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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Progressive Games, Inc.

Serial No. 75/359,707

Robert E. Purcell and Kirstin L. Stoll-DeBell of Reilly & Purcell for applicant.

Jeffery C. Coward, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Hanak, Hairston and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

This case concerns an application on the Principal Register for the mark shown below for "casino gaming tables and casino card games."¹ The application includes a disclaimer of PROGRESSIVE BLACK JACK apart from the mark as a whole.

¹ Serial No. 75/359,707, in International Class 28, filed September 19, 1997, based on use of the mark in commerce, alleging first use and first use in commerce as of February 28, 1997. The owner of record of this application is Progressive Games, Inc.



The Examining Attorney has issued a final refusal under Sections 1, 2 and 45 of the Trademark Act on the ground that the subject matter does not function as a trademark to identify and distinguish the goods of applicant from those of others and does not indicate the source of such goods. Additionally, the Examining Attorney has issued a final requirement for the submission of substitute specimens showing trademark use of the subject matter in connection with the goods identified in the application.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Specimens

A copy of the photograph submitted as a specimen in this application is shown below:

Applicant contends that its specimens are adequate because the photograph submitted shows a sign that is affixed to applicant's gaming tables and, further, that this sign constitutes a display associated with its casino card games. Applicant states that the specimen shows "an electronic sign [that] is the equivalent point-of-sale material designed to catch the attention of potential consumers ... and induce consumers to play Applicant's casino card games at Applicant's casino gaming tables." Applicant states, further, that:

Applicant displays its casino gaming tables at trade shows where Applicant seeks to lease its casino gaming tables and license its casino card games to casinos. The electric sign is designed to catch the attention of potential casino lessees, and induce these casinos to lease Applicant's casino table games and casino card games.

The Examining Attorney's argument regarding the unacceptability of the specimens is unclear. In his brief, the Examining Attorney argues that the specimens are unacceptable because the specimens do not demonstrate use of the subject matter as a trademark, i.e., the subject matter is allegedly "buried" in other matter in the sign. Whether or not the subject matter functions as a trademark is addressed below. Although reference is made to the use of the mark on the specimens in determining whether the subject matter functions as a trademark, it is not an issue pertaining to the acceptability of the specimens.

In his final office action, the Examining Attorney argues that the specimens are not acceptable point-of-sale displays because applicant is not actually selling the listed goods. Rather, he argues, applicant appears to offer casino services. The record contains no basis for this conclusion. From the record, it is perfectly clear that applicant does, in fact, offer the identified goods for sale and that the sign displayed in the specimens does function as a point-of-purchase display at trade shows.²

² With regard to the identified goods, there is no evidence in the record indicating whether the patrons of casinos would be considered relevant purchasers of the identified goods, or whether they would be viewing the mark in connection with possible casino gaming services. However, it is not necessary to decide this point as applicant has stated that the signs function as point-of-purchase displays at trade shows.

Whether or not applicant may also offer services in connection with these goods is not relevant herein.

Thus, we find the Examining Attorney's requirement for substitute specimens to be unwarranted.

Use as a Trademark

We turn, next, to the refusal on the ground that the subject matter does not function as a mark to identify and distinguish applicant's goods from those of others and does not indicate the source of such goods. The Examining Attorney contends that the subject matter "is simply buried in the middle of a design and word-filled electronic sign" and, thus, "it is highly unlikely that consumers would extract the particular subject matter of this application from the rest of the sign and attribute trademark significance to [it]."

Applicant contends that the use of the "tm" in connection with the subject matter demonstrates applicant's intent that the subject matter function as a trademark; and that there is no requirement that the subject matter be prominently displayed on the specimen for it to function as a mark.³ Applicant contends, further, that:

³ Applicant argues that it has submitted similar specimens in applications for similar marks without encountering this refusal. The Examining Attorney objects to evidence in this regard submitted with applicant's supplemental brief on the ground that it is untimely. With regard to the evidence, it is untimely and we have not considered it.

since there are two uses of the phrase "progressive blackjack" appearing on the sign, it would be silly to include two such uses of that phrase, unless one of the uses of that phrase was part of a separate distinctive element appearing in the sign [and, that] persons viewing the sign would accord a special significance to one of the occurrences of the phrase "progressive blackjack," especially, where, as here, such a phrase is intertwined in a special, separately identifiable design element.

The term "trademark," as defined in the relevant part of Section 45 of the Trademark Act, means "any word, name, symbol, or device, or any combination thereof used by a person to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

A critical element in determining whether a term is a trademark is the impression the term makes on the relevant public. *In re Volvo Cars of North America, Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998). In the case before us, the inquiry is whether the design sought to be registered is likely to be perceived as a source indicator. In this regard, we agree with applicant. The subject matter is a design that is distinct from the other information and design on the

However, even if it had been considered as part of the record, it would be of little or no persuasive value as each case must be decided on its own facts. Further, the Board will not be bound by decisions made by Examining Attorneys.

sign; it is centered at the bottom of the sign; it is accompanied by the "tm"; and it repeats the words "Progressive Blackjack" appearing elsewhere on the sign. These factors taken together lead us to conclude that the subject matter is used as a trademark on the specimen of record. The Examining Attorney's refusal is reversed.

Decision: We reverse both the refusal under Sections 1, 2 and 45 of the Trademark Act, and the refusal based on the Examining Attorney's requirement for substitute specimens.

E. W. Hanak

P. T. Hairston

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board