

## **RESPONSE TO OFFICE ACTION DATED JULY 19, 2021**

The Applicant, Betfair Interactive US LLC (“Applicant”), by and through its undersigned counsel, respectfully submits this Response to the Office Action issued on July 19, 2021 (“Office Action”) in connection with U.S. Application Serial No. 88/472,643 (“Subject Application”) for the mark SAME GAME PARLAY (“Subject Mark”).

### **I. INTRODUCTION**

In the Office Action, the Examiner refused to register the Subject Mark in connection with Applicant’s goods in Class 9 for *downloadable electronic game software for use on mobile and cellular phones and handheld computers* and services in Class 41 for *providing online computer games; betting services; gambling services; entertainment services, namely, providing a website for online gambling; gaming services in the nature of online gambling and conducting online computer game tournaments*, and Class 42 for *computer services, namely, creating an on-line virtual environment for sports betting*, on the Supplemental Register, because the Examiner found that the Subject Mark is generic and thus incapable of distinguishing Applicant’s goods and services.

However, as explained below, the Subject Mark is not generic because it has trademark significance, and the relevant public understands and refers to the Subject Mark as a source identifier of the goods and services offered by Applicant’s affiliate. *See* Applicant’s Statement of Use and Specimen for affiliate information. Given the Examiner previously found the Subject Mark to be descriptive in the Office Action dated February 19, 2021 and issued an advisory to amend the application to the Supplemental Register—which Applicant so accepted and adopted—Applicant respectfully requests the Examiner to allow registration of the Subject Mark in U.S. Application Serial No. 88/472,643 on the Supplemental Register.

### **II. THE SUBJECT MARK IS NOT GENERIC**

The Examiner has the initial and high burden to show, with clear and convincing evidence, that a proposed mark is generic. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1576, 1571 (Fed. Cir. 1987); *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016).

The question of whether a mark is generic is a question of fact. *In re Cordua Rests., Inc.*, 823 F.3d 594, 599 (Fed. Cir. 2016). It is well established that any doubt on the issue of the genericness of a mark must be resolved in favor of the applicant. *See In re Tennis Indus. Ass'n*, 102 U.S.P.Q.2d 1671, 2012 WL 1267923\*12 (T.T.A.B. 2012). “A mark is generic if its primary significance to the relevant public is the class or category of goods or services on or in connection with which it is used.” TMEP § 1209.01(c)(i); *see H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986).

Registration of the Subject Mark on the Supplemental Register cannot be refused unless the Examiner has determined the genus of Applicant’s goods and services at issue and has shown by clear and convincing evidence that the relevant public understands the Subject Mark *primarily* to refer to that genus of goods and services. TMEP § 1209.01(c)(i); *H. Marvin Ginn Corp.*, 782 F.2d at 989-90, 228 USPQ at 530.

In the Office Action, the Examiner identified the genus of Applicant’s services as “downloadable game software, online games, betting, and gambling, and computer environments for betting,” which is overly broad and overlooks the *services* aspect of most of the applied-for-services in the Subject Application. Indeed, the applied-for-services in the Subject Application include: downloadable electronic game software for use on mobile and cellular phones and handheld computers; *providing* online computer games; betting *services*; gambling *services*; entertainment *services*, namely, providing a website for online gambling; gaming *services* in the nature of online gambling and conducting online computer game tournaments; computer *services*, namely, creating an on-line virtual environment for sports betting. (*See* Subject Application). Accordingly, the appropriately defined genus of Applicant’s services is not simply online games, betting, or gambling, and is for downloadable electronic game software and *providing or offering* betting, gambling, entertainment, gaming, and computer *services*, as listed in the Subject Application. Applicant offers a specific form of betting-related software under the name “Same Game Parlay;” it should be understood in that context.

As to step two of the genericness inquiry, the relevant public understands the Subject

Mark to be a source identifier of the services offered by Applicant's affiliate and *does not* understand the Subject Mark to be generic for the genus identified by the Examiner or Applicant. *See* Applicant's Statement of Use. Applicant (FanDuel or FanDuel Sportsbook) is recognized as a pioneer in the online gambling services field related to correlated wagers on single sports games in the United States, and its offerings and consistent use of the Subject Mark as a trademark has resulted in the public understanding the Subject Mark to be a source identifier of the goods and services offered by Applicant and its affiliates. Indeed, in the article attached hereto as **Exhibit A**, the author states that, "***FanDuel Sportsbook's Same Game Parlay has been a bonafide [sic] sensation in the betting world since it launched in 2019. The feature has been the centerpiece of FanDuel Sportsbook and launched a million copycats...***" "[*T*]he *FanDuel Same Game Parlay* was a revelation for American bettors when it was introduced in November 2019. **FanDuel was the betting site that really popularized the same game parlay in the States.**" (Emphasis added.) It is well established that evidence regarding third-party use of the subject mark to refer to the applicant can be sufficient evidence that the mark is *not* generic. *See In re America Online, Inc.*, 77 U.S.P.Q.2d 1618, 2006 WL 236389, at \*7 (T.T.A.B. 2006).

Even more so, the Examiner presented certain articles in purported support of the Office Action that create serious doubt as to the genericness of the Subject Mark that must be resolved in Applicant's favor. For example, the third-party guides relied upon by the Examiner specifically identify "Same Game Parlay" as being linked to Applicant (FanDuel) and its affiliates, while also making clear that competing businesses can and do compete with Applicant or its affiliates effectively without having to use the Subject Mark to designate the products or services they offer in direct competition with Applicant or its affiliates.

Indeed, the first article attached to the Office Action titled, "What's A Same Game Parlay? Single-Game or Same-Same Parlays Explained," identifies various companies that offer correlated wagers on a single game, all of which offer their services under different names. *See* Office Action, Pgs. 11-12. Specifically, the companies below have named and call their respective competing goods and services as follows:

Company	Name/Mark
BetMGM	One-Game Parlay
Barstool	Parlay+
Unibet	Same Game Combo

That article refers potential consumers to Applicant’s affiliate’s “Same Game Parlay,” describes what a “same game parlay” is, and notes that “because of trademark agreements and other factors, the same game parlay goes by different names at different sportsbooks.” *See* Office Action, Pgs. 5 -12. Notably, the article establishes that the Subject Mark is not generic, but is at most, descriptive or suggestive of the goods and services listed in the Subject Application because the “same game parlay,” “single-game, or one-game parlay” are described as “fancy (or catchy) names for a parlay consisting of **correlated wagers.**” Office Action, Pg. 6. The article further illuminates that the relevant public understands the Subject Mark to be a source identifier of the services offered by Applicant’s affiliate and recognizes Applicant’s usage of the Subject Mark as a trademark given the article notes that the “same game parlay” is a phrase actually trademarked by FanDuel Sportsbook.” *Ibid.*

Moreover, the second article attached to the Office Action titled, “Same Game Parlay Guide: What is it and when can I bet on it?” also refers to various companies that offer correlated wagers on a single game, all under different names. *See* Office Action, Pgs. 13 -14. When advising the public where they can bet on a Same Game Parlay, the article attached to the Office Action notes that “FanDuel is one of the sportsbooks championing Same Game Parlays...,” that “BetMGM has also introduced their own version called a ‘One Game Parlay,’” and “PointsBet has a Single Game Parlay feature.” *Ibid.* The lack of evidence of potential competitive harm if the Subject Mark is registered weighs in Applicant’s favor. *See In re Trek 2000 International Ltd.*, 97 U.S.P.Q.2s 1106, 2010 WL 5099653 \*8 (T.T.A.B. 2010).

The third article attached to the Office Action titled “Grab Your Risk Free NFL Bet This Week,” also refers potential consumers to Applicant’s affiliate for its “Same Game Parlay,” and is further evidence that the Subject Mark has trademark significance. *See* Office Action, Pgs. 18-

23.

In other words, the articles the Examiner relied upon and attached to the Office Action in purported support of the genericness all stand for the proposition that Applicant and its affiliates use the term “Same Game Parlay” to refer to their own goods and services, and their competitors can and do utilize different names to refer to their respective goods and services.

Moreover, there are multiple references in the articles mentioned above that capitalize the first letter for each word in “Same Game Parlay,” which is indicative of use as a trade or brand name, especially when referring to the goods and services offered by Applicant or its affiliates. *See In re County Music Association, Inc.*, 100 U.S.P.Q.2d 1824, 2011 WL 5600319\*5 (TTAB 2011) (“We note that all of the Internet and LEXIS/NEXIS excerpts show the phrase “Country Music Association” in initial capitalization form, which, as discussed further below, may be indicative of use as a trade or brand name.”.)

Furthermore, the Applicant’s specimens submitted as part of the Subject Application evidence consistent use of the Subject Mark as a trademark, including use of the Subject Mark with the “TM” symbol. *See* copies of various examples from Applicant’s Specimens and Statement of Use, submitted hereto as **Exhibit B**.

Based on the foregoing, the Subject Mark is primarily recognized as a trademark and the relevant public understands or refers to the Subject Mark as a source identifier of Applicant or its affiliates’ goods and services, *not* to be generic for the genus referenced above. At a minimum, the evidence addressed, and arguments presented above, raise serious doubt as to the Subject Mark’s genericness that must be resolved in Applicant’s favor. *See In re Tennis Indus. Ass’n*, 102 U.S.P.Q.2d 1671, 2012 WL 1267923\*12 (T.T.A.B. 2012).

Given the Subject Mark is not generic, and the Examiner had previously found the Subject Mark to be merely descriptive in its Office Action dated February 19, 2021 and issued an advisory to amend the application to the Supplemental Register (Applicant already did so), Applicant respectfully requests the Examiner to allow registration of the Subject Mark on the Supplemental Register.

### **III. CONCLUSION**

Applicant submits that the Subject Mark is not generic, and requests that the Examiner allow registration of the Subject Mark on the Supplemental Register.