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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Video Gaming Technologies, Inc.

Serial No. 78294596

Melinda B. Buurma of Howard & Howard Attorneys, P.C. for Video Gaming Technologies, Inc.

Christopher L. Buongiorno, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Quinn, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Video Gaming Technologies, Inc. seeks registration on the Principal Register of the mark **LUCKY LEPRECHAUN** *(standard character drawing)* for goods identified in the application, as amended, as follows:

> computer software and/or firmware for operating games of chance on any computerized platform, namely, dedicated gaming consoles, video and reel based slot machines, and video lottery terminals; gaming devices, namely, gaming machines, slot machines, computerized

bingo machines with or without video output" in International Class 9.[1]

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the mark **LEPRECHAUN'S GOLD** *(standard character drawing)* registered for goods identified as "currency and credit operated slot machines and gaming devices, namely, gaming machines for use in gaming establishments" also in International Class 9, as to be likely to cause confusion, to cause mistake or to deceive.[2]

Applicant and the Trademark Examining Attorney have fully briefed the case, but applicant did not request an oral hearing. We affirm the refusal to register.

Applicant argues that the marks are distinguishable in sight, sound, meaning and commercial impression when considered in their entireties; that the channels of trade

[1] Application Serial No. 78294596 was filed on September 1, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. In an Amendment to Allege Use filed on April 25, 2005, applicant claimed first use of the mark on these goods anywhere and first use in commerce at least as early as September 1999.

[2] Reg. No. 2610753 issued to WMS Gaming Inc. on August 20, 2002, based upon allegations of use in commerce since at least as early as October 1, 2001.

are dissimilar; that the consumers are highly sophisticated purchasers who are not likely to be confused as to the source of the respective goods marketed under these marks; and that the marks have coexisted for four years with no instances of actual confusion.

By contrast, the Trademark Examining Attorney concludes that the two marks create similar commercial impressions; that both marks will be used to identify gaming machines and slot machines; and that applicant and registrant will likely sell these similar goods through the same trade channels to the same classes of purchasers.

Likelihood of confusion

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The marks

Accordingly, we turn first to the *du Pont* factor focusing on the similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant argues that even though the marks both contain the word LEPRECHAUN (or LEPRECHAUN'S), when compared in their entireties, these marks are not confusingly similar.

When viewed in a side-by-side comparison, registrant's mark contains the possessive form of the word "leprechaun's" while applicant's mark does not, the placement of the word LEPRECHAUN['S] is inverted and the respective marks include different secondary terms.[3]

However, we agree with the Trademark Examining Attorney that when considered in their entireties, the respective

[3] As the Trademark Examining Attorney correctly points out, a side-by-side comparison is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general commercial impression engendered by the marks that must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. Accordingly, at least with respect to ordinary purchasers, they normally retain a general rather than a specific impression of marks. *See Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); and *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973).

marks are quite similar in connotation and commercial impression due to the shared presence of the term LEPRECHAUN[’S]. This term appears, at worst, to be slightly suggestive when used in connection with gaming machines. While the respective marks must be considered in their entireties, it is nevertheless proper to recognize that one feature of a mark may be more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). Application of these standards to the instant case indicates that the substantially identical term LEPRECHAUN/LEPRECHAUN’S creates such strong imagery that the connotations associated with leprechauns dominate both marks.

Even the secondary terms in these marks fail to distinguish the marks as to connotation or commercial impression. The Trademark Examining Attorney argues from a series of third-party registrations that these two secondary terms are widely-used terms in naming games of chance in applicant’s and registrant’s fields of gaming:

> Terms such as "lucky" and "gold" are widely used within the gaming and casino industries to promote games of chance and are unlikely to be perceived as additional source indicators that would distinguish both marks.

Moreover, in the specific context of these composite marks, the secondary terms actually create similar meanings and commercial impressions. In applicant's mark, the word LUCKY calls to mind the idea that leprechauns are said to give humans objects which bring "luck" or good fortune.[4] We notice that the trade dress on applicant's gaming machine shows the image of a leprechaun's head in the same frame as an overflowing pot of gold. Similarly, while the meaning and commercial impression created by the registered mark is dominated by the identical term LEPRECHAUN'S, the addition of the word GOLD calls to mind the same idea, namely, that leprechauns have hidden pots of gold. The trailing word GOLD reinforces the dominant mythologies surrounding leprechauns but creates no disparate imagery to impact the meaning or commercial impression of the registered mark.

[4] We take judicial notice of dictionary entries for the word "leprechaun": "2. a conventionalized literary representation of this figure as an old man who will reveal the location of a hidden crock of gold to anyone who catches him." *THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE* (Second Edition, Unabridged, 1987), p. 1102; "a mischievous elf of Irish folklore usu. conceived as a shoemaker and believed to reveal the hiding place of treasure if caught." *WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY OF THE ENGLISH LANGUAGE* (Unabridged 1993), p. 1295.

The goods

Applicant is right in arguing that the respective goods are not necessarily related simply because they coexist in the same broad industry. As argued by applicant, registrant's involved goods carrying the LEPRECHAUN'S GOLD mark are three-reel "slot machines" – class-3 devices for Las Vegas-style casinos. We also accept as true applicant's representations that its LUCKY LEPRECHAUN machines are class-2 devices. Nonetheless, that is not the end of our inquiry on the *du Pont* factor focusing on the relationship of the goods.

As our primary reviewing court has often stated, the question of likelihood of confusion is determined on the basis of the identification of goods and services set forth in the application and registration, rather than on the basis of what evidence might show the actual nature of the goods and services or purchasers to be. *See J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889 (Fed. Cir. 1991); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783 (Fed. Cir. 1990).

There are no limitations in applicant's identification of goods as to classes of machines. In fact, on its face, applicant's identification of goods is broad enough to

include both class-2 (electronic bingo) and class-3 (electronic slot machine) gaming devices. Moreover, it stands to reason that over the years, technology continues to blur the distinctions between these classes of machines.

Channels of trade

In its appeal brief, applicant states that the gaming industry is highly regulated, and argues that as a result, the trade channels for these types of machines are different. However, neither applicant's nor registrant's identifications of goods are restricted as to trade channels or classes of purchasers, so we must presume that the goods move through the same or similar trade channels to the same or similar classes of purchasers. Additionally, the record contains no evidence to demonstrate how the operation of these different classes of regulated machines move to casinos, bingo parlors, etc., and exactly what impact, if any, that would have on the trade channels or classes of purchasers for the respective goods herein.

Sophisticated purchasers and users

As an additional consideration, applicant contends that confusion is unlikely because purchasers of gaming machines are knowledgeable, sophisticated consumers who are familiar with the industry, with the different classes of gaming

devices, and with the manufacturers and vendors of equipment that they are accustomed to dealing with. As noted by applicant, "[T]he cost of these goods range in the thousands of dollars and are not the type of goods that would be purchased casually by … ordinary consumers."

Assuming that at least some purchasers of gaming machines are highly sophisticated and discriminating consumers, we observe that the fact that consumers may exercise care or thought in choosing the respective products "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). Here, the overall commercial impressions engendered by applicant's LUCKY LEPRECHAUN mark and registrant's LEPRECHAUN'S GOLD mark are so similar, due to the shared imagery derived from the term LEPRECHAUN['S], that the contemporaneous use thereof in conjunction with gaming machines, is likely to cause confusion, even among knowledgeable and discriminating consumers of such goods.

We find, however, that even if the initial purchasers of applicant's gaming devices are professional, careful

purchasers (for example, employees or agents of casinos, bingo parlors and other gaming establishments), the classes of consumers for applicant's and registrant's gaming devices also include the ultimate users of such gaming devices, i.e., the patrons of the casinos and other gaming establishments who encounter and use applicant's and registrant's gaming devices. *See In re Artic Electronics Co., Ltd.* 220 USPQ 836 (TTAB 1983) [although the initial purchasers, i.e., owners of arcades, are sophisticated and careful purchasers of arcade games, in determining likelihood of confusion, consideration must also be given to the ultimate users of the arcade games, i.e., the arcade's customers who are the end users of the goods].

Similarly in this case, in determining likelihood of confusion, the classes of purchasers for applicant's and for registrant's gaming devices include not only the sophisticated initial purchasers of the gaming devices themselves, i.e., casinos and other gaming establishments, but also must include the ultimate users of such gaming devices, i.e., ordinary customers of bingo parlors and casinos. Given the fact that slot machines, electronic bingo games and other gaming devices require a relatively small financial commitment to begin play, these ultimate users of gaming devices must be deemed to be ordinary

consumers and impulse purchasers who do not exercise more than an ordinary degree of care in deciding to play gaming devices in a casino or other gaming establishment. Applicant's detailed description of the quirky behavior of gamblers contained in its briefs does not convince us otherwise. And while we have no evidence as to different classes of customers, even if we should accept applicant's position that it and registrant are marketing different classes of machines, we must conclude that casino patrons playing a class-3 game betting against the house are also likely at some point to be users of class-2 bingo games playing against other players.

Contemporaneous use without actual confusion

As to the *du Pont* factor dealing with the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, applicant points to four years of coexistence without any actual confusion. However, we have no evidence that these respective marks have ever been used contemporaneously in the same geographical area. As to whether there has been sufficient opportunity for confusion to occur, the record contains no indication of the level of sales or advertising by applicant. The absence of any instances of actual

confusion is a meaningful factor only where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. Similarly, we have no information concerning the nature and extent of registrant's use, and thus we cannot tell whether there has been sufficient opportunity for confusion to occur, as we have not heard from the registrant on this point. All of these factors materially reduce the probative value of applicant's argument regarding asserted lack of actual confusion. Therefore, applicant's claim that no instances of actual confusion have been brought to applicant's attention is not indicative of an absence of a likelihood of confusion. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In any event, we are mindful of the fact that the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion.

Conclusion

After careful consideration of the relevant *du Pont* factors, we concur with the Trademark Examining Attorney's

conclusion that a likelihood of confusion exists. Prospective purchasers and users are likely to assume, incorrectly, that applicant's LUCKY LEPRECHAUN gaming machines are produced by the same entity that produces registrant's LEPRECHAUN'S GOLD gaming machines. Even assuming that customers of gaming machines remember the differences in sound and appearance between these respective marks, it is still the case that the suggestive term LEPRECHAUN, when combined with the respective secondary terms, results in marks that overall are so similar that, for example, consumers familiar with registrant's LEPRECHAUN'S GOLD mark for gaming machines could reasonably assume, upon encountering applicant's LUCKY LEPRECHAUN mark for gaming machines, that applicant's goods constitute a new or additional line of gaming machines from registrant. Confusion as to origin or affiliation is therefore likely to occur from the contemporaneous use of these respective marks in connection with identical and otherwise closely related goods.

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