

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Masquerade of Tampa Bay, Inc.

Serial No. 85325500

Kenneth L. Mitchell of Woodling, Krost and Rust for Masquerade of Tampa Bay, Inc.

Maria-Victoria Suarez, Trademark Examining Attorney, Law Office 102 (Mitchell Front, Managing Attorney).

Before Holtzman, Lykos and Adlin, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On May 19, 2011, Masquerade of Tampa Bay, Inc. (“applicant”) filed an application to register the mark displayed below



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for “charitable fund raising services for the benefit of multiple sclerosis research” in International Class 36.¹ The description of the mark is as follows:

The mark consists of the word "MASQUERADE" with a large "MS" in hot pink overlapping the black letters "AQUERADE" with a black mask and a swooping gray line leading from the mask underneath the word "MASQUERADE" with spots of purple, blue, brown, yellow and green and gray lines in the form of party tassels emanating from the mask, and the words "ONE STEP CLOSER TO UNMASKING A CURE FOR MULTIPLE SCLEROSIS" in black.

In addition, applicant claims the colors “hot pink, purple, blue, brown, yellow, green, black and gray” as features of the mark.

The Trademark Examining Attorney refused registration of applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant’s mark so resembles the registered marks MASQUERADE,² in standard character format, and the design mark displayed below³



both owned by the same individual and both for services identified as “charitable fundraising services” in International Class 36, that when used on or in connection

¹ Application Serial No. 85325500, filed pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging February 26, 2011 as the date of first use anywhere and in commerce.

² Registration No. 3247585, registered on May 29, 2007, alleging March 22, 2006 as the date of first use anywhere and in commerce.

with applicant's identified services, it is likely to cause confusion or mistake or to deceive.

Following a request for reconsideration which was denied, applicant has appealed the examining attorney's final refusal to register the application. The case is fully briefed. For the reasons explained below, we affirm the refusal to register.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). *See also, In re Majestic Distilling Company, Inc.*, 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 and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors and the other relevant *du Pont* factors are discussed below.

At the outset, we note that as identified, applicant and registrant are offering legally identical services. This is because registrant's charitable fundraising services are recited broadly without any limitation as to the beneficiary. As such, the registrations necessarily encompass applicant's more narrowly defined "charitable fund raising services for the benefit of multiple sclerosis research." *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009). In addition, because the recitations of the involved application and registrations are unrestricted as to

³ Registration No. 3574143, registered February 10, 2009, alleging September 21, 2006 as the date of first use anywhere and in commerce. Color is not claimed as a feature of the

trade channels, we must presume that both parties' legally identical charitable fundraising services travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers (in this case, donors). *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), *citing Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958). Consequently, applicant's argument that the services are distinct because applicant raises money by dinner fundraisers to benefit multiple sclerosis research whereas registrant's fundraising activities consist of "\$5 dollar jewelry sales" (Applicant's Brief, p. 9) necessarily fails. As we have often stated, we are bound by the respective recitations as stated in the involved application and registration(s). *Id.* Thus, the identical nature of the services and channels of trade weigh heavily in favor of finding a likelihood of confusion.

Because the services are identical, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). With this in mind, we now turn to the first *du Pont* likelihood of confusion factor regarding the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). "[T]he test 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 so

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that confusion as to the source of the goods offered under the respective marks is likely to result.” *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Jack B. Binion*, 93 USPQ2d 1531 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant argues that when the marks are compared in their entireties, they are different and not likely to be confused. More specifically, applicant contends that its design mark includes as a prominent term the abbreviation "MS" denoting "multiple sclerosis," the disease for which donations are sought. Based on this distinction, applicant asserts that the presentation of the acronym "MS" in combination with, and overlapping the letters "a" and "querade," creates a different commercial impression than the registered marks. Applicant also points to the additional phrasing in its mark, "ONE STEP CLOSER TO UNMASKING A CURE FOR MULTIPLE SCLEROSIS," as entirely different in sound, appearance, and meaning from registrant's stylized design mark MASQUERADE which includes the phrase "EXPERIENCE THE FRENZY!" as well as registrant's word mark MASQUERADE. In addition, applicant emphasizes the color elements of its applied-for design mark as creating a meaningful difference in commercial impression.

Applicant's arguments are unconvincing. Applicant's and registrant's marks all share the common term MASQUERADE which appears as either the sole term or

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prominently as the first term in each of the marks. It is well-established that prospective consumers are often more inclined to focus on the first part of a trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1692. *See also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). We acknowledge the obvious differences in wording, stylization, and design elements in the marks. Nonetheless, it is more likely that prospective consumers will overlook these distinctions and instead confuse the marks as identifying the same charitable fundraising services from the same source, given that they either commence with or consist solely of the word MASQUERADE.

To elaborate, the design elements in applicant’s mark when compared with those of Registration No. 3574143 do not obviate the similarity between the marks. 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). *See also 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 addition, we note that because registrant's word mark MASQUERADE is registered in standard format, it may be used in any stylized display or color scheme, including one that is identical to the special form drawing of the term MASQUERADE in applicant's applied-for mark. *See* Trademark Rule 2.52(a). That is to say, registrant has the right to use the mark MASQUERADE with "MS" appearing in larger, more prominent "hot pink" lettering and overlapping over the remaining letters "a" and "querade" in the same stylized font, size and shades of color as applicant's mark.

We therefore find that applicant's marks and registrant's marks are similar in appearance, sound, connotation and commercial impression. This first *du Pont* factor also weighs in favor of finding a likelihood of confusion.

To the extent that there are any other relevant *du Pont* factors, we treat them as neutral.

After considering all of the evidence of record and argument pertaining to the *du Pont* likelihood of confusion factors, we find that because the marks are similar, the services are legally identical, and the channels of trade and consumers are presumed to overlap, there is a likelihood of confusion between applicant's mark and the registered marks when used in connection with the identified services. To the extent there is any doubt, we resolve it, as we must, in registrant's favor. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

DECISION: The refusal to register is affirmed.