

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 3, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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The Worlds Pageants, LLC and Camila Productions Ltd.

v.

Miss G-String International LLC

—
Opposition No. 91200183
—

Thomas T. Aquilla of Aquilla Patents & Marks, PLLC
for The Worlds Pageants, LLC and Camila Productions, Ltd.

Luke Lirot of Luke Charles Lirot, P.A.
for Miss G-String International LLC.

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Notice of Correction

By the Board:

On July 29, 2016, the Board mailed a final decision in this proceeding. The decision was inadvertently marked precedential. In the caption and on page 2, Opposer, The Worlds Pageants LLC was referred to as “The World Pageants, LLC.” The language “the sixth affirmative defense as two new defenses lack of standing and unclean hands, which are in lines 5-6 on page 3 were inadvertently highlighted.

In view thereof, the decision is hereby corrected to properly indicate that the decision is not precedential, to correct the spelling of Opposer's name in the caption and on page 2 of the decision, and to delete the highlighting on page 3 of the decision.

Attached hereto is a corrected form of the July 29, 2016 decision.

The time for filing an appeal or commencing a civil action by either party regarding the Board's decision continues to run from the mailing date of the July 29, 2016 decision. *See* Trademark Rule 2.145(d)(1), 37 C.F.R. § 2.145(d)(1).

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Before Lykos, Gorowitz, and Pologeorgis, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Miss G-String International LLC (“Applicant”) filed an application to register the mark MISS G-STRING INTERNATIONAL & design, as illustrated below:



for the following services:

Entertainment services in the nature of conducting beauty pageants and talent contest in International Class 41.¹

The following description of the mark was entered in the application: “The mark consists of the stylized wording ‘MISS G-STRING INTERNATIONAL’ with the wording ‘G-STRING’ in yellow gold. The word ‘MISS’ in white is above the word ‘G-STRING’ and the wor[d] ‘INTERNATIONAL’ in white is below ‘G-STRING’. All of the wording is outlined in black. All of the words are superimposed on a woman's pink undergarment.” The colors white, yellow gold, pink and black are claimed as a feature of the mark. The phrase “G-STRING INTERNATIONAL” has been disclaimed.

The Worlds Pageants, LLC (“Opposer”)² opposed the application on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Specifically, Opposer alleges prior use and registration of the mark MISS NUDE INTERNATIONAL (typed form)³ for “entertainment services in the nature of

¹ Application Serial No. 77753000 was filed on June 5, 2009, based upon Applicant's allegations of first use anywhere and first use in commerce on or in connection with all of the services since at least as early as April 29, 2009.

² By order dated June 29, 2013, the Board acknowledged the assignment of Registration Nos. 2037202 and 3039826 from The Worlds Pageants, LLC to Camila Productions, Ltd. and joined Camila Productions as a party plaintiff. Hereinafter The Worlds Pageants, LLC and Camila Productions, Ltd. are hereinafter jointly referred to as “Opposer.”

³ It is noted that prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks”). *See also* Trademark Manual of Examining Procedure (TMEP) § 807.03(i) (April 2016).

promoting and conducting beauty pageants” in International Class 41. The phrase “NUDE INTERNATIONAL” has been disclaimed.

Applicant filed an answer denying all salient allegations in the notice of opposition and asserted six “affirmative defenses.”⁴ Applicant filed an amended answer on July 16, 2012 and repleaded the sixth affirmative defense as two new affirmative defenses: lack of standing and unclean hands. The issue of standing will be discussed below. Applicant has not established that Opposer has unclean hands and thus, this affirmative defense is dismissed.

On July 10, 2012, Applicant’s principal, William Eadie filed an action titled “Petition to Cancel”, in which Mr. Eadie requested that ownership of Opposer’s Registration Nos. 2037202 and 3039826 be transferred to Mr. Eadie. The proceeding, Cancellation No. 92055838, was deemed to be analogous to a counterclaim and was consolidated with the current proceeding. Board Order dated August 24, 2012 at 19 TTABVUE. Mr. Eadie subsequently filed two amended petitions, the last of which was filed on July 18, 2013. Third Amended Petition to Cancel at 31 TTABVUE. Mr. Eadie alleged that he acquired, by assignment, a judgment against Opposer’s predecessors, which under Florida law entitled him to acquire the trademark registrations at issue in the petition to cancel. However, since the Board has no

⁴ Applicant’s first affirmative defense was failure to plead a claim. In an order dated June 21, 2012, the Board held that Opposer had properly pleaded a claim under Section 2(d). 14 TTABVUE 2. On the basis thereof, we deem Applicant’s first affirmative defense of failure to state a claim as moot. The Board also found that four of the six affirmative defenses alleged were actually amplifications of denials in the notice of opposition. *Id.* at 8. With respect to the sixth affirmative defense, the Board found that Applicant had interwoven several arguments, only some of which were properly before the Board. *Id.* at 15. Applicant was granted leave to replead the sixth affirmative defense. *Id.*

jurisdiction to adjudicate issues arising under Florida law, the petition was dismissed with prejudice. *See* Board Order dated November 27, 2013 at 35 TTABVUE. This determination is germane to the current proceeding since Applicant is asserting its ownership of the registrations at issue in the cancellation action.

The Record.

The record includes the pleadings, and by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the opposed application and the two registrations that were the subject of the counterclaim. In addition, the parties introduced the following evidence:

Opposer's evidence:

1. Copies of unauthenticated documents purporting to be Opposer's advertising – Exhibit B to Opposer's Notice of Reliance, 50 TTABVUE 4-11;
2. Copies of documents from the USPTO Assignment Database– Exhibit C to Opposer's Notice of Reliance, 50 TTABVUE 12-28;
3. Copies of corporate filings with the Florida Secretary of State – Exhibit D to Opposer's Notice of Reliance, 50 TTABVUE 31-40;
4. Copies of unauthenticated documents purporting to be Opposer's and Applicant's advertising – Exhibit G to Opposer's Notice of Reliance, 50 TTABVUE 41-48;
5. Copy of an unauthenticated document purporting to be Applicant's advertising – Exhibit H1 to Opposer's Notice of Reliance, 50 TTABVUE 49;
6. Copies of articles from the internet and unauthenticated documents - Exhibit H2 to Opposer's Notice of Reliance, 50 TTABVUE 50-56; and

7. Copy of testimony transcript from opposition by Miss World Limited against Opposer, (Cardoso Test.), 50 TTABVUE 60-106.⁵

Applicant's evidence:

- Testimony of William Eadie, Managing Member of Applicant, (Eadie Test.), 56 TTABVUE.

Standing.

By bringing Cancellation No. 92055838 to transfer ownership of Registration Nos. 2037202 and 3039826 to Mr. Eadie, which action was consolidated with the current action, pleaded registration No. 2037202 was made of record in this action. However, the petition, which was based on a monetary judgment acquired by assignment, was filed against R&D Promotions, Inc., the judgment debtor. As discussed above, the Board has no jurisdiction to adjudicate issues arising under Florida law. Accordingly, the petition was dismissed with prejudice. November 27, 2013 Board Order at 35 TTABVUE. Therefore, Applicant cannot attack Opposer's title based on the purported putative assignment of Opposer's registrations to Mr. Eadie.

Applicant then argues that the assignment from The Worlds Pageants, LLC to Camila Productions Ltd. was invalid because "Cardoso's third assignment document reveals it is temporally and factually false." Applicant's Brief, 68 TTABVUE 22. The third assignment" is from The Worlds Pageants, LLC, a Florida limited liability

⁵ The transcript is testimony from an unrelated opposition between Opposer and a third party who is not in privity with Applicant. As such, it cannot be introduced by notice of reliance. However, since Applicant has relied on the testimony, we consider it to be of record by stipulation of the parties. See Trademark Trial and Appeal Board Manual of Procedures (TBMP) § 704.13 (2016) ("[a] testimony deposition from another proceeding may also be made of record in a Board proceeding by stipulation of the parties approved by the Board.").

company to Camila Productions, LLC, a New Hampshire limited liability company.⁶ Applicant argues that at the time of the assignment, the registration was owned by The Worlds Pageants LLC a New Hampshire limited liability company and that the Florida limited liability company was no longer in existence. *See* Applicant's Brief, 68 TTABVUE, 8-9. Contrary to Applicant's assertion, the Florida limited liability company was an active company at all relevant times: September 19, 2012 (the date the assignment document was executed) and December 13, 2012 (the date the assignment document was recorded). Board Order dated June 29, 2013, 30 TTABVVUE 3 fn.2. Moreover, the record does not reflect the existence of a New Hampshire limited liability company named The Worlds Pageants LLC.

Further, Opposer has made of record by notice of reliance the assignment records from the USPTO database establishing that its registration is owned by Opposer. Accordingly, Opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority.

Opposer's ownership of pleaded Registration No. 2037202 removes priority as an issue with respect to entertainment services in the nature of promoting and conducting beauty pageants. *See Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1169 (TTAB 2011) (citing *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 82 USPQ 108 (CCPA 1974)).

⁶ *See* fn. 2.

Likelihood of Confusion.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

1. Similarity or dissimilarity of the services, channels of trade and class of purchasers.

We start our analysis with the second and third *du Pont* factors and look at the relationship between the services at issue, the channels of trade in which they travel and the class of purchasers. When determining the relationship between the services,

[t]he authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods [and services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods [and rendering of services] are directed.

Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014).

Applicant's services are identified as: "entertainment services in the nature of conducting beauty pageants and talent contests" and Opposer's services are identified as: "entertainment services in the nature of promoting and conducting beauty pageants." As identified, the services are identical. In addition, there are no restrictions in either the application or the registration as to the channels of trade in which Applicant's and Opposer's services are rendered.

"It is well established that absent restrictions in the application and registration, [identical] goods and services are presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 101 USPQ2d at 1908. Because the services are identical, they are presumed to travel in the same channels of trade to the same classes of purchasers.

Accordingly, the second and third *du Pont* factors favor a finding of likelihood of confusion. However, despite this, we find that confusion is not likely because of the crucial differences in the marks, which is discussed below.

2. Similarity or dissimilarity of the marks.



The marks at issue are: and MISS NUDE INTERNATIONAL (typed form), which we compare “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps.*, 73 USPQ2d at 1691. “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.*, 688 F3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (emphasis added).

While “the similarity or dissimilarity of the marks is determined based on the marks in their entirety ... there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety.” *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this case, the dominant portion of Applicant’s mark is the word “G-STRING,” which is depicted in gold script and is larger than the other words in the mark; and the depiction of a pink G-string.

The other words in the mark, which are the only common elements between Applicant’s and Opposer’s marks, “MISS” and “INTERNATIONAL,” are positioned above and below the word “G-STRING” and are very small in comparison.

For the reasons discussed above, we find that the overall commercial impression of Applicant's mark is dominated by the word G-STRING and its design feature, a pink G-STRING, which emphasizes the word "G-STRING," and that this weighs heavily against a conclusion that confusion is likely.

We readily acknowledge that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)). But Applicant's mark is so different from the registered mark that even when used on identical services, confusion is unlikely. "No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark." *Mighty Leaf*, 94 USPQ2d at 1259.

In sum, we find the first *du Pont* factor, the differences between the marks, to outweigh the other factors. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (Federal Circuit affirmed Board finding of no likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, where Board relied solely on dissimilarity of marks); *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive").

3. Conclusion.

Having considered all the evidence and arguments on the relevant *du Pont* factors, whether specifically discussed herein or not, we conclude that there is no



likelihood of confusion between Applicant's mark for "entertainment services in the nature of conducting beauty pageants and talent contests" and Opposer's mark MISS NUDE INTERNATIONAL for "entertainment services in the nature of promoting and conducting beauty pageants."

Decision: The opposition is dismissed.