambling - with a secret weapon - on-screen professional advice. Features 6 slot machines, 4 video poker games ... create a realistic casino feel. [www.digitalriver.com]

Casino Master - Casino software that teaches smart casino play, casino rules, casino instruction, and improves your chances of winning! Play and practice 11 casino software games.

[www.bigdaddysoftware.com]

Trump Castle 3 - This all new generation of gambling software offers more games, more features and more realistic action than ever before ... the most authentic casino simulation on the market today! [www.ebay.com]

Applicant contends that, when viewed in their entirety, the two marks are "quite distinct" due to the addition of the last word COLLECTION to the mark in the

cited registration. In support of its position that its goods are very different from those identified in the cited registration, applicant explains that it sells legalized gaming equipment which can be sold only to a licensed casino in a regulated gaming jurisdiction; that "a game used in the gaming industry must be approved by either the respective state gaming commission or a tribal gaming authority and sold to an entity licensed by either of those entities" (brief, p. 5); that the cited registration does not include gaming equipment or software; that software for "games" is very different from software for "gaming"; and that the excerpts submitted by the examining attorney are inapposite because they all "relate to games people can play in their homes or on their computers - there does not appear to be a real or live gaming or wagering element to the games" (brief, p. 6).

Applicant argues, further, that the trade channels and purchasers for the respective products are entirely different, as its products are sold directly to discerning and sophisticated purchasing agents for casinos or approved gaming locations, whereas game software is sold to the general public in the usual retail outlets for such products. Applicant notes that the purchasers of its products know exactly who are the manufacturers in the gaming industry; that the equipment is usually tested by the

prospective purchaser before purchasing it for a casino; and that such sales entail discussions over several months. Members of the general public would not purchase applicant's products; rather, such people would travel to a casino to play, not purchase, applicant's products. Applicant states that a player familiar with registrant's game is not likely to believe that applicant's game at a casino is related thereto and, even if such confusion occurred, after one game the player would surely recognize that both products do not come from the same source.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB

1999) and the cases cited therein. The factors deemed pertinent in this proceeding are discussed below.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. 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 terms of their overall commercial impressions that confusion as to the source of the goods or services 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. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant's mark is identical to the first two terms in the registered mark, AMERICAN HEROES. Given the descriptive nature of the term COLLECTION, which has been disclaimed in

the registered mark, AMERICAN HEROES is the dominant portion thereof, and the term COLLECTION is insufficient to distinguish the marks. There is absolutely no evidence in this record regarding third-party use or registration of AMERICAN HEROES or similar marks for related goods, which might, if it were present, indicate that the registered mark may be a weak mark. Thus, considering the marks in their entirety, we find that the marks are substantially similar and that, if used to identify similar or related products, confusion as to source is likely.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

It is true that registrant's goods and applicant's goods are distinctly different products. However, 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). Thus, it is not necessary that the goods of the applicant and registrant be similar or even competitive to support a finding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Because applicant emphasizes the differences between "games" and "gaming," we take judicial notice of the following definitions from *Merriam Webster's Collegiate Dictionary*, 11th ed., 2003:

Game: 1a(1) - activity engaged in for diversion or amusement; play (2) the equipment for a game.

Gaming: 1 - the practice of gambling; 2a - the playing of games that simulate actual conditions ... b - the playing of video games.

The identification of goods in the cited registration is extremely broad, "computer game software," and could be considered to encompass game software played on home computers or machines dedicated to game playing (e.g., Sony's PlayStation 2), as well as software for the gaming

machines identified in the application. Moreover, the evidence clearly establishes that many of the same games played at casinos and other gaming establishments are available in software packages for the home user. The evidence includes numerous third-party registrations that include both gaming equipment and game software for use in connection therewith.⁵ Thus, we conclude that the goods are closely related.

Applicant argues that the casinos and gaming establishments that purchase applicant's goods do so with knowledge and great care. However, we note that the ultimate users of the gaming machines at casinos represent that portion of the general public perhaps most likely to purchase game software packages that include versions of the same games played at gaming establishments. A player familiar with applicant's game at a casino is likely to believe that registrant's game software is related thereto, because they emanate from the same source, or have common sponsorship.

In addition, because the identification of goods in the cited registration is broad enough to encompass game

⁵ Although third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d

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software for use in gaming machines at casinos, such goods would be sold to the same class of purchasers as applicant's goods. Even though such purchases may be made by knowledgeable persons, we note that sophisticated, knowledgeable purchasers are not immune from confusion when the marks are as similar as these marks and the goods with which they are used are as closely related as the goods herein. See *In re General Electric Company*, 180 USPQ 542 (TTAB 1973).

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

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

1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).