

From: Dombrow, Colleen

Sent: 5/11/2012 8:01:28 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77438476 - BAR MASA -
60257/T605 - EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 77438476.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77438476

MARK: BAR MASA



CORRESPONDENT ADDRESS:
EDWARD R SCHWARTZ
CHRISTIE PARKER HALE LLP
PO BOX 29001
GLENDALE, CA 91209-9001

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:
<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Masayoshi Takayama

CORRESPONDENT'S REFERENCE/DOCKET NO:
60257/T605

CORRESPONDENT E-MAIL ADDRESS:
pto@cph.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Trademark Attorney's final refusal to register the service mark BAR MASA for, "Japanese and sushi restaurant and bar services". The service mark for which registration is sought gives rise to a likelihood of confusion with U.S. Registration Numbers 3,380,250 and 3,855,043 under Trademark Act Section 2(d), 15 U.S.C. §1052(d). It is respectfully requested that this refusal be affirmed.

STATEMENT OF ACTS

On April 2, 2008, Masayoshi Takayama applied for a federal service mark registration for the service mark BAR MASA pursuant to 15 U.S.C. §1051(a). Applicant identified its service mark for, "restaurant and bar services".

On April 23, 2008, the Trademark Attorney refused registration of the service mark due to a likelihood of confusion with U.S. Registration Numbers 2,533,825 and 3,380,250. Additionally, the Trademark Attorney cited pending Application Serial

Number 78654116 as a potential bar to registration. Further, the Trademark Attorney required a disclaimer of the word “BAR” from applicant’s mark.

On October 27, 2008, the applicant filed a timely response with arguments in favor of registration and against the substantive refusal. Additionally, applicant amended the recitation of services to “Japanese and sushi restaurant and bar services”. Further, the applicant entered a disclaimer the word “BAR”.

On November 26, 2008, the Trademark Attorney suspended the application pending the disposition of U.S. Application Serial Number 78654116 and Opposition Number 91175440.

On December 28, 2010, the Trademark Attorney issued a non-final Office action, citing U.S. Registration Numbers 2,533,825, 3,380,250, and 3,855,043 against the applicant.

On June 28, 2011, the applicant submitted arguments in favor of registration.

On July 20, 2011, the Trademark Attorney withdrew the Section 2(d) Refusal to Register as to U.S. Registration Number 2,533,825 and issued a Final Office action citing U.S. Registration Numbers 3,380,250 and 3,855,043 against the applicant. Applicant filed a Notice of Appeal on January 20, 2012 and filed a timely appeal brief on March 20, 2012.

ISSUE

The sole issue on appeal is whether under Section 2(d), there is a likelihood of confusion between the applicant’s mark BAR MASA in standard character form for, “Japanese and sushi restaurant and bar services”, and U.S. Registration Number 3,380,250, MASA in stylized form plus design for “restaurant and bar services” and U.S.

Registration Number 3,855,043, MASA in standard character form for, “restaurant and bar services.”

ARGUMENTS

I. APPLICANT’S MARK IS CONFUSINGLY SIMILAR TO REGISTRANT’S MARKS AND THE SERVICES ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION, MISTAKE OR DECEPTION EXISTS UNDER SECTION 2(D) OF THE TRADEMARK ACT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

A. THE MARKS ARE CONFUSINGLY SIMILAR

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

The applicant's mark is BAR MASA in standard character form. The mark in U.S. Registration Number 3,380,250 is MASA plus design. The mark in U.S. Registration Number 3,855,043 is MASA in standard character form. The applicant's mark is similar to the registrant's marks because they all contain the identical wording MASA.

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's

mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

Additionally, although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). In this case, the applicant has disclaimed the wording "BAR" from the mark, accordingly, the dominant portion of the applicant's mark is MASA.

Further, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services; therefore, the word portion is normally accorded greater weight in determining whether marks are confusingly similar. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *see CBS*

Inc. v. Morrow, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011). In this case, the dominant portion of the registrant's mark in U.S. Registration Number 3,380,250 is MASA.

Accordingly, because the dominant portion of the applicant's mark, MASA is identical in sound, appearance, and meaning to the dominant portion of the registrant's marks, MASA, the overall commercial impression of the marks is similar.

B. THE SERVICES ARE IDENTICAL

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

The applicant's services are, "Japanese and sushi restaurant and bar services". The registrant's services are, "Restaurant and bar services." The applicant's services are legally identical to the registrant's services as they both include restaurant and bar services.

In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii).

In this case, the identification set forth in the cited registrations uses broad wording to describe registrant's goods and/or services and does not contain any limitations as to nature, type, channels of trade or classes of purchasers. Therefore, it is presumed that the registration encompasses all goods and/or services of the type described, including those in applicant's more specific identification, that the goods and/or services move in all normal channels of trade, and that they are available to all potential customers. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii). Specifically, the registrant's identification does not limit the type of food or cuisine served at registrant's restaurants and bars and encompasses the applicant's more specific "Japanese and sushi restaurant and bar services." Because the applicant's mark and the registrant's marks include the identical wording MASA and the services are overlapping, confusion as to source is likely and registration is refused under Section 2(d).

The applicant argues, “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).” (Applicant’s Br. 1.) These arguments, however, are not persuasive. Specifically, the Applicant argues that its activities are geographically separate from those of registrant; however, applicant seeks a geographically unrestricted registration. The owner of a registration without specified limitations enjoys a presumption of exclusive right to nationwide use of the registered mark under Trademark Act Section 7(b), 15 U.S.C. §1057(b), regardless of its actual extent of use. *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1568, 218 USPQ 390, 393 (Fed. Cir. 1983). Therefore, the geographical extent of applicant’s and registrant’s activities is not relevant to a likelihood of confusion determination. Additionally, the applicant indicates that the registrant’s services are Italian restaurants. However, there is no such limitation in the registrant’s recitation of services. The registrant’s recitation in both registrations is for “restaurant and bar services.” As stated above, in a likelihood of confusion analysis, the comparison of the parties’ goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii). Because the registrant’s services are written broadly as, “restaurant and

bar services,” and are not limited in any way, the registrant’s services are written broadly enough to encompass the applicant’s services. Accordingly, because the applicant’s mark and the registrant’s marks all include the identical wording MASA, and the services are overlapping, confusion as to source is likely and registration is refused under Section 2(d).

The applicant further argues, “The application has been refused solely on an alleged likelihood of confusion with D’Amico’s registration for MASA, i.e., the ‘250 Reg.¹ Plainly, the only similarity between the two marks is the term ‘MASA’.”

(Applicant’s Br. 3.) Applicant further argues, “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 [sic] addition of ‘BAR’ somehow creates a likelihood of confusion between the parties’ MASA marks.”

(Applicant’s Br. 3.) These arguments, however, are not persuasive. Specifically, the applicant’s mark is similar to the registrant’s marks as they all include the identical wording MASA. As stated above, marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant’s and registrant’s mark. *See Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff’d sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Ass’n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen*

¹ The applicant indicates that only the ‘250 registration was cited against the applicant. This, however, is incorrect. In the final office action, both U.S. Registration Numbers 3,380,250 and 3,855,043 were cited against the applicant’s mark and are continued to be cited against the applicant’s service mark application.

Corp., 228 USPQ 949 (TTAB 1986) (21 CLUB and “21” CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

Additionally, the Trademark Attorney found that there was no likelihood of confusion in applicant’s copending application, MASA for “Japanese and sushi restaurant and bar services” (U.S. Application Serial Number 76685731) as the applicant made of record a consent agreement specifically discussing and addressing applicant’s 76685731 application. The applicant made that same consent agreement of record in the current application. Specifically, applicant stated in its June 28, 2011 incoming response, “As to the latter two registrations, applicant has entered a consent agreement with the owner of Registration Nos. 3,380,250, and 3,855,043 making these reasons for refusal moot.” However, the consent agreement provided by the applicant did not discuss the current application. Specifically, the consent states, “WHEREAS, Takayama has adopted and used the mark MASA in connection with exquisite Japanese sushi restaurant and bar services in New York City, NY since at least 2004.” The consent agreement specifically refers to and limits itself to applicant’s MASA service mark (U.S. Application Serial Number 76685731). This application is for a different mark, specifically, for the mark BAR MASA. Accordingly, the consent does not reference nor does it apply to the instant application.

Because the applicant's mark and the registrant's marks all include the identical wording MASA, and the services are overlapping, confusion as to source is likely and registration is refused under Section 2(d).

CONCLUSION

The Trademark Attorney, having established that the respective marks are similar and the respective services are overlapping, respectfully submits that the applicant's mark so resembles the registered marks that it is likely, when applied to the applicant's services, to cause confusion, or to cause mistake, or to deceive. Accordingly, the Trademark Attorney respectfully submits that registration of applicant's mark is properly refused under Trademark Act Section 2(d).

Respectfully submitted,

/Colleen Dombrow/
Trademark Attorney
Law Office 101
Direct Dial: (571) 272-8262
Facsimile: (571) 273-9101
colleen.dombrow@uspto.gov

Ronald R. Sussman
Managing Attorney
Law Office 101