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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Sierra Design Group*

Serial No. 76311622

Kristin M. Jahn of *Jahn & Associates LLC* for *Sierra Design Group*.

Gina M. Fink, Trademark Examining Attorney, Law Office 103
(*Michael Hamilton*, Managing Attorney).

Before *Hanak*, *Hairston* and *Rogers*, Administrative Trademark Judges.

Opinion by *Hairston*, Administrative Trademark Judge:

On September 10, 2001 *Sierra Design Group* applied to register CASINO MERCHANDISING TECHNOLOGY as a trademark for goods described as "networked gaming system comprising gaming machines and accounting and gaming software."¹

¹ Serial No. 76311622. The application was based on applicant's allegation of a bona fide intention to use the mark in commerce. On January 2, 2003, applicant filed an amendment to allege use claiming a date of first use anywhere and a date of first use in commerce of September 14, 2001.

The Trademark Examining Attorney refused registration on the ground that the mark, when used on the identified goods, is merely descriptive of them. The Examining Attorney maintained that the mark merely describes a feature of the goods, namely technology used to promote casinos.

When the refusal was made final, applicant appealed. Applicant subsequently submitted its appeal brief along with a request for reconsideration. In the request for reconsideration, applicant argued that it was clear from the various components of its networked gaming system that the system does not promote casinos or casino games. In this regard, applicant sought to amend the identification of goods to "networked gaming system comprised of computer hardware and software for accounting, player tracking, progressives, inventory, administration, prize pay outs and calculations, security controls, configuration management, prize redemption and cashier support." In addition, applicant offered to disclaim the individual words CASINO and TECHNOLOGY.

The Examining Attorney filed her appeal brief and indicated therein that she was not persuaded by applicant's argument and that she would give no consideration to the proposed amendment or the disclaimers. Thereafter,

applicant filed a reply brief. An oral hearing was not requested.

As indicated above, it is the Examining Attorney's position that applicant's mark CASINO MERCHANDISING TECHNOLOGY merely describes a feature of applicant's networked gaming system. According to the Examining Attorney:

Knowing that the goods are networked gaming systems comprised of gaming machines and accounting and gaming software and that the mark for those goods is CASINO MERCHANDISING TECHNOLOGY, the consumers/examining attorney/public will immediately understand that a feature of those gaming systems is technology to promote casino earnings, or in other words, casino merchandising technology.
(Brief, p. 4).

In support of the refusal, the Examining Attorney has submitted the following definitions from The American Heritage Dictionary of the English Language (3d. 1992):

casino: a public room or building for gambling or other entertainment.

merchandise: (verb) to promote the sale of, as by advertising or display.

technology: the application of science, especially to industrial or commercial objectives.

Further, the Examining Attorney made of record printouts of applicant's internet "home page", and points to statements that say applicant "can increase your

revenue” and “maximize your casino’s operational potential.”²

Applicant, on the other hand, argues that its mark is at most suggestive of its goods. According to applicant, the Examining Attorney has incorrectly characterized applicant’s goods. Applicant argues that its goods, as identified, are not used to promote casinos or casino games, but rather are designed for use by casinos to compile various gaming and accounting information.

The Examining Attorney bears the burden of proving that a mark is merely descriptive of the relevant goods. In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). A mark is descriptive if it “forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” Abercrombie & Fitch Co. v. Hunting World, Inc. 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976). See also: In re Abcor Development Corp., 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the ingredients,

² We note that these statements refer to applicant’s capabilities in general and there is no specific mention of the mark and goods involved in this appeal.

qualities or characteristics of the goods with a degree of particularity." In re Diet Tabs, Inc. 231 USPQ 587, 588 (TTAB 1986); Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949, 952 (TTAB 1981); Plus Products v. Medical Modalities Associates, Inc., 211 USPQ 1199, 1204-1205 (TTAB 1981); and In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1987).

There is no dispute, given the dictionary definitions of record, about the readily understood meanings of the words comprising the mark sought to be registered. We do not believe, however, that the combination of these words results in a phrase which, when considered in its entirety, is merely descriptive of a networked gaming system comprising gaming machines and accounting and gaming software.

As shown by the dictionary definition of record, "merchandis[ing]" involves promoting the sale of goods or services, as by advertising or display. However, there is no evidence that applicant's type of goods, i.e., networked gaming systems comprising gaming machines and accounting and gaming software, are used to promote casinos or casino games. Thus, there is a certain ambiguity about the mark CASINO MERCHANDISING TECHNOLOGY, and no information about any quality or characteristic of the goods is conveyed with

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a degree of particularity. Additional thought or imagination would be required on the part of prospective purchasers in order to perceive any significance of the mark CASINO MERCHANDISING TECHNOLOGY as it relates to applicant's goods.

Further, inasmuch as applicant's proposed amendment to the identification of goods set forth in its request for reconsideration limits the scope of the goods, the amendment is acceptable and will be entered in the application. Also, inasmuch as an applicant is allowed to voluntarily disclaim matter in its application, the disclaimers of the words CASINO and TECHNOLOGY will be entered in the application.

Decision: The refusal to register is reversed.