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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77438476
Applicant	Masayoshi Takayama
Applied for Mark	BAR MASA
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Submission	Appeal Brief
Attachments	60257_Appeal_Brief.pdf (3 pages)(54346 bytes)
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Date	03/20/2012

SERVICE MARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being electronically filed with the United States Patent and Trademark Office on March 20, 2012 at or before 11:59 p.m. Pacific Time under the Rules of 37 CFR § 1.8.

Suzanne Swezey

Mark	:	BAR MASA
Serial No.	:	77/438,476
Filed	:	April 2, 2008
Applicant	:	MASA RESTAURANT
Law Office	:	101
Examiner	:	Colleen Dombrow
Docket No.	:	60257/T605

SUBMISSION OF APPEAL BRIEF
TO THE TRADEMARK TRIAL AND APPEAL BOARD

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Post Office Box 29001
Glendale, CA 91209-9001
March 20, 2012

Commissioner:

I. INTRODUCTION

Applicant Masayoshi Takayama appeals the rejection of his application to register the mark BAR MASA for Japanese and sushi restaurant and bar services based on Registration No. 3,380,250 for MASA and design for restaurant and bar services (the "'250 Reg."), owned by D'Amico Holding Company ("D'Amico"). The basis for this appeal is that there is no likelihood of confusion between the subject marks as evidenced by the admission by D'Amico that there is no likelihood of confusion between Applicant's use of the mark MASA and D'Amico's use of the mark MASA because of the differences in geography, target customers, and uses (Japanese versus Italian restaurants). Indeed, this statement by D'Amico was the basis for the Examining Attorney to withdraw the rejection of Applicant's co-pending application to register MASA. Since addition of the word "BAR" to Applicant's mark MASA can only further distinguish

Applicant's mark from that of D'Amico, the Board should similarly find that there is no likelihood of confusion between Applicant's BAR MASA and D'Amico's MASA mark and thereby sustain this appeal.

II. FACTUAL BACKGROUND

D'Amico filed Application Serial No. 78/654,116 for MASA and design on June 20, 2005, which application was published for opposition on December 26, 2006. On January 23, 2007, Applicant filed a Notice of Opposition alleging prior use of its mark MASA and alleging a likelihood of confusion, thereby commencing Opposition No. 91175440. That opposition was settled with the parties agreeing that there was no likelihood of confusion between the parties' respective use of MASA "due to differences in geography, target customers and different uses." (See Coexistence and Settlement Agreement filed on June 28, 2011 in response to the Final Office Action dated July 20, 2011.)

On January 14, 2008, Applicant filed Application Serial No. 76/685,731 for MASA and on April 2, 2008, Application Ser. No. 77/438,476 for BAR MASA. Both applications were initially refused registration based, *inter alia*, on citation of the '250 Reg. In response, Applicant amended the specification of services in both applications from "restaurant and bar services" to "Japanese and sushi restaurant and bar services" and submitted the Coexistence and Settlement Agreement between Applicant and D'Amico in which they agreed that the parties' respective uses of MASA was not likely to cause confusion. The Examining Attorney thereupon withdrew the refusal of Applicant's application to register MASA which was published for opposition on August 23, 2011, but maintained the refusal to register BAR MASA because the referenced agreement does not reference the mark BAR MASA. (See Final Office Action dated July 20, 2011.)

III. ARGUMENT

Applicant's mark is BAR MASA for Japanese and sushi restaurant and bar services. The application has been refused solely on an alleged likelihood of confusion with D'Amico's registration for MASA, i.e., the '250 Reg. Plainly, the only similarity between the two marks is the term "MASA." However, the same Examining Attorney has found that there is no likelihood of confusion between Applicant's use of MASA for the specified services and the mark shown in the '250 Reg. The addition of the descriptive term BAR (which has been disclaimed) only further distinguishes Applicant's mark and indeed the Examining Attorney does not argue that addition of "BAR" somehow creates a likelihood of confusion between the parties' MASA marks. In view thereof, the parties' agreement that there is no likelihood of confusion between their respective uses of MASA is the best evidence on this issue and should be applied by the Board to find that there is no likelihood of confusion between Applicant's BAR MASA mark and the mark shown in D'Amico's '250 Reg.

IV. CONCLUSION

For the reasons stated above, this appeal should be sustained and Applicant's mark should be allowed and published.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

Date: March 20, 2011

By _____

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