

This Opinion is Not a  
Precedent of the TTAB

Mailed: January 9, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Primeway International LLC*  
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Serial No. 87059786  
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Billy Hoang, Principal of Primeway International LLC, pro se.

Jeffrey J. Look, Trademark Examining Attorney, Law Office 108,  
Steven Berk, Acting Managing Attorney.

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Before Zervas, Mermelstein, and Wolfson,  
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Primeway International LLC (“Applicant”) seeks registration on the Principal Register of the mark INCOGNITO (in standard characters) for “footwear; footwear for men; footwear for women; shoes; shoes for men and women” in International Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 87059786 was filed on June 3, 2016, under Section 1(b) of the Trademark Act, based on Applicant’s allegation of a bona fide intent to use the mark in commerce.

The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with Registration No. 4172560 for the mark depicted below for "hats; hooded sweatshirts; jackets; shirts; t-shirts."<sup>2</sup>



When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

### **I. 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 *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is

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<sup>2</sup> Registered on the Principal Register on July 10, 2012. A declaration under Section 8 has been accepted.

evidence of record. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (even within *du Pont* list, only factors that are “relevant and of record” need be considered); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (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.”). *See also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

#### **A. The Marks**

We start with the first *du Pont* factor, that is, whether Applicant’s INCOGNITO mark and Registrant’s STS “INCOGNITO” and design mark are similar when viewed in their entirety in terms of appearance, sound, connotation and commercial impression. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014), (quoting *Palm Bay Imps., Inc. v. Veuve*

*Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). The test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result. *See i.am.symbolic*, 123 USPQ2d at 1748; *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).


While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. *In re Covalinski*, 113 USPQ2d 1166, 1168 (TTAB 2014); *see also In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[T]here 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 consideration of the marks in their entireties.”). When a mark comprises both words and a design, the words are normally accorded greater weight because they are more likely to be impressed upon a purchaser’s memory and would typically be used by purchasers to request the goods or services. *See, e.g., In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012); *In re Covalinski*, 113 USPQ2d at 1168-69. However, “[t]his is

not to say that the Board cannot, in appropriate circumstances, give greater weight to a design component of a composite mark.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135 (Fed. Cir. 2015). Such may be the case where, as here, the mark contains unusual or uncommon design features.

Applicant’s mark features the unusual design of a wolf in sheep’s clothing making a menacing expression, standing on top of the word “incognito” and holding out its arm with a raised hand against the letters STS:



The wolf design and letters STS immediately draw one’s attention and engage the viewer before he or she may notice the smaller word “incognito” in quotation marks below the picture of the wolf. We find this large wolf design and STS combination to be the mark’s “most visually prominent feature.” *Id.* (citing *In re Comput. Commc’ns, Inc.*, 484 F.2d 1392, 179 USPQ 51, 52 (CCPA 1973) (Board did not err in focusing on the design portion because the Board found the large design portion to be the mark’s “most visually prominent feature”)); *see also In re Covalinski*, 113 USPQ2d at 1169 (no likelihood of confusion between RACEGIRL (in standard

characters) and  for clothing due to prominence of overlapping letters “R”); *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009) (no likelihood of confusion between VOLTA (in standard characters) for caffeine-



infused vodka and TERZA VOLTA and design (due to the prominent design in the registered mark); *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (prominently displayed design of a torso wearing a cape considered to



be dominant element of the mark BODYMAN and design because the design catches the eye and engages the viewer before the viewer looks at the word “Bodyman”); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79



(TTAB 1987) (no likelihood of confusion between STEVE’S (in typed characters) for ice cream; “Even with the word ‘STEVE’S’ appearing above the hot dog figures, applicant’s mark is distinguishable from the registered mark of opposer, which is simply the word ‘STEVE’S’ in block letter form.”).

We note the Examining Attorney’s argument that the “design element of the wolf dressed like a sheep simply emphasizes the meaning of the term ‘incognito’ as the wolf has assumed the identity of a sheep.”<sup>3</sup> We disagree. The phrase “wolf in sheep’s clothing” refers to a threat that may appear to be benign,<sup>4</sup> and the term “incognito,”

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<sup>3</sup> 9 TTABVUE 8. We take judicial notice of the Merriam-Webster dictionary definition, attached to the Examining Attorney’s appeal brief, *Id.* at 14, of “incognito” as “with one’s identity concealed.”

<sup>4</sup> We take judicial notice of an idiomatic definition of *wolf*, “14. wolf in sheep’s clothing, a person who conceals his or her evil intentions or character beneath an innocent exterior.” <https://www.dictionary.com/browse/wolf?s=t> (visited Jan. 2, 2019), based on the Random House Unabridged Dictionary (Random House, Inc. 2019).

defined as “with one’s identity concealed,”<sup>5</sup> does not imply anything about whether the entity concealing its identity is a threat. The connotation of Applicant’s wolf design is distinct from the word incognito, and we cannot say that the design simply reinforces the word.

We are also unpersuaded by the Examining Attorney’s argument that in general, consumers are less likely to remember arbitrary strings of letters than they are to recall words, and that they would be likely to shorten Registrant’s mark to “INCOGNITO.”<sup>6</sup> Here, to the extent that consumers would shorten Registrant’s mark, they are at least as likely to recall STS as they are to recall “INCOGNITO” because of the prominence of STS relative to “INCOGNITO,” and because STS appears first when reading the mark, as would be usual, from left to right. *See 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”); *see also, Palm Bay*, 73 USPQ2d at 1692; *Century 21*

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<sup>5</sup> At <https://www.merriam-webster.com/dictionary/incognito>. We take judicial notice of the definition submitted by the Examining Attorney with his brief, 9 TTABVUE 14.

<sup>6</sup> The Examining Attorney relies on *Textron, Inc. v. Maquinas Agricolas Jacto, SA*, 215 USPQ 162 (TTAB 1984) and *Edison Bros. Stores, Inc. v. Bruttling EB Sport Int’l*, 230 USPQ 530 (TTAB 1986) for this proposition. In *Textron*, the Board compared a single stylized “J” letter mark with a differently stylized letter “J” and in *Edison Bros.*, the Board compared the mark EB surrounded by a diamond border with the typed mark EBS. The principle applied by the Board in each case was that confusion is more likely between sets of letters than it is between other types of marks. “The difficulty of remembering such lettered marks makes confusion between such marks, when similar, more likely.” *Edison Bros.*, 230 USPQ at 533. The principle is not applicable to this appeal where we compare a mark comprising a letter set plus additional elements with a standard character word-only mark.

*Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).<sup>7</sup>

For the reasons discussed above, we find that Registrant's mark is dominated by the design of the wolf making a "stop" sign with its hand against the large stacked letters STS; that the term "incognito is subordinate thereto; and that Applicant's mark is not similar in meaning or commercial impression to Registrant's mark and only somewhat similar in appearance and pronunciation, and that the first *du Pont* factor weighs heavily against likelihood of confusion.

### **B. Relatedness of the Goods**

We next turn to the second *du Pont* factor, the relatedness of the goods. Applicant's goods are "footwear; footwear for men; footwear for women; shoes; shoes for men and women." Registrant's goods are "hats; hooded sweatshirts; jackets; shirts; T-shirts." Because we must make our determination of relatedness based on the goods as they are identified in the application and registration, we do not consider the printouts from Registrant's website, submitted by Applicant, as narrowing the scope of the goods on which Registrant uses its mark,<sup>8</sup> and Applicant's argument that Registrant

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<sup>7</sup> We are similarly unpersuaded with the argument that because Applicant's mark is a standard character mark "there is nothing which would prevent applicant from adding a design of a sheep or a wolf or a wolf in sheep's clothing to its 'Incognito' mark now or in the future." Under Trademark Rule 2.52(a)(1), Applicant's mark could be presented in any font style, size or color, including that used for the literal elements of Registrant's mark. But the scope of the rule does not extend to design features in a mark. *See In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187 (TTAB 2018) (when comparing a standard character mark to a word + design mark for Section 2(d) purposes, the Board "will consider variations of the depictions of the standard character mark *only with regard to* 'font style, size, or color' of the 'words, letters, numbers, or any combination thereof.'").

<sup>8</sup> *See, e.g.*, printouts at June 28, 2017 Response to Office Action at TSDR 9-17 showing that Registrant offers "automatic knives" under its mark.



primarily sells “tactical hardware (mainly combat auto switch blade knives) on its website, ecommerce store, and You[T]ube channel,”<sup>9</sup> and uses its mark only peripherally on clothing, is irrelevant. An applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence. *See Stone Lion*, 110 USPQ2d at 1161 (“It was proper, however, for the Board to focus on the application and registrations rather than on real-world conditions, because ‘the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application.’) (citing *Octocom Sys., Inc. v. Houston Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008) (“[A]pplicant’s reliance on registrant’s website in an attempt to restrict the scope of registrant’s goods is to no avail.”); *cf. In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013) (even though applicant limited its bar services to those located in a casino, the bar services identified in the cited registration were not limited and were therefore presumed to encompass all types of bar services, including those located in a casino).

It is settled that the respective goods need not be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that the goods emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722; *see also In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565,

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<sup>9</sup> 7 TTABVUE 3.

223 USPQ 1289, 1290 (Fed. Cir. 1984). The issue is not whether purchasers would confuse the respective goods, but rather whether there is a likelihood of confusion as to the source of these goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

To show that goods of the type involved in this appeal are offered for sale under the same mark and therefore would be considered related, the Examining Attorney submitted web pages from two retailers, Nike and Adidas, who sell both shirts and shoes directly to consumers via their own online websites, and from Target, which sells a wide variety of footwear and clothing under various marks including MERONA, C9 CHAMPION, MOSSIMO, and DICKIES brand clothing and footwear.

For example, Nike sells hooded jackets and shoes through its website under its

 design mark:<sup>10</sup>



1 Color

USAB Nike Revolution Hooded  
Men's Jacket



Customize

Nike Air Max 1 Ultra Flyknit iD  
Shoe

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<sup>10</sup> At store.nike.com, attached to September 19, 2016 Office Action at TSDR 13 and 21.



Adidas sells shoes and clothing bearing the mark through its website:<sup>11</sup>



**AX 2.0 MID GTX SHOES**  
Men's Outdoor



2 colors

**ADIDAS STELLASPORT LONG HOODIE**  
Women's adidas STELLASPORT

and Target sells both footwear (shoes and sandals) and clothing (jackets and t-shirts) online under the MERONA, C9 CHAMPION, MOSSIMO, and DICKIES trademarks:<sup>12</sup>

<sup>11</sup> At [www.adidas.com](http://www.adidas.com), attached to September 19, 2016 Office Action at TSDR 25 and 12.

<sup>12</sup> At <https://www.target.com>, attached to September 20, 2017 Office Action at TSDR 22 and 9 (MERONA); TSDR 26 and 15 (C9 CHAMPION); TSDR 22 and 3 (MOSSIMO) and TSDR 9 and 20 (DICKIES).

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choose options



**\$16.98** reg \$19.99

Men's Garrison Adult Loafers Gray - Merona™



add to cart

**\$8.98** reg \$29.99

Men's Sweater Fleece Hoodie - Merona™



choose options



**\$7.48** reg \$14.99

Men's Seth Slide Sandals - C9 Champion® Blue



add to cart

**\$12.99**

Men's Tech T-Shirt - C9 Champion®



add to cart

**\$39.99**

Men's Coach's Jacket - Mossimo Supply Co.™...



choose options



**\$19.58** reg \$27.99

Men's James Adult Sneakers - Mossimo Supp...



add to cart



**\$24.98** reg: \$49.99

Dickies® - Men's Colorblock Henley with Ho...

☆☆☆☆☆ 0 ● ●



choose options



**\$59.99**

Men's Manuel Dickie's Black Work Boot

While these web pages are evidence that footwear and clothing are commercially related goods, the evidence is not strong. All of the websites offer clothing and footwear on different web pages. A consumer searching for shoes on the Target website will not be exposed to clothing because the web pages do not include any links from clothing to footwear or vice versa or images of other goods. Likewise, consumers searching on the Nike or Adidas websites for shoes or for clothing may not be aware that each offers both items, because not all of the pages include tabs that link to both clothing and footwear. For example, the Adidas web pages for women's clothing do not include a link to footwear and all but one of the Nike web pages for men's clothing do not indicate that Nike also sells footwear.<sup>13</sup> Moreover, to the extent there are tabs on a web page that link to both types of available goods, the tabs alone, as they display no trademarks, do not prove that the clothing or footwear would necessarily bear a NIKE or ADIDAS mark, or that in the case of Target, the clothing or footwear would bear a single mark.<sup>14</sup> Accordingly, the similarity of the goods factor only slightly weighs in favor of a finding of likelihood of confusion.

### **C. Channels of Trade and Classes of Purchasers**

With respect to the channels of trade for Applicant's and Registrant's goods, because Applicant's application and the cited registration describe the goods broadly,

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<sup>13</sup> See, e.g., September 19, 2016 Office Action at TSDR 8-12 (Adidas web pages for women's clothing; no indication that footwear is sold by Adidas); see also the Nike web page for men's jackets (no indication that footwear is sold by Nike), *id.* at TSDR 13-17 and 19-20.

<sup>14</sup> See September 19, 2016 Office Action at TSDR 18 (web page for NIKE brand tops & t-shirts that includes links to other categories, including "Shoes" (without reference to "Nike"), as compared with a link to the category "Compression & Nike Pro" (which does reference "Nike").

and there are no limitations as to their nature, type, channels of trade, or class of purchasers, it is presumed that the identifications encompass all goods of the type described, that they move in all normal channels of trade for such goods, including the Internet, and that they are available to all classes of purchasers normal for such goods. *See Stone Lion*, 110 USPQ2d at 1161; *see also Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (where there are no limitations as to channels of trade or classes of purchasers in either the involved application or registration, we must presume that the identified goods and services move in all channels of trade normal for such goods or services and are available to all potential classes of ordinary consumers of such goods or services); *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 1990) (“We have no authority to read any restrictions or limitations into the [applicant’s or] registrant’s description of goods.”). Since the relevant purchasers in this case include members of the general public who purchase clothing or shoes, consumers of the identified goods comprise a particularly large group.

Here, we only have web pages as evidence. Internet evidence alone is insufficient to prove that the goods may be encountered in overlapping channels of trade by the same classes of consumers. *See In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087-88 (Fed. Cir. 2014) (“The PTO goes too far, however, in claiming that because both St. Helena’s services and the registrant’s goods are promoted through websites, the channels of trade are similar. Advertising on the Internet is ubiquitous

and ‘proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.’”) (citing *Kinbook, LLC v. Microsoft Corp.*, 866 F. Supp. 2d 453, 470-71 n.14 (E.D. Pa. 2012)) (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 24:53.50 (4th ed. Supp. 2011)). Without more persuasive evidence, the *du Pont* factor regarding trade channels is neutral.<sup>15</sup> There is no dispute, however, that the purchasers are identical for both Applicant’s and Registrant’s goods.

## II. Summary

Although the record evidence shows some relationship of the goods and we can conclude that the potential purchasers are the same, given the noted differences between the marks, we find the first *du Pont* factor to be dispositive, in that this factor of the dissimilarities of the marks simply outweighs the other factors. *See Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (“a single *du Pont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (“[E]ven if all other relevant *DuPont* factors were


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<sup>15</sup> The Examining Attorney invokes *In re Viterra Inc.*, 671 F3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012), for the proposition that the goods must be presumed to travel in the same channels of trade to the same class of purchaser because there are no restrictions as to their nature, type, channels of trade or classes of purchasers. However, the presumption only applies when the goods are identical. Where, as here, the goods are not identical, we may presume only that they travel in whatever trade channels are normal for each type of product. There is no presumption that these normal trade channels are the same for different goods. *See Coach Servs.*, 101 USPQ2d at 1723 (absent limitation, “goods are presumed to travel in all normal channels ... for the relevant goods.”).



considered in [opposer's] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.”); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (Federal Circuit affirmed 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 Enters. 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”). Under the facts of this case, because of the very different appearance and commercial impression of the marks, we find that confusion is not likely between Applicant's INCOGNITO mark for footwear and shoes and



Registrant's mark  for “hats; hooded sweatshirts; jackets; shirts; t-shirts.”

### III. Decision:

The refusal to register Applicant's mark under Trademark Act Section 2(d) is reversed.