

**This Opinion is Not a
Precedent of the TTAB**

Hearing:
November 3, 2015

Mailed:
January 7, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Miss World Limited
v.
Camila Productions Ltd.

—
Opposition No. 91206024
—

Patricia Hatry and Jeffrey C. Katz of Davis & Gilbert LLP,
for Plaintiff Miss World Limited.

Thomas T. Aquilla of Aquilla Patents & Marks PLLC,
for Defendant Camila Productions Ltd.

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Before Taylor, Mermelstein, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On September 26, 2011, The Worlds Pageants LLC filed an application to register on the Principal Register THE WORLDS PAGEANTS for “entertainment in the nature of beauty pageants” in International Class 41.¹ The mark is in standard characters, with “pageants” disclaimed and with a claim of acquired distinctiveness

¹ Application Serial No. 85431760, based on Applicant’s claim of first use anywhere and use in commerce since at least as early as November 1, 1999.

based on five or more years of substantially exclusive and continuous use pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). The application was assigned to Camila Productions Ltd. (“Applicant”) on September 19, 2012.²

Miss World Limited (“Opposer”) opposes registration of Applicant’s mark on the grounds that it is likely to cause confusion with, and to dilute the distinctive quality of,³ its common-law mark MISS WORLD and its registered marks MISS WORLD for “entertainment services – namely, conducting of beauty competitions,”⁴ and



for “entertainment services, namely, live shows featuring body appearance competitions and pageants; motion picture film production services; television show production services and videotape production services,” all in International Class 41.⁵

² Assignment recorded with the Assignment Recordation Branch of the U.S. Patent and Trademark Office at Reel/Frame 4918/0559.

³ Opposer alleged two additional causes of action in its Second Amended Notice of Opposition, the operative pleading in this proceeding. *See* 19 TTABVUE. Because Opposer did not argue these claims in its brief on the case, however, we deem them waived. *See, e.g., Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005).

⁴ Registration No. 877221, issued September 16, 1969; renewed. Exhibit 1 to the Trial Testimony of Stephen Douglas Anthony Morley (“Morley Tr.”), 22 TTABVUE 378. This registration is automatically of record because Applicant filed two counterclaims against it, notwithstanding their dismissal due to Applicant’s failure to prosecute, as noted *infra*. *See* Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).

⁵ Registration No. 3990366, issued July 5, 2011. Morley Tr., Exhibit 4, 22 TTABVUE 391-92. Opposer also pleaded three other registrations that have been cancelled under Trademark Act Section 8. We accordingly give them no consideration. *See Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973).

Applicant denied the allegations in the Notice of Opposition. Applicant also asserted two counterclaims, but because it failed to offer any evidence or file a brief on the case, the counterclaims were dismissed with prejudice.⁶

Opposer filed a brief on the case. An oral hearing, at which only counsel for Opposer appeared, was held on November 3, 2015.

We sustain the opposition on the ground of likelihood of confusion.

I. Record

Opposer submitted the following evidence:

- Trial Testimony of Stephen Douglas Anthony Morley (“Morley Tr.”), Opposer’s events director, with Exhibits 1-123 (22 TTABVUE); and
- Opposer’s Notice of Reliance, with Exhibits A-G (21 TTABVUE).

Applicant submitted no evidence.

II. Opposer’s Standing and Priority

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Opposer may establish its standing to oppose registration of Applicant’s mark by properly making of record its pleaded registrations and showing them to be valid, subsisting, and owned by Opposer. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

Trademark Rule 2.122(d)(2) provides that a “registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony.” Copies of Opposer’s

⁶ May 27, 2015 Board Order, 26 TTABVUE. We also note that Applicant submitted its answer to the Second Amended Notice of Opposition on December 27, 2014, six days after the deadline set by the Board. *See* 18 and 20 TTABVUE.

two subsisting pleaded registrations were introduced as Exhibits 1 and 4 to the Morley Tr., along with testimony we construe as establishing that the registrations are valid and subsisting, and owned by Opposer.⁷

Because Opposer's pleaded registrations are of record, priority is not an issue with respect to the goods and services covered by Opposer's pleaded registrations. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). Opposer also introduced evidence that it has used the MISS WORLD mark in the United States since 1951 in connection with beauty pageants.⁸

III. Likelihood of Confusion

We first address Opposer's likelihood of confusion claim. Our determination under Trademark Act Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services, the first two *du Pont* factors. *See 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.").

⁷ See Morley Tr. at 8:1-14:7, 22 TTABVUE 12-18.

⁸ Morley Tr. at 29:11-15, 22 TTABVUE 33.

A. Similarity of the Services

We first consider the second *du Pont* factor, which assesses the similarity or dissimilarity of the parties' goods or services. We base our evaluation on the services as they are identified in the application and registrations and, for Opposer's pleaded common-law mark MISS WORLD, its established prior use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

In comparing the goods or services, "[t]he issue to be determined . . . is not whether the goods of plaintiff and defendant are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source." *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). The parties' services need not be similar or even competitive to support a finding of likelihood of confusion. It is sufficient that the respective services are related in some manner, or that the conditions surrounding their marketing are such that they would be encountered by the same consumers under circumstances that could, in light of the similarity of the marks, give rise to the mistaken belief that they originate from or are associated with the same source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

Here, Applicant's identified services are "entertainment in the nature of beauty pageants." Opposer's common-law services are beauty pageants, while the services recited in its pleaded registrations are "entertainment services – namely, conducting of beauty competitions" and, in part, "entertainment services, namely,

live shows featuring body appearance competitions and pageants.” These services are highly similar, if not identical. The second *du Pont* factor thus weighs strongly in favor of a likelihood of confusion.

B. Similarity of the Marks

We turn next to the first *du Pont* factor, the similarity of the parties’ marks. In a likelihood of confusion analysis, we compare the marks in their entireties for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Opposer’s pleaded marks are MISS WORLD, MISS WORLD and



while Applicant’s mark is THE WORLDS PAGEANTS. Each mark shares the literal element WORLD. Indeed, WORLD is the only distinctive term in Applicant’s mark; “the” lacks source-identifying significance and the disclaimed term “pageants” is generic in association with beauty pageants. Although we recognize that the shared term WORLD is inherently somewhat suggestive in association with Opposer’s

services – particularly in light of the evidence that Opposer’s services are intended to be global in nature – we also note the record evidence that Opposer’s MISS WORLD mark has gained strength through more than 60 years of exclusive and continuous use of the mark in the United States.⁹

Opposer’s pleaded marks are distinguished somewhat from Applicant’s mark by the presence of the honorifics MISS and MR. However, because these terms have descriptive significance – *i.e.*, indicating the gender and, with respect to MISS, the marital status of competitors¹⁰ – in association with Opposer’s entertainment services, they do not significantly distinguish Opposer’s marks from Applicant’s more inclusive mark THE WORLDS PAGEANTS. Consumers aware of Opposer’s use of MISS WORLD and MR WORLD (and design) in connection with pageants would likely believe that Applicant’s mark is a reference to both of Opposer’s pageants. Similarly, the globe in Opposer’s mark



serves to emphasize the term WORLD, common among the marks.

⁹ Opposer submitted evidence that, although the pageant is based in the United Kingdom, the United States has sent an entrant known as Miss World USA each year since 1951 (joined beginning in the 1970s by entrants from Guam, Puerto Rico, and the U.S. Virgin Islands) and has conducted pageants in the United States to select contestants. *Id.* at 18:16-19:9, 22 TTABVUE 22-23; 73:16-75:25, 22 TTABVUE 77-79; Exhibit 17, 22 TABVUE 504-07.

¹⁰ Morley Tr. at 97:14-19, 22 TTABVUE 101.

For these reasons, we find that Applicant's mark is similar to Opposer's pleaded marks for purposes of the first *du Pont* factor, relating to similarity in appearance, sound, connotation and commercial impression. This factor also weighs in favor of a likelihood of confusion.

IV. Conclusion

We have found that the critical first and second *du Pont* factors weigh in Opposer's favor. Considering the record evidence as a whole, we find that Applicant's mark THE WORLDS PAGEANTS is likely to cause consumer confusion with Opposer's common-law mark MISS WORLD and registered marks MISS WORLD and



Because we have found for Opposer on its likelihood of confusion claim, we need not reach the merits of its dilution claim under Trademark Act Section 43(c). *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1172 (TTAB 2013).¹¹

Decision: The opposition is sustained pursuant to Trademark Act Section 2(d).

¹¹ Opposer's motion to amend its pleadings to conform to the evidence introduced at trial, filed November 5, 2015 (29 TTABVUE), is denied as moot.