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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Aristocrat Technologies Australia PTY Limited

Serial No. 76460409

Scott M. Hervey of Weintraub Genshlea Chediak Sproul for
Aristocrat Technologies Australia PTY Limited.

Sonya B. Stephens, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Bucher, Grendel and Walsh, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Aristocrat Technologies Australia PTY Limited seeks
registration on the Principal Register of the mark **WILD
SUIT** for goods identified in the application, as amended,
as follows:

"gaming devices, namely, gaming machines and
associated software for use therewith, to
enable the gaming machine to run" in
International Class 9.¹

¹ Application Serial No. 76460409 was filed on October 22,
2002 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce.

This case is now before the Board on appeal from the final refusals of the Trademark Examining Attorney to register this proposed mark (i) based upon the ground that the term is merely descriptive when considered in relation to applicant's goods, i.e., that the term WILD SUIT immediately informs potential purchasers about a characteristic or feature of applicant's identified goods, and (ii) based upon applicant's failure to respond unequivocally to the requirement as to whether or not the proposed mark has "any meaning in relation to the goods" as requested under Trademark Rule 2.61(b).

Applicant and the Trademark Examining Attorney each filed a brief on the issues presented in this appeal, but applicant did not request an oral hearing before the Board.

Requirement under 37 C.F.R. § 2.61(b)

In her first Office action, the Trademark Examining Attorney asserted that applicant "must indicate the relevance of the wording 'WILD SUIT,' individually and collectively, in its mark, including whether such term has any significance in relation to the goods." She cited as authority for this request 37 C.F.R. Section 2.61(b).

Applicant responded, " ... that the instant application is based on an intent to use. Applicant's gaming devices

generally feature games based on traditional reel-type slot machine games that may contain features evocative of familiar elements. WILD SUIT has no direct meaning in relation to the identified goods."

In her Final Office action, the Trademark Examining Attorney made this response a basis for refusing registration:

The applicant has failed to indicated [sic] whether the terms, "WILD" and "SUIT," individually have any significance in relation to the goods. Additionally, the applicant's response that "WILD SUIT has not [sic] direct meaning in relation to the identified goods" (emphasis added [by the Trademark Examining Attorney]) is ambiguous. The requirement made in the first Office action was that the applicant [should] indicate whether "WILD SUIT" had any meaning in relation to the goods; not whether "WILD SUIT" had any direct meaning.

At this stage of the prosecution, applicant appeared to be hewing carefully to narrowly-drawn semantics (e.g., "traditional reel-type slot machine games *that may contain features evocative of familiar elements,*" answering a query as to "any meaning" with "no *direct* meaning"), suggesting that applicant was being evasive because it feared that a totally truthful response might well support the statutory refusal under Section 2(e)(1), thereby hurting its chances of getting a registration. The purpose of the Trademark

Examining Attorney's request for more information was most clear. Yet applicant's hair-splitting responses seemed calculated to interject just enough ambiguity into the record to avoid a falsehood while defeating the ability of the Examining Attorney to prove descriptiveness in an Intent-to-Use application without an allegation of use.

Nonetheless, in its request for reconsideration, applicant appears finally to have dropped whatever ambiguity the Trademark Examining Attorney identified in earlier responses, by saying: "The wording WILD SUIT has no significance in relation to the identified goods."

Accordingly, it seems as if applicant has complied with the Trademark Examining Attorney's rather narrowly-worded request for information under Rule 2.61(b).² Hence, as to this refusal to register, we reverse the Trademark Examining Attorney.³

² Given the powerful reach of Trademark Rule 2.61(b), especially when faced with an Intent-to-Use application where applicant appears to be gaming the prosecution, rather than restricting herself to a binary query, the Trademark Examining Attorney might well have required applicant to submit any literature or promotional materials it has on this proposed gaming device, to submit any extant portions of applicant's business plan dealing with bringing this reel-type slot machine to market, while querying which features of non-machine games might be 'evoked' by the anticipated play of this gaming device, etc.

³ Previous counsel proffered all of the quoted responses. Current counsel merely filed the appeal brief.

Descriptiveness

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"]. Hence, the ultimate question before us is whether this term conveys information about a significant characteristic or feature of applicant's goods with the immediacy and particularity required by the Trademark Act.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods

or services. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986).

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when we analyze the evidence, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. In re Abcor, *supra* at 218 ["Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]; In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). Rather, the proper test in determining whether a term is merely descriptive is to consider the alleged mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Intelligent

Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1988) [SCREENWIPE generic for wipes that clean computer and television screens]; In re Tower Tech, Inc., 64 USPQ2d 1314, 1318 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; In re Sun Microsystems Inc., 59 USPQ2d 1084, 1087 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs]. Furthermore, a mark need not describe the full scope of the applicant's goods to be found merely

descriptive. In re Oppendahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371-72 (Fed. Cir. 2004).

Applicant argues that the Trademark Examining Attorney has failed to meet her burden of establishing that applicant's mark is merely descriptive when applied to its goods. Applicant argues that the Trademark Examining Attorney's conclusion is based on assumptions not supported by facts in evidence. While the Trademark Examining Attorney contends that "applicant's gaming machines have a function whereby the player is able to determine the equivalence or value of a suit of cards," applicant argues that it is improper for the Trademark Examining Attorney to base her descriptiveness determination on sheer speculation. Applicant points out that in this intent-to-use application, it has not introduced a specimen or any other material supporting the position of the Trademark Examining Attorney. On the other hand, applicant argues that applicant has "declared under oath that the words WILD SUIT, both individually and collectively, have no significance in relation to the identified goods."

As was the case in an earlier Board decision cited by the Trademark Examining Attorney, In re Copytele Inc., 31 USPQ2d 1540, 1541 (TTAB 1994), "we have of record no

specimens of use nor product literature illustrating applicant's goods." Accordingly, as urged by the Trademark Examining Attorney herein, we must look to dictionary definitions and Internet evidence made of record in order to make conclusions about the likely nature of applicant's goods.

In this case, we start with the Trademark Examining Attorney's dictionary entries of the individual words:

wild (wild) *adjective*

Games. Having an equivalence or value determined by the cardholder's choice.⁴

wild *adjective*

... 7. *of a playing card:* able to represent any card designated by the holder.⁵

wild *adjective*

... 16. **CARD GAMES with value assigned by player:** used to describe a playing card that has any value that the player using it wishes to give it.
• *Jokers are wild*⁶

wild *adjective*

... 17. *Cards* (of a card) having its value decided by the wishes of the players.⁷

wild *adjective*

... 13. *Games.* Having an equivalence or value determined by the cardholder's choice. *Playing poker with deuces wild.*⁸

⁴ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Third Edition 1992.

⁵ MERRIAM-WEBSTER ONLINE DICTIONARY, <http://www.m-w.com/cgi-bin/dictionary?book=dictionary&va=wild>

⁶ MSN ENCARTA, <http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid1861713197>

⁷ <http://infoplease.com/apd/A0738226.html>

⁸ <http://dictionary.reference.com/search?q=wild>

suit (sɪt) *noun*

Games. Any of the four sets of 13 playing cards (clubs, diamonds, hearts, and spades) in a standard deck, the members of which bear the same marks.⁹

suit *noun*

6.a. all the playing cards in a pack bearing the same symbol ... 6.c. all the card or counters in a particular suit held by one player <a 5-card *suit*> 6.d. the suit lead <follow *suit*>¹⁰

suit *noun*

3. CARD GAMES **set of playing cards:** one of four different sets of playing cards in a pack¹¹

suit (PLAYING CARDS) *noun*

any of the four types of cards in a set of playing cards, each having a different shape printed on it: *The four suits in a pack of cards are hearts, spades, clubs and diamonds.*¹²

suit *noun*

5. all the playing cards of a single kind in the deck. Hearts is one suit.¹³

suit *noun*

7. Cards **a.** one of the four set or classes (spades, hearts, diamonds and clubs) into which a common deck of playing cards is divided. **b.** the aggregate of cards belonging to one of these sets held in a player's hand at one time: *spades were his long suit.* **c.** one of various sets or classes into which less common decks of cards are divided, as lances, hammers, etc., found in certain decks formerly used or used in fortune telling.¹⁴

Additionally, the Trademark Examining Attorney provided for the record website printouts showing that the combined term "wild suit" is used to describe a feature of a number of different games played with cards and tiles:

⁹ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Third Edition 1992.

¹⁰ MERRIAM-WEBSTER ONLINE DICTIONARY, <http://www.m-w.com/cgi-bin/dictionary?book=dictionary&va=suit>

¹¹ MSN ENCARTA, <http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid1861716788>

¹² CAMBRIDGE DICTIONARIES ONLINE, <http://dictionary.cambridge.org/define.asp?key=79708&dict=CALD>

¹³ WORDSMYTH DICTIONARY-THESAURUS, <http://www.wordsmyth.net/live/home.php?script=search&matchent=suit&matchtype=exact>

¹⁴ <http://infoplease.com/apd/A0678677.html>

Target® is a rummy game like nothing you've ever played. One deck of 80 "Playing" cards are numbered 0 though 9 in 4 colorful suits, plus a 5th "**wild**" suit, and are used for making melds.¹⁵



If this card is played from your hand, it may be played as if it had any of the four suit powers. On the board, this card has only its own suit power, as described above. All Royalty are treated the same in Zarcana, no matter what their titles. ¹⁶

Cardz is a set of 78 letter cards. There are three basic suits with 22 letters in each suit (one of everything except J, Q, X, and Z). There is also a **wild suit** which has the difficult letters, one of each vowel, and three totally wild cards.¹⁷

Games: Ticket To Ride

... There is also a deck containing cards of nine suits: the eight route colors found on the board, and a ninth "**Wild**" suit. Players start with four of these cards and a pile of small, plastic trains.¹⁸

WILD CARDS

These suits are different than the rest. Any tile in a **wild suit** will match with any other tile in the same suit.¹⁹

BRIDGE

How It Works:

Bridge is played with four people (two sets of partners). The object is to figure out how good your combined hands are. You do this through your bids, which are simple declarations like "two spades." The highest bidder establishes what the "trump," or the **wild suit**, will be, and she must claim as many "tricks" (by playing the highest card or trump) as she predicted she would during the bidding process. Confused? I won't even begin to explain scoring.²⁰

Sentence Building

... Example: Let's say that HEARTS is not assigned a column. If the student has the 4 of Hearts, they [sic] can use only the FOURTH word (because of the number 4) in ANY column (because HEARTS is a **wild suit**).²¹

¹⁵ <http://www.ingenuity.com/target.htm>
¹⁶ <http://www.wunderland.com/WTS/Ginohn/games/Zarcana/rules.html>
¹⁷ <http://www.boardgamegeek.com/game/10764>
¹⁸ <http://www.defectiveyeti.com/archives/000855.html>
¹⁹ <http://www.cmtcanada.com/connect/games/swf/cmt%20mahjongg.swf>
²⁰ <http://www.wweek.com/html/lifefeature060999.html>
²¹ http://www.angelfire.com/blog2/yamajet/new_page_2.htm

Community Card and Wilds:

The suit of the community card is wild. However, the community card itself is not wild. Also, if any player has three or more cards of the **wild suit** in his/her hand, none of those player's cards are wild.²²

A player who keeps an Ace may draw up to 4 cards, otherwise a maximum of 3 new cards is allowed. If 4 cards are drawn to a WILD card, the wild card becomes an Ace with a **wild suit** after the draw.²³

Thus, the earlier dictionary entries demonstrate that both words ("wild" and "suit") individually have descriptive meanings when applied to card games. With these Internet excerpts, the Trademark Examining Attorney has also demonstrated the highly descriptive nature of this combined term as it relates to card games. The combination of the terms "wild" and "suit" in the composite phrase WILD SUIT creates no double entendre, ambiguity or unique commercial impression so as to remove the mark from the category of being merely descriptive in the context of card games. That is, as used in the common parlance, the composite phrase readily and immediately describes a salient feature or characteristic of card games.

Yet, applicant argues that "[n]one of [these] references introduced by the Examiner implicate a computer based gaming machine for use in casinos."

²² <http://21ace.com/phpBB2/viewtopic.php?t=860&highlight=>

²³ <http://archive.mash.acalltoduty.com/index.cgi?5088@mash.acalltoduty.com::191>

We find that applicant's position that this term is only descriptive of games played with actual cards misses the point. While the record shows that a "wild suit" is traditionally a feature of games played with cards, applicant's gaming machines could well incorporate features of such a traditional card game, resulting in a reel-type slot machine that uses card suits and shares other features frequently used when playing traditional card games. If this were the case, then the proposed mark involves no ambiguity or incongruity, and no thought or perception is required to make the mental leap from applicant's proposed mark to its identified goods.

Applicant carefully avoids disclosing anything about the nature of the gaming device, but instead simply contends the games are not what the Trademark Examining Attorney assumes, speculates or concludes that they are. Applicant does not assert that it does not know precisely what the goods are, or will be. However, applicant does contend that the Trademark Examining Attorney is incorrect in her speculation that "that the goods are gaming devices in which the player may determine the equivalence of value of a suit of cards." Applicant's request for reconsideration, p. 1. Applicant asserts that the mark is

not merely descriptive of its goods because its goods are gaming machines and associated software for operating the gaming machines and "this software has nothing to do with cards, the suits of cards, or any equivalency thereof." *Id.* Of course, we are not so much interested in the workings of the "operating software" as we are with the look and feel the casino player experiences when interacting with the gaming device. In this case, the applicant's goods include broadly-identified goods,²⁴ which could clearly include gaming machines in which the player may determine the equivalence or value of a suit of cards (i.e., games which feature a "wild suit"). Moreover, even if an algorithm contained within the software permitted the machine randomly to determine the value of a suit of cards, this term would still be merely descriptive. Accordingly, the Trademark Examining Attorney argues that this proposed mark describes a characteristic or feature of the identified goods.

After careful consideration of the record and the arguments herein, we find the Trademark Examining Attorney's arguments persuasive.

²⁴ We note that applicant amended its identification of goods with an outstanding refusal based on mere descriptiveness, and did not take the opportunity to narrow the identification of goods to eliminate reel-type slot machines that use card suits as the symbols used to create a winning match, for example.

As is industry practice, we assume that applicant's mark will be embossed directly onto the gaming devices where the mark would be seen by the *end-users* on the casino floor. The evidence supports a conclusion that when prospective purchasers encounter this term on applicant's goods, they will immediately know that the game features a "wild suit." Therefore, applicant's term is merely descriptive of its goods.²⁵

Conclusion

We find ourselves in agreement with the position of the Trademark Examining Attorney. Based on this record, we find that the term WILD SUIT used on gaming devices immediately conveys information as to a significant feature of the machine. Stated differently, given the clear meaning of the term WILD SUIT in the context of casino gaming machines, it takes no imagination on the part of a

²⁵ If, as argued by applicant, the Trademark Examining Attorney is indeed wrong in her speculation that the game, as experienced by the player, may feature a "wild suit," perhaps the Examining Attorney should have made the alternate refusal that, in this event, the term would be deceptively misdescriptive of the goods - also under Section 2(e)(1) of the Act. In such a case, it appears that the term WILD SUIT would misdescribe a feature or characteristic of the machine. If prospective end-users of the gaming machine who are acquainted with the concept of a "wild suit" from card games find it plausible that the casino game is played with a "wild suit," they would most likely find themselves misled by this term used in conjunction with such a reel-type slot machine. In re Berman Bros. Harlem Furniture Inc., 26 USPQ 1514 (TTAB 1993) [the term, FURNITURE MAKERS, is deceptively misdescriptive for retail furniture store services, not including the manufacture of furniture].

casino gambler to conclude that the game has a wild suit. Accordingly, we find that Section 2(e)(1) of the Trademark Act bars registration herein.

Decision: While we reverse the refusal to register based on applicant's alleged failure to respond to the Trademark Examining Attorney's request for information under Rule 2.61(b), the refusal to register this mark on the Principal Register under Section 2(e)(1) of the Lanham Act is hereby affirmed.