

This Opinion is Not a
Precedent of the TTAB

Mailed: February 22, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ms. America Pageant

Serial No. 87820883

James Shlesinger of Shlesinger Arkwright & Garvey LLP
for Ms. America Pageant.

Rebecca T. Caysido, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

Before Shaw, Heasley and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Ms. America Pageant (“Applicant”) seeks registration on the Principal Register of the standard character mark MS. INTERNATIONAL for “promoting the sale of goods and services of others by conducting beauty pageants, contests and competitions for women 26 years of age and up” in International Class 35 and “entertainment in the nature of beauty pageants, contests and competitions for women 26 years of age and up; entertainment services, namely, organizing, arranging and conducting of beauty

pageants, contest [sic] and competitions for women 26 years of age and up” in International Class 41.¹

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the standard character mark MISS INTERNATIONAL subject to two registrations owned by the same individuals (“Registrants”) for “entertainment services, namely, presentation of beauty pageants, contests and competitions for single women; arranging and conducting state, regional and national pageants for single women”² in International Class 41; and “entertainment services, namely, presentation of beauty pageants, contests and competitions for single women; arranging and conducting state, regional, national, and international pageants for single women” in International Class 41.³

The Examining Attorney also issued an advisory regarding the potential for refusal under Section 2(d) based on Registrants’ prior-filed application for the mark

¹ Application Serial No. 87820883; filed March 5, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s allegation of first use and first use in commerce on October 1, 2010; “International” disclaimed.

² Registration No. 3319089; registered October 23, 2007; “International” disclaimed; renewed.

³ Registration No. 4279813; registered January 22, 2013; claiming acquired distinctiveness in the term “International” under Trademark Act Section 2(f), 15 U.S.C. § 1052(f); Section 8 accepted; Section 15 acknowledged.

The services in this registration overlap with the services in Registration No. 3319089, but also include “arranging and conducting ... international pageants for single women.” Registrations with overlapping goods and services are not considered duplicates if they also cover some different goods and services. TRADEMARK MANUAL OF EXAMINING PROCEDURE § 703 (Oct. 2018).

MS. INTERNATIONAL also for beauty pageant services in International Class 41.⁴ Registrants abandoned the application after it was opposed by Applicant, removing it as a potential bar to registration.⁵

The Examining Attorney made final the refusal to register based on a likelihood of confusion with the MISS INTERNATIONAL mark subject to the cited registrations. Applicant requested reconsideration and appealed. After the Examining Attorney denied the request for reconsideration, the appeal proceeded. Applicant and the Examining Attorney filed appeal briefs.

We reverse the refusal to register.

I. Evidence

The Examining Attorney submitted into evidence:

- Dictionary definitions for the words “Miss” and “Ms.”;⁶
- Articles intended to demonstrate that “the terms ‘Miss’ and ‘Ms.’ are commonly used interchangeably and also overlap in definition”;⁷ and
- Third-party websites and registrations intended to show that Applicant’s Class 35 services are related to Registrants’ services.⁸

⁴ Serial No. 87479153 filed June 7, 2017 based on an alleged intent to use the mark under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

⁵ Opposition No. 91239942. December 11, 2018 Office Action Response, TSDR 3. August 20, 2019 Final Office Action, TSDR 3.

Citations to the prosecution record are to the Trademark Status & Document Retrieval (“TSDR”) system by page number in the downloadable .pdf versions of the documents. All other citations are to TTABVUE, the Board’s online docketing system.

⁶ June 18, 2018 Office Action, TSDR 16-17.

⁷ August 20, 2019 Final Office Action, TSDR 8-30.

⁸ June 18, 2018 Office Action, TSDR 18-42; August 20, 2019 Final Office Action, TSDR 31-71.

Applicant submitted into evidence:

- A declaration and substitute declaration from Susan Jeske,⁹ Applicant's Chief Executive Officer, who has "been involved in the pageant and entertainment industry for more than thirty-six years" in the capacity of "competitor, judge, pageant producer, director and owner."¹⁰ The following exhibits are attached to the Substitute Jeske Declaration:
 - Excerpts from Applicant's interrogatories and Registrants' responses thereto in Opposition No. 91239942;¹¹
 - Wikipedia pages listing beauty pageants;¹²
 - Printouts from the Pageantplanet.com website;¹³
 - Applicant's "Hall of Fame" listing of pageants;¹⁴
 - Excerpt from a November 26, 2008 brief that Registrants filed in unrelated Opposition No. 91165290 brought by a third-party against Registrants' application Serial No. 76503247 for the mark MRS. U.S. INTERNATIONAL;¹⁵
 - Rules and regulations for beauty pageants operated by Applicant and third parties MAO and Mrs. America, Inc.;¹⁶

⁹ November 19, 2019 Request for Reconsideration, TSDR 16-20; February 20, 2020 Request for Reconsideration, Part I, TSDR 25-31. We refer to the second declaration as the "Substitute Jeske Declaration" because that is how Applicant refers to it.

¹⁰ February 20, 2020 Request for Reconsideration, Part I, TSDR 25, 27, Substitute Jeske Declaration, ¶¶ 2, 5.

¹¹ February 20, 2020 Request for Reconsideration, Part I, TSDR 32-38.

¹² *Id.* at 39-51.

¹³ *Id.* at 52-54.

¹⁴ *Id.* at 55-56.

¹⁵ *Id.* at 57-59.

¹⁶ *Id.* at 60-105.

- Third-party registrations for marks incorporating the word “international” or the words “international” and “miss” for beauty pageants;¹⁷ and
 - List of marks for beauty pageants incorporating the term “international” or both terms “international” and “miss” and Internet screenshots showing use of the marks for beauty pageants.¹⁸
- Wikipedia pages for third-party MISS INTERNATIONAL and MISS U.S. INTERNATIONAL beauty pageants;¹⁹
 - Registrations for the marks MISS AMERICA, MRS. AMERICA, MISS TEEN AMERICA, and MISS BLACK AMERICA for beauty pageants and related services;²⁰
 - Registrations for the marks MISS EARTH, MRS. EARTH, and MRS. EARTH & Design for beauty pageants;²¹ and
 - Copy of Registrants’ application for the mark MISS INTERNATIONAL COMPETITION and Office action and notice of allowance issued in connection therewith.²²

¹⁷ *Id.* at 106-241. Several of the registrations are duplicates of those that Applicant submitted with its November 19, 2019 Request for Reconsideration, TSDR 26-58. This complicated our review of the record.

In addition, Applicant submitted a list of registrations generated from a search of the Office’s electronic database. November 19, 2019 Request for Reconsideration, TSDR 21-25. A list of registrations is not sufficient to make the registrations of record. *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018). The Examining Attorney advised Applicant of this insufficiency and informed Applicant how to make third-party registrations of record. December 10, 2019 Denial of Request for Reconsideration, TSDR 2. Accordingly, we have not considered the list.

¹⁸ February 20, 2020 Request for Reconsideration, Part I, TSDR 242-45; 12 and 13 TTABVUE.

The dates the webpages were accessed and printed were cut off when submitted with Applicant’s request for reconsideration so Applicant requested and the Board granted remand of the application for Applicant to submit copies of the webpages with dates. Board’s June 3, 2020 Order, 16 TTABVUE. The refiled webpages, with dates, can be found at 12 and 13 TTABVUE. We have disregarded the duplicate copies at 14 and 15 TTABVUE.

¹⁹ February 20, 2020 Request for Reconsideration, Part I, TSDR 18-20.

²⁰ November 19, 2019 Request for Reconsideration, TSDR 66-77.

²¹ *Id.* at 78-80. The registration for MS. EARTH in standard characters is cancelled.

²² *Id.* at 59-64.

II. Analysis

Our determination under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). We consider each *DuPont* factor for which there is argument and evidence, see *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019), but “we focus our analysis on those factors we find to be relevant.” *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015).

A. The Similarity of the Services, Trade Channels, and Classes of Consumers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Applicant acknowledges that “the second and third *DuPont* factors do not favor” it, conceding that “the services as described in the application and [cited] registrations and the corresponding channels of trade are more similar than dissimilar.”²³

²³ Appeal Brief, 19 TTABVUE 18-19.

Indeed, the services are legally identical, in part. Both the involved application and cited registrations cover entertainment services in the nature of beauty pageants and conducting beauty pageants.²⁴ Although Applicant's pageants are limited to women at least 26 years old and Registrants' pageants are limited to single women, Applicant acknowledges that "an overlap in the respective services can exist to the extent single women [in Registrants' beauty pageants] are not restricted by their age."²⁵ Moreover, the fact that Registrants' services are "conducting ... pageants" in International Class 41,²⁶ while Applicant's services are conducting beauty pageants primarily for entertainment in International Class 41 **and** conducting beauty pageants primarily to promote the goods and services of others in International Class 35 is not a meaningful distinction, as both conduct beauty pageants.

In any event, the Examining Attorney submitted printouts from websites showing eight third parties using a single mark for conducting beauty pageants both to entertain and to promote the goods and services of others.²⁷ This evidence shows that it is common for such services to emanate from a common source under the same

²⁴ The cited registrations specify conducting "pageants," which encompasses "beauty pageants."

²⁵ Appeal Brief, 19 TTABVUE 17.

²⁶ Although the purpose of Registrants' "conducting ... pageants" is not specified, services under the heading of International Class 41 include those services "having the basic aim of the entertainment, amusement or recreation of people" while services under the heading of International Class 35 include "services rendered by advertising establishments[.]" NICE AGREEMENT, 11th ed. (2021).

²⁷ June 18, 2018 Office Action, TSDR 18-36 (MISS UNIVERSE, MISS DISTRICT OF COLUMBIA, and MISS EARTH). August 20, 2019 Final Office Action, TSDR 31-65 (NATIONAL AMERICAN MISS, USA NATIONAL MISS, INTERNATIONAL JUNIOR MISS, MISS GRAND INTERNATIONAL, and MCS INTERNATIONAL).

mark. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (crediting relatedness evidence showing that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *In re Integrated Embedded*, 120 USPQ2d 1504, 1514-15 (TTAB 2016); *In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1934-35 (TTAB 2012) (relatedness supported by evidence of third parties offering both services under a single mark). As further corroboration, the record shows two third-party marks, MISS UNIVERSE and MISS USA, registered based on use for conducting beauty pageants both to entertain and to promote the goods and services of others.²⁸ See *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001) (“Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the services listed therein are of a kind which may emanate from a single source.”); see also, e.g., *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *4 (TTAB 2020) (“Copies of use-based, third-party registrations may help establish that the services are of a type which may emanate from a single source.”); *In re RiseSmart, Inc.*, 104 USPQ2d at 1934-35 (relatedness supported by evidence of third-party registrations covering both services).

²⁸ June 18, 2018 Office Action, TSDR 37-42 (Reg. Nos. 620557 and 1597876 for the mark MISS UNIVERSE and Reg. Nos. 808974 and 1601484 for the mark MISS USA).

Because the services are legally identical, in part, and otherwise closely related, the channels of trade and targeted classes of consumers also overlap. *Am. Lebanese Syrian Associated Charities, Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re RiseSmart, Inc.*, 104 USPQ2d at 1935. We presume that Applicant's and Registrants' beauty pageants are offered through the same ordinary channels of trade, e.g. live events as well as internet and mass media broadcasts, to all ordinary classes of consumers for such services, e.g. beauty pageant contestants, members of the general public with an interest in beauty pageants, and advertisers.²⁹

In view of the foregoing, the second and third *DuPont* factors support a finding that confusion is likely.

B. Strength of the Cited Mark

Before we turn to the similarity of the marks, we consider the scope of protection to which the cited mark is entitled. The fifth *DuPont* factor is the fame or strength of the prior mark, and the sixth factor is the number and nature of similar marks in use for similar goods or services. In determining the strength of a mark, we consider both its inherent or conceptual strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A

²⁹ Although the cited registrations do not specify that Registrants conduct beauty pageants to promote the goods and services of others, the evidence shows that beauty pageants are often sponsored by advertisers. *See* June 18, 2018 Office Action, TSDR 18-36; August 20, 2019 Final Office Action, TSDR 31-65; 12 TTABVUE 16, 20, 25-26, 35, 39-40, 45; 13 TTABVUE 15, 28, 50-51, 58.

mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

With regard to conceptual strength, Registrants have acknowledged that the term “international” is descriptive of beauty pageant services as Registrants have disclaimed “international” in one of the cited registrations and claimed acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), in the other cited registration. *Yamaha Int’l Corp. v. Hoshino Gakki Co*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (when a claim of acquired distinctiveness is made under Section 2(f) of the Trademark Act, the statute “accepts a lack of inherent distinctiveness as an established fact”); *In re DNI Holdings, Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005) (“[I]t has long been held that the disclaimer of a term constitutes an admission of the merely descriptive nature of the term [for the identified goods or services] ... at the time of the disclaimer.”); *In re Interco Inc.*, 29 USPQ2d 2037, 2038 n.3 (TTAB 1993) (same).

In addition, one definition for the word “Miss” is a title “used in front of the name of a place or region to refer to the young woman who has been chosen in a competition as the most beautiful woman there.”³⁰

The record also includes:

- approximately 15 third-party use-based registrations incorporating the term “international” for beauty pageants wherein the term “international”

³⁰ June 18, 2018 Office Action, TSDR 16 (Collins Dictionary).

has been disclaimed or the mark is registered on the Supplemental Register;³¹

- approximately 10 third-party use-based registrations for marks incorporating both the terms “Miss” and “international” for beauty pageants wherein the term “international” has been disclaimed or the mark is registered on the Supplemental Register;
- more than 15 marks in use for beauty pageants³² incorporating the term “international”;

³¹ Applicant also submitted more than thirty cancelled or expired registrations for marks incorporating “international” and/or “miss” for beauty pageants, a few of which registered on the Principal Register without a disclaimer or claim of 2(f) as to “International.” February 20, 2020 Request for Reconsideration, Part I, TSDR 153-160, 165-66, 177-78, 181-88, 193-200, and 203-41.

³² The record includes additional third-party marks incorporating “miss” and “international” for pageants held outside the United States, but these pageants appear to have U.S. exposure. Almost all of the websites and social media pages for these pageants are in English and many are open to contestants from around the world. 12 TTABVUE 20, 27, 38; 13 TTABVUE 13, 18, 32, 33, 35, 48-51. The record further supports that the beauty pageant industry is international in scope. Some U.S. pageants serve as qualifiers for participation in international pageants. February 20, 2020 Request for Reconsideration, Part I, TSDR 20-24 and 39; 12 TTABVUE 42. Indeed, Applicant’s pageant contract includes that Applicant may appoint the winner “to represent the USA to compete in an International Pageant” and that the “duties of [their] National Titleholder may include travel and participation in personal appearances domestically and internationally.” February 20, 2020 Request for Reconsideration, Part I, TSDR 89, 94. Ms. Jeske also explained that as “part of [her] involvement in the pageant and entertainment industry, [she] has traveled to twenty-six countries as a good will [sic] ambassador and Presidential Envoy for the United States[.]” *Id.* at 27, Substitute Jeske Declaration, ¶ 6.

For all of these reasons, we have considered the third-party marks for pageants held outside the United States. *Cf. In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 n.10 (TTAB 2017) (“Various factors may inform the probative value of a foreign website in any given case, such as whether the website is in English (or has an optional English language version), and whether the nature of the goods or services makes it more or less likely that U.S. consumers will encounter foreign websites in the field of question.”).

- more than 60 marks in use for beauty pageants incorporating the terms “Miss” and “international”; and
- approximately 8 marks in use for beauty pageants incorporating the terms “Ms.” and “international.”

This evidence further demonstrates that the word “international” is descriptive of the geographic scope or intended reach of the beauty pageants and that the female courtesy title “Miss” has a particular significance in the beauty pageant industry, serving as the title of a winner of a beauty pageant or identifying a contest category or contestant eligibility. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Mew Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ that is, some segment that is common to both parties’ marks may have a ‘normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.”); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (“Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.”) (quoting J. Thomas McCarthy, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90 (4th ed. 2015)).

The nature and quantity of third-party use and registration here is comparable to the “extensive” and “considerable” evidence found persuasive as to the strength of the

marks in *Jack Wolfskin*, 116 USPQ2d at 1136-37, and *Juice Generation*, 115 USPQ2d at 1674-75. Based on this evidence, we find that the cited mark is highly suggestive of Registrants' services, and as such, is conceptually very weak.

With respect to commercial strength, the evidence shows that it is common for beauty pageant marks to comprise or incorporate a female courtesy title and the geographic indicator "international." As noted above, the record includes more than 60 marks used for U.S.-based pageants incorporating the terms "Miss" and "International," and approximately eight marks for pageants incorporating the terms "Ms." and "International." The most pertinent marks are as follows:

- MISS INTERNATIONAL³³
- MISS INTERNATIONAL BEAUTY (registered to Applicant and in use since 2017)³⁴
- MISS U.S. INTERNATIONAL³⁵
- MISS INTERNATIONAL QUEEN³⁶
- MISS INTERNATIONAL TOURISM³⁷
- MISS INTERNATIONAL FASHION TRAVEL PAGEANT³⁸

³³ 12 TTABVUE 6.

³⁴ February 20, 2020 Request for Reconsideration, Part I, TSDR 56, 163-64; *see also id.* at 28, Substitute Jeske Declaration, ¶ 7.

³⁵ February 20, 2020 Request for Reconsideration, Part I, TSDR 20-24 and 39; 12 TTABVUE 13.

³⁶ 12 TTABVUE 14. Reg. Nos. 5499306 and 3393218. November 19, 2019 Request for Reconsideration, TSDR 36; February 20, 2020 Request for Reconsideration, Part I, TSDR 175-176.

³⁷ 12 TTABVUE 11.

³⁸ *Id.* at 8. Reg. No. 5647289 (with a disclaimer of "International Fashion Travel Pageant"). November 19, 2019 Request for Reconsideration, TSDR 30, 57.

- MISS INTERNATIONAL GRAND LATINA³⁹
- MISS INTERNATIONAL CURVE⁴⁰
- MISS ASIA INTERNATIONAL⁴¹
- MISS BLACK INTERNATIONAL⁴²
- MISS TALL INTERNATIONAL⁴³
- MISS NIGERIA INTERNATIONAL⁴⁴
- MISS WORLDWIDE INTERNATIONAL⁴⁵
- MISS GRAND INTERNATIONAL⁴⁶
- MS. INTERGALACTIC INTERNATIONAL⁴⁷
- MISS LANDSCAPES INTERNATIONAL⁴⁸
- MISS SUMMIT INTERNATIONAL⁴⁹
- MISS HOOTERS INTERNATIONAL⁵⁰

³⁹ 12 TTABVUE 10. Reg. No. 5085955. November 19, 2019 Request for Reconsideration, TSDR 43.

⁴⁰ 13 TTABVUE 59.

⁴¹ 12 TTABVUE 20. Reg. No. 4321304. November 19, 2019 Request for Reconsideration, TSDR 54.

⁴² 13 TTABVUE 9, 55.

⁴³ *Id.* at 19.

⁴⁴ *Id.* at 27.

⁴⁵ *Id.* at 37.

⁴⁶ 12 TTABVUE 16.

⁴⁷ *Id.* at 37.

⁴⁸ *Id.* at 43.

⁴⁹ 13 TTABVUE 2.

⁵⁰ *Id.* at 52.

- MISS TOURISM INTERNATIONAL USA⁵¹
- MISS TOURISM INTERNATIONAL⁵²
- MISS TOURISM QUEEN OF THE YEAR INTERNATIONAL⁵³
- YOUNG MISS INTERNATIONAL and YOUNG AMERICAN MISS INTERNATIONAL⁵⁴
- ROYAL INTERNATIONAL MISS⁵⁵
- AMERICA'S INTERNATIONAL MISS⁵⁶
- INTERNATIONAL UNITED MISS⁵⁷
- INTERNATIONAL MS⁵⁸
- INTERNATIONAL MS. USA⁵⁹
- INTERNATIONAL JUNIOR MISS⁶⁰

The Examining Attorney argues that the third-party use “is not relevant to the determination of the similarities in the marks ... in question” because the marks “contain additional wordings that change the meaning and commercial impression of

⁵¹ *Id.* at 14.

⁵² *Id.* at 15.

⁵³ *Id.* at 16.

⁵⁴ 12 TTABVUE 15.

⁵⁵ *Id.* at 33.

⁵⁶ *Id.* at 30. Reg. No. 5277209. November 19, 2019 Request for Reconsideration, TSDR 42.

⁵⁷ *Id.* at 36.

⁵⁸ *Id.* at 27. Reg. No. 5056192. February 20, 2020 Request for Reconsideration, TSDR 144.

⁵⁹ 12 TTABVUE 44.

⁶⁰ August 20, 2019 Final Office Action, TSDR 48-52. Reg. No. 4931267. November 19, 2019 Request for Reconsideration, TSDR 45.

the marks.”⁶¹ We agree that the additional terms in many of the third-party marks distinguishes them somewhat from the cited mark, but they are still relevant. In fact, the “considerable number” of third-party marks in use for the same services is “powerful” evidence that consumers encountering marks in the beauty pageant field have become conditioned to distinguishing marks incorporating a female courtesy title and the geographic indicator “international” based on minute differences. *Juice Generation*, 115 USPQ2d at 1674 (extensive third-party use and registration is “powerful on its face”); *see also Jack Wolfskin*, 116 USPQ2d at 1136 (discussing “voluminous evidence” of registration and use of paw print design elements); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (“Evidence of third-party use of similar marks on similar goods [or services] is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1036 (TTAB 2016) (“evidence of extensive use and registration of a term by others as a mark, as is the case here, can be ‘powerful on its face’”); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of the goods or services in the field.”).

⁶¹ Examiner’s Statement, 21 TTABVue 9, 22-23.

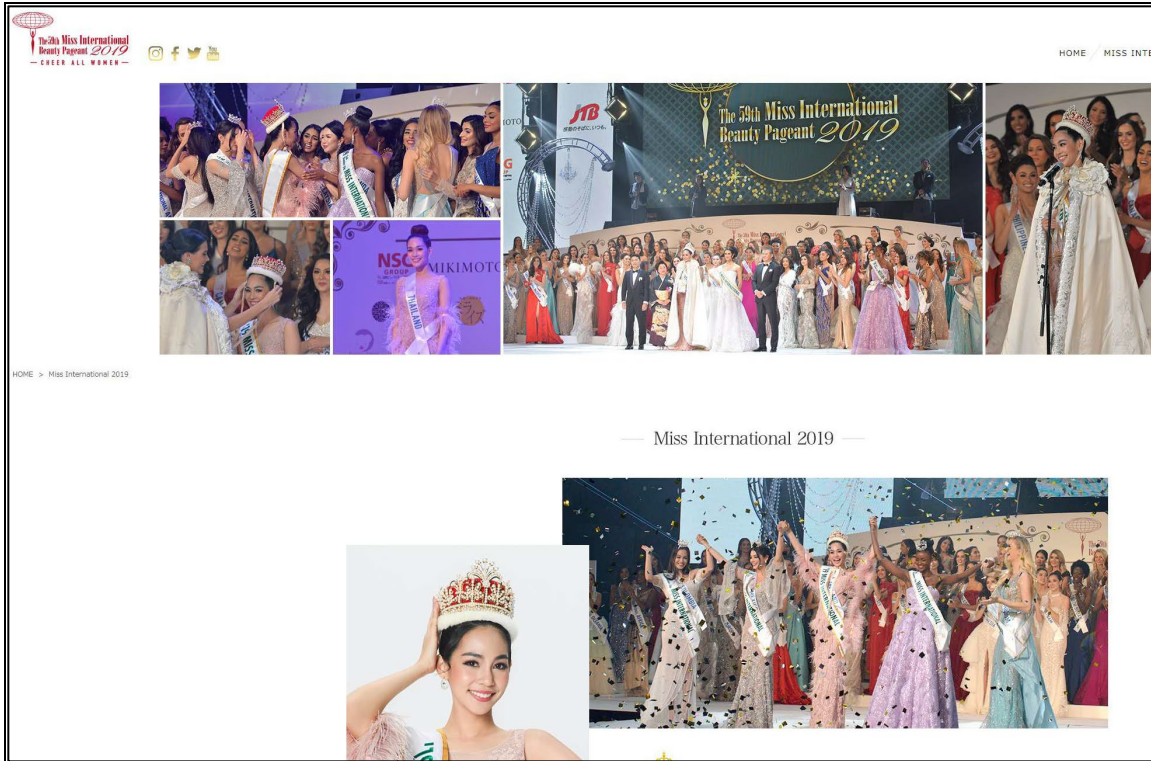
The Examining Attorney argues that “Registrants’ cited marks are the only marks that contain the title ‘MISS’, followed by the sole wording ‘International’” and that Registrants “also own[] the following registered marks that consist of a title followed by the sole wording ‘INTERNATIONAL’: MRS. INTERNATIONAL in Registration No. 1731756; MISS PRE TEEN INTERNATIONAL in Registration No. 5576067; MISS TEEN INTERNATIONAL in Registration No. 4279815. Accordingly, registrant[s] own[] the registrations for marks that are formed by a title, followed by the sole wording ‘INTERNATIONAL’.”⁶²

Although the record shows that Registrants are using and have registered the marks MISS INTERNATIONAL, MRS. INTERNATIONAL, MISS TEEN INTERNATIONAL, and MISS PRE TEEN INTERNATIONAL for beauty pageants, they are not the only ones using a mark consisting of a Title + “International.”⁶³ In fact, International Culture Association (“ICA”), an entity that has no apparent connection to Registrants, uses the identical MISS INTERNATIONAL mark to identify a beauty pageant. A screenshot from the miss-international.org/en website is below:⁶⁴

⁶² Examiner’s Statement, 21 TTABVUE 23.

⁶³ 12 TTABVUE 7; 13 TTABVUE 42.

⁶⁴ 12 TTABVUE 6.



It appears that this pageant is primarily hosted in Japan, but the evidence suggests that the pageant has exposure in the United States. The website is available in English and the backdrop of the pageant stage and the sash worn by the winner also are in English. In addition, another third-party, Harrison Productions, LLC, operates a MISS U.S. INTERNATIONAL pageant that it promotes as a qualifier for ICA’s MISS INTERNATIONAL pageant.⁶⁵ According to Wikipedia, ICA’s MISS INTERNATIONAL pageant originated in Long Beach, California, is one of “the world’s four major beauty contests,” and “[t]he United States has sent a

⁶⁵ February 20, 2020 Request for Reconsideration, Part I, TSDR 21-24; *see also id.* at 20 (Wikipedia identifying the MISS U.S. INTERNATIONAL pageant as the “official United States preliminary to [ICA’s] Miss International Beauty Pageant.”).

representative to [ICA's] Miss International pageant since its inception in 1960. The only year a representative was not sent was in 2006.”⁶⁶

Also troubling is Applicant's mark MISS INTERNATIONAL BEAUTY and the third-party mark MISS U.S. INTERNATIONAL, both of which appear to have been in use for beauty pageants since at least as early as 2017.⁶⁷ Both marks incorporate a third word, so they differ from the two-word structure of the cited mark. But the connotation of the MISS INTERNATIONAL BEAUTY mark is substantially the same as the connotation of the cited mark given that the term “beauty” is generic for beauty pageants. The mark MISS U.S. INTERNATIONAL is also very similar to the cited mark. The addition of the geographic indicator “U.S.” suggests that the pageant may be a preliminary pageant in the U.S., and in fact this pageant is promoted as the U.S. qualifier for ICA's MISS INTERNATIONAL pageant. In addition, as noted above, the marks INTERNATIONAL MS⁶⁸ and INTERNATIONAL JUNIOR MISS⁶⁹ similarly consist of only a Title + “International” and are used and registered for pageant services.

Applicant further argues that the beauty pageant industry recognizes that differences in female courtesy titles are sufficient to distinguish marks for beauty

⁶⁶ *Id.* at 18-20, 39 (noting that ICA's pageant “is also called ‘Miss International Beauty’.”). We recognize the inherent limitations with Wikipedia, but the Examining Attorney did not attempt to rebut this evidence despite the opportunity to do so. *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032 (TTAB 2007); *In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1382 n.2 (TTAB 2012).

⁶⁷ February 20, 2020 Request for Reconsideration, Part I, TSDR 20-24, 56; 12 TTABVUE 13.

⁶⁸ Reg. No. 5056192.

⁶⁹ Reg. No. 4931267.

pageants, pointing to the marks MISS AMERICA, MS. AMERICA, and MRS. AMERICA, registered to and used by different entities, as well as the marks MISS EARTH and MS. EARTH & Crown Design registered to different owners.⁷⁰ We do not know, however, whether there are any agreements between the owners of these marks designed to reduce the likelihood of confusion. Moreover, “each application must be decided on its own merits.” *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009); *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (same).

Applicant points to an opposition proceeding in 2008, in which Registrants stated:

[T]he following three pageants run parallel to one another without anyone claiming confusion. All of these pageants have accompany[ing] federal service mark registrations.

MISS AMERICA
MRS. AMERICA
MS. AMERICA

This fact is to show that, in the pageant industry, there is very little confusion and the folks in the business and that portion of the public interested in pageants are not confused by such close names.⁷¹

This statement is illuminative of shade and tone in the total picture before us. *Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 USPQ2d 1213, 1223 (TTAB 2011) (recognizing that a party’s position in a prior proceeding “is not an admission, but may be considered only as illuminative of shade and tone in the total picture”);

⁷⁰ November 19, 2019 Request for Reconsideration, TSDR 10, 66-72, 78, 80; February 20, 2020 Request for Reconsideration, Part I, TSDR 28 (Substitute Jeske Declaration, ¶¶ 7 and 8) and 55, 60-105.

⁷¹ February 20, 2020 Request for Reconsideration, Part I, TSDR 59 (excerpt from Registrants’ brief in Opposition No. 91165290).

Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co., 95 USPQ2d 1271, 1281 (TTAB 2009) (party's position in a prior proceeding does not "rise to the level of an admission against interest"). However, Registrants are not a party to this ex parte proceeding and made this representation more than a decade ago in an opposition involving a different mark (MRS. U.S. INTERNATIONAL),⁷² and more recently have taken the position that the marks MISS INTERNATIONAL and MS. INTERNATIONAL are "substantially identical."⁷³

In sum, when we consider all of the evidence of record, we find that the cited mark is conceptually and commercially very weak. This weighs heavily against finding a likelihood of confusion. *See Primrose Ret. Cmtys.*, 122 USPQ2d at 1036 (according "significant weight" to "extensive" evidence of third-party use and registration); *see also Juice Generation*, 115 USPQ2d at 1674 ("The weaker [a cited mark], the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection."); *Exxon Corp. v. U.S. Indus., Inc.*, 213 USPQ 393, 396 (TTAB 1982) ("[I]t has often been stated that a party who chooses a weak or suggestive term as its trademark may expect that its competitors will choose marks which are closer to his than would be true if that party had chosen an arbitrary or coined mark.").

⁷² *Id.* at TSDR 57-59.

⁷³ *Id.* at 36 (Registrants' responses to Applicant's interrogatories in Opposition No. 91239942).

C. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion*, 110 USPQ2d at 1160; *DuPont*, 177 USPQ at 567. The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 688 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1160; *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

The marks are similar in appearance as they share an overall structure. Each mark starts with a female courtesy title beginning with the letter “M” and ending with an “S”, followed by the geographic designation “International.” Applicant argues that the marks sound different because “Ms.” is pronounced “miz” while “Miss” is pronounced “mis”.⁷⁴ These are the proper pronunciations of the terms,⁷⁵ but when the terms are pronounced quickly, the ending sounds are less pronounced, such that there

⁷⁴ November 19, 2019 Request for Reconsideration, TSDR 10.

⁷⁵ June 18, 2018 Office Action, TSDR 16-17.

can be a similarity in sound. Moreover, there is no one correct way to pronounce a mark. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

With respect to connotation, the Examining Attorney contends that the terms “Miss” and “Ms.” “overlap in definition and are also commonly used interchangeably” to refer to an unmarried woman.⁷⁶ The record, however, reflects that the terms have specifically different meanings. Collins Dictionary defines “Miss” and “Ms.” as follows:⁷⁷

- “You use Miss in front of the name of a girl or unmarried woman when you are speaking to her or referring to her.”
- “Ms is used, especially in written English, before a woman’s name when you are speaking to her or referring to her. If you use Ms, you are not specifying if the woman is married or not.”

The articles the Examining Attorney submitted define “Miss” as a title for an unmarried woman and explain that “Ms.” also may be used to refer to an unmarried woman, but similar to Collins Dictionary, the articles recognize an important distinction between the terms, namely, that “Ms.” does not indicate any particular marital status and therefore is applicable to all women just as the term “Mr.” applies to men generally regardless of marital status.⁷⁸ Two of the articles stress the cultural importance of the distinction between “Miss” and “Ms.”:

⁷⁶ Examiner’s Statement, 21 TTABVUE 7, 17-18.

⁷⁷ June 18, 2018 Office Action, TSDR 16-17.

⁷⁸ August 20, 2019 Final Office Action, TSDR 8-30.

- “It may seem like ‘miss’ and ‘ms’ mean the same. After all, they both mean miss, right? In actuality, it is important to know the difference in usage as it can create offense or misunderstanding.”⁷⁹
- “Miss, Mrs., and Ms. are not interchangeable terms. Choosing the wrong title can cause offense, so it’s important to know the difference between the three titles.”⁸⁰

Because the word “Ms.” is intentionally ambiguous as to a woman’s marital status, it can be substituted grammatically for the word “Miss” to refer to an unmarried woman, but the meanings of the terms are specifically different and culturally significant. In addition, the ubiquitous third-party use and registration discussed in the preceding section demonstrates that in the beauty pageant industry, the female courtesy titles “Miss” and “Ms.” refer to different competition categories and eligibility requirements. Accordingly, the words convey different shades of meaning to consumers of beauty pageant services.

On balance, based on the record before us, we find that the marks are similar in appearance and sound, but they are nonetheless distinguishable in connotation and commercial impression. The first *DuPont* factor therefore weighs only slightly in favor of a likelihood of confusion.

⁷⁹ *Id.* at 9 (whyunlike.com).

⁸⁰ *Id.* at 21 (www.grammarly.com/blog/ms-mrs-miss-difference/).

D. Fourth *DuPont* Factor: Sophistication of the Consumers

Applicant argues “[t]he consumer is highly sophisticated in that each contestant will have investigated the source of the pageant, the eligibility requirements and the services,” which “necessarily involve written contracts which spell out the terms of eligibility, awards, etc.”⁸¹ We must consider the sophistication of all ordinary consumers of Registrants’ beauty pageant services, namely, pageant contestants, advertisers, and the general public with an interest in beauty pageants. Our determination must be based on the least sophisticated consumer. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *5.

We agree that pageant contestants are more likely to be sophisticated because they are required to enter into participation agreements with pageant organizers. Similarly, advertisers are likely to be sophisticated about the organizations through which they advertise. Some of the general public interested in beauty pageants may also be familiar with the beauty pageant industry, and therefore, have some level of sophistication. But not all of the general public spectating beauty pageants will have a familiarity with the beauty pageant industry or otherwise be sophisticated about beauty pageants.

⁸¹ November 19, 2019 Request for Reconsideration, TSDR 11; *See also* February 20, 2020 Request for Reconsideration, Part I, TSDR 29, Substitute Jeske Declaration, ¶ 9, and 60-105 (“Contestants are sophisticated women competing for titles which might propel their career or for scholarships and other prizes. The title that these contestants bear is a very important consideration. Contestants fill out applications and are governed by rules specific to the pageant.”). Applicant made the argument about the sophistication of the purchasers during prosecution and did not reassert the argument in its appeal brief.

Because we must make our determination based on the least sophisticated consumer, we find the fourth *DuPont* factor neutral.

E. Absence of Actual Confusion

Under the seventh and eighth *DuPont* factors we consider “[t]he nature and extent of any actual confusion” and “[t]he length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. Generally, the “lack of evidence of actual confusion carries little weight, especially in an ex parte context.” *In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (internal citation omitted). This is because the owner of a cited mark does not have a role in an ex parte proceeding, so it is rare to have any evidence regarding whether a registrant is aware of any instances of actual confusion. “[N]or is it usually possible to determine that there has been any significant opportunity for confusion to have occurred.” *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *see also In re Jeep Corp.*, 222 USPQ 333, 337 (TTAB 1984); *In re Barbizon Int’l, Inc.*, 217 USPQ 735, 737 (TTAB 1983). Here, however, we have such evidence.

Before Applicant filed its application for the MS. INTERNATIONAL mark subject to this appeal, Registrants filed an intent-to-use application for the MS. INTERNATIONAL mark also for beauty pageant services. Applicant opposed Registrants’ application.⁸² During the opposition, Applicant propounded an

⁸² December 11, 2018 Office Action Response, TSDR 3; December 28, 2018 Suspension Letter, TSDR 1.

interrogatory asking Registrants to “[i]dentify any instances of actual confusion of which you are aware between the use of **any of your marks**” and Applicant’s MS. INTERNATIONAL mark subject to this appeal.⁸³ On February 7, 2019, Registrants responded under oath that they were not aware of any such instances.⁸⁴ Accordingly, we have a statement from Registrants “under penalty of perjury,” contemporaneous with this appeal, that Registrants are not aware of any actual confusion between the cited marks and Applicant’s MS. INTERNATIONAL mark.⁸⁵ *Cf. In re Majestic Distilling*, 65 USPQ2d at 1205-06 (registrant entered into coexistence agreements with third parties, but the agreements were “several years old” and registrant “may now have knowledge of incidents of actual confusion”). This evidence corroborates Ms. Jeske’s averment that there have not been any instances of actual confusion.⁸⁶ *Cf. In*

⁸³ February 20, 2020 Request for Reconsideration, Part I, TSDR 33-34 (emphasis added). Although the opposition concerned Registrants’ intent-to-use application for the mark MS. INTERNATIONAL, the interrogatory asks Registrants to identify instances of actual confusion with “any” of its marks.

⁸⁴ *Id.* at 35-38. We have ignored the preface to Registrants’ interrogatories attempting to reserve the right to raise certain objections in the future as such a reservation of rights is improper. Fed. R. Civ. P. 33(b)(4) (“The grounds for objecting to an interrogatory must be stated with specificity.”); *Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ2d 80, 83 (TTAB 1984) (“[I]t is incumbent upon a party who has been served with interrogatories to respond by articulating his objections (with particularity) to those interrogatories which he believes to be objectionable, and by providing information sought in those interrogatories which he believes to be proper.”). We have similarly ignored Registrants’ unilateral statement that “[t]he information supplied herein is for use in this proceeding only.” *Id.* at 35. “We find no warrant, in the statute or elsewhere, for discarding *any* evidence bearing on the question of likelihood of confusion.” *DuPont*, 177 USPQ at 567; *Duling v. Gristede’s Operating Corp.*, 266 F.R.D. 66, 75-76 (S.D.N.Y. 2010) (“[I]t is well established that the Federal Rules of Civil Procedure[] create no automatic prohibition against using discovery obtained in one litigation in another litigation”).

⁸⁵ February 20, 2020 Request for Reconsideration, Part I, TSDR 38 (verification).

⁸⁶ February 20, 2020 Request for Reconsideration, Part I, TSDR 26, Substitute Jeske Declaration, ¶ 3 (“Nor have there been any instances of confusion resulting from our use of the MS. INTERNATIONAL mark for the services claimed in the application.”).

re Guild Mortg. Co., 129 USPQ2d at 1163 (noting the absence of declarations from the registrant or “other parties testifying as to the absence of actual confusion”).

As for the opportunity for actual confusion, Ms. Jeske, Applicant’s Chief Executive Officer, avers:⁸⁷

All services claimed in [the involved] application were in use under the mark, MS. INTERNATIONAL, since at least as early as October 2010 and all services are currently in use. At no time has there been any discontinuation in the use of the MS. INTERNATIONAL mark for the services claimed in the application....

The cited MISS INTERNATIONAL mark has been used extensively for beauty pageants continuously during the ten-year period concurrent with Applicant’s extensive use of its MS. INTERNATIONAL mark for beauty pageants. Both pageants accept contestants from any state or region in the United States. Both pageants have been recognized as Top 10 Best in Pageantry by PageantPlanet.com in their respective category.

The record does not include specifics regarding the nature of Applicant’s and Registrants’ “extensive” and “continuous” use, and it appears that Applicant has held its pageants in California while Registrants have held their pageants in Tennessee.⁸⁸ Still, beauty pageants have broad geographic reach, both pageants accept contestants from “any state or region in the United States,” and both have been “recognized” by PageantPlanet.com, “a major resource for the beauty pageant industry with more than 266,000 followers.”⁸⁹

Based on this record, we find that there has been some meaningful opportunity for confusion to have occurred, and therefore, the absence of actual confusion is

⁸⁷ *Id.* at 26-27, Substitute Jeske Declaration, ¶¶ 3-4.

⁸⁸ 12 TTABVUE 7; Applicant’s specimens, TSDR 1.

⁸⁹ February 20, 2020 Request for Reconsideration, Part I, TSDR 26-27, 30, Substitute Jeske Declaration, ¶¶ 3-4 and 10.

probative. Accordingly, the eighth *DuPont* factor weighs somewhat in Applicant's favor.

F. Eleventh DuPont Factor

The eleventh *DuPont* factor concerns the “extent to which [A]pplicant has a right to exclude others from use of its mark on its [services.]” *DuPont*, 177 USPQ at 567; *see also* 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24.43 (5th ed. Dec. 2020 update) (factor eleven is apparently intended to draw attention to the strength of applicant or registrant's common law rights to exclude others). Applicant argues that it has the right to exclude others from using the MS. INTERNATIONAL mark based on its “extensive, longstanding, and continuous use of its MS. INTERNATIONAL mark” and because it “successfully opposed [Registrants'] application to register the mark, MS. INTERNATIONAL” for the same services.⁹⁰

In the few precedential Board cases discussing the eleventh *DuPont* factor, the applicants failed to show sufficient use of their marks to establish a right to exclude others from use of their marks on their goods. *In re Davey Prods.*, 92 USPQ2d 1198, 1205 (TTAB 2009); *see also McDonalds Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1284-85 (TTAB 2014). Here, Applicant has established “extensive” and “continuous” use of its mark for ten years.⁹¹ Applicant's successful opposition against Registrants' application for MS. INTERNATIONAL also is somewhat probative.⁹² As discussed,

⁹⁰ Appeal Brief, 19 TTABVUE 17.

⁹¹ *Id.* at 26-27, Substitute Jeske Declaration, ¶ 3-4.

⁹² We note, however, that an opposition proceeding concerns only the right to registration, not the right to use. *See, e.g., Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1309 (TTAB 2014) (right to register is the only issue within the Board's jurisdiction).

however, there is ubiquitous use and registration of marks for beauty pageants incorporating a female courtesy title and the term “International,” including the third-party mark INTERNATIONAL MS.⁹³

Accordingly, we find that the eleventh *DuPont* factor is neutral or only slightly favors Applicant.

III. Conclusion

Two key considerations in any likelihood of confusion analysis are the similarities between the marks and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). Here, those factors support a finding that confusion is likely. But not all *DuPont* factors may be “of equal weight in a given case, and ‘any one of the factors may control a particular case.’” *In re Majestic Distilling*, 65 USPQ2d at 1204. In the circumstances here, the extreme weakness of the cited mark and absence of actual confusion despite nearly ten years of “extensive” and “continuous” contemporaneous use are controlling. On the record before us, we find that confusion between Applicant’s mark and the cited mark is not likely.

Decision: The refusal to register Applicant’s mark, MS. INTERNATIONAL, under Section 2(d) of the Trademark Act is reversed.

⁹³ 12 TTABVUE 27. Reg. No. 5056192. February 20, 2020 Request for Reconsideration, TSDR 144.