

RESPONSE TO OFFICE ACTION

Applicant submits this response to the September 12, 2019 Office Action in the instant application, Serial No. 88478636, in which the Trademark Office required a disclaimer of “Cash” in applicant’s mark “CAI SHEN CASH.” The Examiner also incorrectly determined that the applicant’s mark may cause consumer confusion with the marks in the two pending cited applications requesting registration of the marks “CAI SHEN FISHING.” Applicant has provided the requested disclaimer of “Cash” and submits, as will be shown below, there is no likelihood of confusion between applicant’s mark and the marks in the cited applications.

I. DISCLAIMER OF “CASH”

Applicant has disclaimed the exclusive right to use “Cash” apart from the mark as shown in this application in the form of response that is filed simultaneously herewith as required by the Examiner.

II. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE MARKS IN THE CITED APPLICATIONS AND APPLICANT’S MARK

In this case, the question is whether an appreciable number of consumers who encounter the mark “CAI SHEN CASH” for the following goods, -- “gaming machines, namely, devices which accept a wager” are likely to believe those goods were sold by or were otherwise associated with the mark “CAI SHEN FISHING” for “downloadable computer game software for gambling machines...recorded computer gaming software for recreational game playing purposes; downloadable virtual reality game software...” in Class 009 and “...leasing of electronic gaming machines for gambling...arranging of contests featuring casino games...providing online non-downloadable computer software” in Class 041 owned by Jumbo Technology Co., Ltd. As discussed below, an analysis of the *DuPont* factors demonstrates that there is no likelihood of confusion between applicant’s mark “Cai Shen Cash” and the marks in the cited applications for “Cai Shen Fishing” Specifically: (1) the marks are different in their sound, appearance, meaning and connotation; (2) the terms “Cai” and “Cai Shen” in the marks are weak in view of the large number of similar marks in use in commerce for gaming related goods and services that include these terms resulting in a narrow scope of protection for the cited applicant’s marks, and (3) that numerous “Cai” and “Cai Shen” marks co-exist on the USPTO Register for gaming related goods and services, supports applicant’s position that likewise its mark is not confusingly similar with the marks in the cited applications.

A mark is only likely to cause consumer confusion under Section 2(d) if confusion is “probable,” and not merely if confusion is “possible.” Whether or not confusion is probable is determined based on an analysis of the factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973) (“The *DuPont* factors”). The Examiner cites the similarity of the marks and similarity of the goods as the countervailing factors upon which the rejection is based. However, these are not the only factors set forth in *DuPont*. Rather, the *DuPont* factors also include: (1) the similarity between the marks as to sound, appearance and meaning; (2) the similarity or dissimilarity and nature of the of the goods; (3) the conditions under which and buyers to whom sales are made; (4) the number and nature of similar marks; (5)

the extent of potential confusion; (6) any other established fact probative of the effect of use. The *DuPont* factors are generally applied on a case-by-case basis, the fundamental inquiry being “the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (CCPA 1976); *see also Toro Co. v. GrassMasters Inc.*, 66 USPQ.2d 1032, 1035-36 (TTAB 2003). An examination of all of those factors relevant to the instant case indicates there is no likelihood of confusion.

A. The Marks “CAI SHEN CASH” and “CAI SHEN FISHING” are Dissimilar.

The differences in the marks should be analyzed based on the relevant features of the marks, including appearance, sound, connotation, and commercial impression. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 U.S.P.Q..2d 1001, 1003 (Fed. Cir. 2002).

Whether a likelihood of confusion exists depends ultimately on the overall impression the marks leave on consumers. In evaluating overall impressions on consumers, each mark must be viewed as a whole and in its entirety, and not judged by or dissected into its individual components. *Professional Art Distribution, Inc. v. Internationaler Zeichenverbank Fur Kunstdruckpapier*, 878 F.2d 1445 (Fed. Cir. 1989); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); *see also Massey Junior College, Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402 (CCPA 1974); J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Comp.*, § 23.41 (4th edition) (hereinafter “McCarthy”); *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 U.S.P.Q..2d 1687, 1688 (Fed. Cir. 1993) (anti-dissection rule).

Here, when compared to the cited applications for the marks “Cai Shen Fishing” and the mark “Cai Shen Cash,” the marks are undeniably different in sound, appearance and connotation.

Although both marks include the terms Cai Shen as the first terms in both marks, when considering applicant’s mark “Cai Shen Cash” and the cited applications for the marks “Cai Shen Fishing,” the marks sound very different. The marks also have different meanings and have different appearances.

Applicant’s mark includes the term “Cash” after Cai Shen. Cash is defined as 1) money in the form of coins or banknotes, especially that issued by a government. The cited applicant’s marks includes the term “fishing” after “Cai Shen.” Fishing is defined as 1) the act of catching fish, the technique, occupation, or diversion of catching fish, a place or facility for catching fish. See the Declaration of Ellen J. Tenud in Support of Response to Office Action (hereinafter the “Tenud Decl.”) attached hereto, which includes the dictionary definitions of “Cash” and “Fishing” at Exhibit “A.” Thus, the two dissimilar terms in each mark sound different, have a different meaning, have a different appearance and importantly result in different connotations derived from each mark.

Perhaps most importantly, the marks have different connotations. Applicant’s mark connotes a God of wealth bestowing cash, money or rewards upon the player of the game when the game is played and won. Although the term “cash” in the mark is weak in that it describes a characteristic of an item that can be won using the goods, this term is still a part of the mark as a whole and creates an impression on the consumer because it affects the connotation of mark.

Conversely, the applicant's cited marks include the dominant term "Fishing" emphasizing that when the game is played it will include the act of catching fish, which adds a unique connotation to the mark not associated with the applicant's mark. The connotation of the cited marks is that of a God or deity in the act of catching fish or in a place for catching fish. In fact, the theme of the cited applicant's game revolves around the act of catching fish. The cited applicant's game is available on JDB Gaming's website which includes an image and description of the game "...Enjoy the fascination of catching fish with the Wealth God and traveling among the tropical oceans to reverse your luck..." See the below image and advertising obtained from the website <https://www.jdbgaming.com/en/game/Fishing/财神捕鱼> on March 5, 2020:



CAI SHEN FISHING
 Other games

JDB's new online fishing game CAI SHEN FISHING is one with great quality and enables players to receive points in great multiples. Enjoy the fascination of catching fish with the Wealth God and traveling among the tropical ocean to reverse your luck! Players have the opportunity to win 200-multiple lucky prizes! Come to join this CAI SHEN FISHING to become richer!

The above image is also available on the cited applicant's website at https://www.jumbogames.com.tw/product_detail.php?SID=57. The cited applicant's website also includes a video of the game from which the below screenshots were obtained on March 5, 2020:



Succinctly stated, the object of the cited applicant's game is to shoot and catch the fish to win points. Thus, the game connotes that the Wealth God along with the player is fishing for points by shooting and catching fish in the ocean to win the game or accumulate points in the game.

Clearly, fishing in the cited applicant's marks has a much different connotation than applicant's mark and the dominant theme of the game in the cited marks is that of fishing in the ocean with a wealth God.

Because the marks sound different, look different and also create completely different commercial impressions, consumers are not likely to automatically believe that the marks emanate from the same source. Conversely, consumers will associate the "Cai Shen Cash" mark with applicant and the cited applicant's fishing game "Cai Shen Fishing" mark with the cited applicant.

The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear).

The importance of evaluating the connotation of marks when performing a likelihood of confusion analysis is exemplified by the Federal Circuit in *Coach Services, Inc. v. Triumph Learning LLC*, 668 F3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012). In *Coach* the Court determined that use of the mark "COACH" for educational materials on the one hand and for leather handbags, fashions and accessories on the other hand were not likely to be confused. While the two "COACH" marks had the same appearance and sound, their connotation was held different. The *Coach* decision illustrates that differences in connotation alone can eliminate the likelihood of consumer confusion, even when the marks are identical, which is certainly not the case here.

Accordingly, when comparing in their entireties the cited marks to "CAI SHEN CASH" the differences undercut any likelihood of confusion.

B. Numerous Similar Marks are in Use in Connection with Substantially Identical Goods and Services.

Because of the existence of many marks for gaming goods and services that include the terms "Cai" or "Cai Shen" coupled with other words, the slightest difference in these "Cai" and "Cai Shen" marks makes all the difference in the analysis of likelihood of confusion. Consumers have been trained to distinguish between the various Cai Shen marks based on minor differences. Thus, consumers will not be confused when seeing the marks "Cai Shen Cash" for the applicant's goods and "Cai Shen Fishing" when used in connection with the cited applicant's goods and services. During the examination of an application, the Examining Attorney should consider separately each registration found in a search of the marks registered in the USPTO that may bar registration of the applicant's mark under §2(d). If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion. TMEP §1207.01(d)(x) [emphasis added].

As discussed above and more fully below, the terms “Cai Shen” are commonly used in the gaming industry as marks on gaming related goods and services. Consumers do not associate “Cai Shen” with only one particular source of these types of goods. The relevant consumers know that most gaming manufacturers commonly use Cai Shen in their marks and as a feature of their games for their goods and services related to gaming equipment and gaming services.

Evidence of third-party use falls under *DuPont* factor (6) – the “number and nature of similar marks in use on similar goods.” *Du Pont*, 476 F.2d at 1361, 177 USPQ at 567. “[N]umerous third-party uses...demonstrate that the purchasing public has become conditioned to recognize that many businesses in the [relevant] fields use the term...and that this purchasing public is able to distinguish between these businesses based on small distinctions among the marks.” *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ.2d 1477 (TTAB 1987). Thus, the more crowded the field, the less likely junior uses will trigger a likelihood of customer confusion. *McCarthy* § 11:76. That is, in a crowded field, customers will not be confused between any two of the crowd and may have learned to carefully pick out one from the other. *Miss World (UK), Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 8 USPQ.2d 1237, 1241 (9th Cir. 1988).

For example, the TTAB has held that the field of trademarks in stripe designs on sports shoes is a “crowded” field. Widespread use by different firms of a plethora of similar stripe designs “has narrowed the breadth of protection” afforded each mark such that any one such design on sports shoes is limited to substantially that identical design. *Puma-Sportschuhfabriken Rudolf Dassler, K.G. v. Superga S.p.A.*, 210 USPQ 316 (TTAB 1980), denying modification of *Puma-Sportschuhfabriken Rudolf Dassler, K.G. v. Superga S.p.A.*, 204 USPQ 688 (TTAB 1979); see also *In re Lucky Co.*, 209 USPQ 422 (TTAB 1980) (“[T]his complete saturation of the market with somewhat similar stripe and bar designs leave[s]...manufacturers of athletic shoes engaging in such practice with marks that are extremely weak and certainly entitled to only a very narrow and limited scope of protection....This means that competitors in this field may come closer to such weak marks without violating the owner’s rights therein than would be the case with a stronger mark”); *Puma-Sportschuhfabriken Rudolf Dassler, K.G. v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980); *In re Jeanne & Kim Chung Co.*, 226 USPQ 938 (TTAB 1985).

McCarthy has also reviewed the “crowded field” issue at § 11:85 *et seq.* Terms that are in common use by many sellers as marks, are not entitled to the same scope of protection as strong marks. These types of marks are often regarded as relatively weak marks and are given a relatively narrow scope of protection. *McCarthy* cites Chief Judge Nies:

Where a mark is commonly used on numerous types of goods and services by different companies, a term such as PREMIUM, SUN, BLUE RIBBON, NATIONAL, GIANT or AMERICAN, it may be reasonable to infer in some situations that purchasers have been conditioned to expect different sources for specifically different goods or services even though such goods or services might be deemed sufficiently related to be attributable to a single source under an uncommonly used mark.

McCarthy § 11:86 (citing *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ.2d 1424, 1430 (Fed. Cir. 1991) (in such situations, “it is reasonable to

infer that [the relevant public] may have become conditioned to draw fine lines between sources of ‘related’ goods or services”).)

Applicant has provided evidence regarding third party use of the terms “Cai” and “Cai Shen” (and the translation of Cai Shen which is God of Wealth) as these terms relate to gaming related goods and services. A review of applicant’s Exhibit “B” attached to the Tenud Decl. clearly shows that there is use of the terms “Cai,” “Cai Shen” and “God of Wealth” coupled with other terms all of which are related to applicant’s and the cited applicant’s industry.

Exhibit B includes copies of print-outs obtained from the United States Patent and Trademark Office’s (“USPTO”) publicly available site “TESS” (www.uspto.gov) for active registrations and pending applications which include the term “Cai,” “Cai Shen” or “God of Wealth” for gaming related goods and services not cited by the Examiner in the Office Action.

Mark	Owner	Goods/Services	Status
Fu Gui Cai Shen (English translation God of Wealth)	International Games Systems Co. Ltd.	Computer game programs...game software... and Electronic games services provided by means of the Internet	Registered
Jewels of Cai Shen (English translation of Cai Shen Chinese God of Prosperity)	SG Gaming, Inc.	Gaming machines	Registered
CAI FU JOURNEY	Ainsworth Game Technology	Gaming machines for gambling... and ...providing online games for playing games of chance	Registered
Cai Fu Juan Zhou (English translation Wealth or Riches and Scroll)	Design Works Studios, LLC	Downloadable computer game software for gambling machines... and Gaming services	Registered
Caifu Zhi Wu (English translation Dance of Wealth)	King Show Games, Inc.	...downloadable gaming software that generates or displays wager outcomes of gaming machines...	Scheduled to publish for opposition March 31, 2020

Mark	Owner	Goods/Services	Status
Cai Lai Si Ji (English translation Wealth Comes with Four Seasons)	Konami Gaming, Inc.	Electronic gaming machines...	Registered
Cai Yun Heng Tong (English translation here's to good luck and money)	IGT	Gaming machines...	Registered
Goddess of Wealth	SG Gaming, Inc.	Gaming machines...	Registered
Choy Sun Jackpots (English translation of Choy Sun is God of Wealth – Jackpots disclaimed)	Aristocrat Technologies	Electronic gaming machines...	Registered
Choy Sun Ci Fu (English translation God of Wealth Blessings)	Aristocrat Technologies	Electronic gaming machines...	Registered
Choy Sun Ci Fu (English translation God of Wealth is Coming)	Aristocrat Technologies	...gaming machines and computer software used therewith	Registered

Importantly, the USPTO granted registrations (some of which have been found to be in use at common law) and approved the pending application for publication for the marks listed above. Thus, all of these marks co-exist on the USPTO Register and in commerce without any consumer confusion as to the source of the goods under these marks. Applicant's mark "Cai Shen Cash" can likewise co-exist with these marks and the marks in the cited applications without causing consumer confusion as to the source of the goods thereunder.

Exhibit C to the Tenud Decl. shows common law third party use of "Cai Shen" marks and includes copies of screen shots of research results conducted on Goggle for gaming related goods and services that are branded with marks that include the terms "Cai Shen" and that are owned and used by various third parties, some of which own the above-identified registrations.

Importantly, Habanero Gaming developed a slot game available online that is branded with the mark "Fa Cai Shen." Exhibit "C" attached to the Tenud Decl. includes images of the mark in use, one of which is depicted below. (Images obtained from <https://www.slotsup.com/free-slots-online/fa-cai-shen-habanero>).



DLV developed an online slot game branded with the mark Cai Shen. See the image included in Exhibit C and shown below (obtained at <https://www.vegasslotsonline.com/dlv/cai-shen/>):



Genesis Gaming branded one of its slot games with the mark “Cai Shen Fortune.” See the use of the mark at <https://trustgamblers.org/free-slot/cai-shens-fortune/> (an image of the game is also included in Exhibit C and shown below).



Pragmatic Play developed an online slot game branded with the mark “Caishen’s Gold.” See use of the mark at <https://www.slotsup.com/free-slots-online/caishens-gold-pragmatic> and the image included in Exhibit C and shown below:



Moreover, additional third party use of marks that include “Cai Shen” for gaming related goods, i.e., online and physical slot games and gaming software, exist at common law. For example Skywind Group’s slot games branded with the marks “Cai Shen Ye” (see <https://slotspot.com/online-free-slots/cai-shen-ye-skywind-group/>), “Ku Xuan Cai Shen (see <https://slotspot.com/online-free-slots/ku-xuan-cai-shen-skywind-group/>) and “Ying Cai Shen (see <http://www.mrgamez.com/skywind/ying-cai-shen/>). Euro Games Technology’s slot game “Cai Shen Kingdom” is available on many websites on the Internet (see for example <https://www.youtube.com/watch?v=UNjUihN5ims>).

Red Rake Gaming branded one of its slot games with the mark “Cai Shen 88.” See <https://newslotgames.net/red-rake/cai-shen-88.html> and <https://www.redrakegaming.com/slots/cai-shen/> and the below image of the mark:



The above image was obtained on 3/3/2020 at <https://www.redrakegaming.com/slots/cai-shen/>.

Spade Gaming brands its slot games with marks that include “Cai Shen,” for example, “Cai Shen 888” and “Baby Cai Shen.” Below is an image of the game “Cai Shen 888” obtained from <https://www.youtube.com/watch?v=pEIL833zZc8> showing the mark during game play.



Images of all of the above discussed marks are included herewith in Exhibit C to the Tenucl Decl. Exhibit C also includes images of the slot games “Cai Shen Four” owned by Ganapati Gaming, “Cai Shen Arrival” by Betsoft, “Fu Cai Shen” by Booongo, “Caishen Bingo” by JDB Gaming, “Cai Shen Mystery” by Weiki Gaming Technology, “Jewels of Cai Shen” by SG Games and “Cai Shen Dao” by SA Gaming. Also included in Exhibit C to the Tenucl Decl. are links to all of the websites where information regarding these games and images of these games were obtained and the dates on which they were obtained.

The evidence of third party “Cai Shen” marks provided in Exhibit C and included hereinabove in this Response to Office Action shows that the term “Cai Shen” as it relates to gaming goods and services is a diluted term, which weakens the strength of the cited applicant’s marks. Simply said, because of the weakness of the marks, consumers can discern between very similar marks for the identical goods. The cited applicant’s marks are weak and only afforded a very narrow scope of protection, such that no likelihood of confusion exists here.

Accordingly, applicant has presented for the Examiner's review convincing evidence of third party use of the term "Cai Shen" all of which are related to both the cited applicant's and applicant's industries. For this reason, *DuPont* factor (6) weighs heavily in favor of permitting registration of applicant's "CAI SHEN CASH" mark.

C. The Existence of Similar Marks on the USPTO Register for Related Goods and Services Supports Applicant's Position that its Mark Should Also be Allowed to Proceed on the Register.

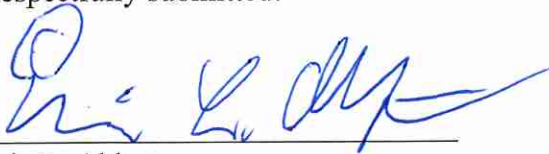
That the marks "FU GUI CAI SHEN," "JEWELS of CAI SHEN," "CAI FU JOURNEY," "CAI FU JUAN ZHOU," CAIFU ZHI WU," "CAI LAI SI JU" and "CAI YUN HEN TONG" for related goods owned by different third parties exist on the register and were not found likely to be confused supports applicant's position that likewise its mark is not confusingly similar with the marks in the cited applications. Based on how the USPTO has treated similar marks in the past, Applicant's request for registration of the mark "Cai Shen Cash" should likewise be granted registration and the citation to the pending applications should be withdrawn.

III. CONCLUSION

Applicant submits that the mark "Cai Shen Cash" is *not* likely to cause consumer confusion with the marks in the cited applications. Accordingly, the undersigned respectfully requests that the Examining Attorney enter the disclaimer provided in response to this Office Action and withdraw the citation to the pending applications, and pass the mark for approval by publication and further processing by the Trademark Office. All issues raised by the Examiner in the Office Action have been addressed in this Response to Office Action.

Should the Examining Attorney have questions with regard to undersigned's position, require further evidence or believe that other issues remain that would benefit from a conversation with the undersigned, the Examining Attorney is invited to contact him by telephone to resolve any such remaining issues.

Respectfully submitted:



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