

From: Suarez, Maria-Victoria

Sent: 3/11/2013 9:37:49 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85325500 - MASQUERADE ONE
STEP CLOSER TO - 8710 - EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 85325500.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85325500

MARK: MASQUERADE ONE STEP CLOSER TO



CORRESPONDENT ADDRESS:

KENNETH L MITCHELL
WOODLING KROST AND RUST
9213 CHILLICOTHE RD
KIRTLAND, OH 44094-8500

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: MASQUERADE OF TAMPA BAY, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

8710

CORRESPONDENT E-MAIL ADDRESS:

ken.mitchell@clevepat.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Masquerade of Tampa Bay, Inc. (applicant), a non-profit corporation existing under the laws of Florida, has appealed the examining attorney's final refusal to register the mark MASQUERADE ONE STEP CLOSER TO UNMASKING A CURE FOR MULTIPLE SCLEROSIS (and design) for use in connection with charitable fund raising services for the benefit of multiple sclerosis research. Registration was refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis that the mark, as applied to the services, is likely to be confused with the marks MASQUERADE EXPERIENCE THE FRENZY! (in stylized form) in U.S. Registration No. 3574143 and MASQUERADE (in standard character) in U.S. Registration No. 3247585 for use in connection with charitable fundraising services – both owned by Douglas Kreyling, a United States citizen (registrant).

STATEMENT OF FACTS

On May 5, 2011, applicant applied to register the mark MASQUERADE ONE STEP CLOSER TO UNMASKING A CURE FOR MULTIPLE SCLEROSIS (and design) for use in connection with charitable fund raising services for the benefit of multiple sclerosis research.

On September 15, 2011, the examining attorney refused registration under Trademark Act Section 2(d), 15 U.S. C. §1052(d), based on the following registrations:

MASQUERADE EXPERIENCE THE FRENZY! (in stylized form)
[U.S. Registration No. 3574143] for use in connection with charitable fundraising services; and

MASQUERADE (in standard character) [U.S. Registration No. 3247585] for use in connection with charitable fundraising services.

The examining attorney also required a complete color claim and mark description, which was subsequently corrected.

On March 13, 2012, applicant argued against the refusal to register the mark under Section 2(d). The examining attorney considered applicant's arguments carefully but found them unpersuasive. Consequently, on April 30, 2012, the examining attorney

issued a final refusal to register on the grounds that applicant's mark is likely to be confused with the registered marks.

Applicant filed a Notice of Appeal on October 25, 2012, and submitted its brief on December 23, 2012.

ARGUMENT

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, 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). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court 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 of the factors may control 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 de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their

entireties that confusion as to the source of the goods and/or services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

I. APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO REGISTRANT'S MARKS

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *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).

A. Comparison of Applicant's Mark and U.S. Registration No. 3574143

[MASQUERADE EXPERIENCE THE FRENZY!]

Applicant's mark consists of the word "MASQUERADE" with the "M" and "S" in hot pink overlapping the black letters "A" and "QUERADE" 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 phrase "ONE STEP CLOSER TO UNMASKING A CURE FOR MULTIPLE SCLEROSIS" in black. Applicant's mark and the mark in U.S. Registration No. 3574143 are very similar in that they share the salient wording "MASQUERADE." 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).

Applicant maintains that the examining attorney has not considered all the elements of its mark. Marks must be compared in their entireties and should not be dissected; however, the examining attorney may weigh the individual components of a

mark to determine its overall commercial impression. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark”); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011).

Applicant states that its “design mark includes a prominent ‘MS’ and these letters are to denote ‘Multiple Sclerosis’ [...] It is respectfully suggested that the presentation of ‘MS’ in combination with and overlapping the letters ‘aquerade’ creates a completely different commercial impression than either registration.” The examining attorney respectfully disagrees. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser’s memory and to be used when requesting the services. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). What is more,

the design of a mask in applicant's mark reinforces the commercial impression of a masquerade.

In applicant's mark, the letters "M" and "S" are not separate from the term "MASQUERADE", but part of the word itself. In calling for the services, consumers would say "MASQUERADE," and not "MS" or "AQUERADE." The term "MASQUERADE" appears larger than the other elements in the mark and is more significant than the other features in creating an impression in the minds of consumers. In fact, the presentation of the letters "M" and "S", and the wording "MULTIPLE SCLEROSIS" in the slogan "ONE STEP CLOSER TO UNMASKING A CURE OF MULTIPLE SCLEROSIS" are less significant in terms of affecting the mark's commercial impression because they are descriptive in the context of applicant's services, thus rendering the wording "MASQUERADE" the more dominant, source-indicating element of applicant's mark.

B. Comparison of Applicant's Mark and U.S. Registration No. 3247585

[MASQUERADE]

Similarly, applicant's mark and the mark in U.S. Registration No. 3247585 are very similar in that they share the dominant wording "MASQUERADE." The stylization of applicant's mark is irrelevant when comparing it to the registered mark because the registered mark is presented in standard character. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or

other literal element and not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”); *In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). That is to say, the mark in U.S. Registration No. 3247585 could be presented in the exact same font style, size and color as applicant’s mark.

II. APPLICANT’S SERVICES ARE HIGHLY RELATED TO REGISTRANT’S SERVICES

In a likelihood of confusion analysis, the comparison of the parties’ services is based on the 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).

Applicant may not restrict the scope of services covered in the registrations by extrinsic arguments. *See, e.g., In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764

(TTAB 1986). When analyzing an applicant's and registrant's services for similarity and relatedness, that determination is based on the description of the services stated in the application and registrations at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

In this case, the identification set forth in the cited registrations uses broad wording to describe registrant's services and does not contain any limitations as to nature, type, channels of trade or classes of purchasers. Therefore, it is presumed that the registrations encompasses all charitable fundraising services, including for the benefit of multiple sclerosis research, that the 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).

The overriding concern is not only to prevent buyer confusion as to the source of the 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).

CONCLUSION

Based on case law, applicant's mark, when used on or in connection with the identified services, so resembles the marks in U.S. Registration Nos. 3574143 and 3247585 as to be likely to cause confusion, to cause mistakes, or to deceive. The examining attorney, therefore, respectfully requests that the Board affirm the refusal to register the mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Respectfully submitted,

/Maria-Victoria Suarez/
Trademark Attorney
Law Office 102
571-272-9264
maria-victoria.suarez@uspto.gov

Mitchell Front
Managing Attorney
Law Office 102