

This Opinion Is Not a
Precedent of the TTAB

Mailed: January 15, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re HEG Inc.

—
Serial No. 87061391

—
Brian L. Michaelis of Seyfarth Shaw LLP,
for HEG Inc.

Kristin Carlson, Trademark Examining Attorney, Law Office 105,
Jennifer L. Williston, Managing Attorney.

—
Before Hightower, Heasley, and Coggins,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Applicant HEG Inc. seeks to register on the Principal Register the mark



for “retail convenience store services” in International Class 35.¹ The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act,

—
¹ Application Serial No. 87061391 was filed June 6, 2016, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the

15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the services identified in the application, so resembles the marks in three registrations on the Principal Register as to be likely to cause confusion, to cause mistake, or to deceive.

The cited marks, all with the same owner, are:

- KICKS (typeset) for “retail convenience store services” in International Class 42;²



-  for “retail convenience store services” in International Class 35;³ and



-  for “retail convenience stores” in International Class 35.⁴

After the Examining Attorney made the refusal final, Applicant appealed to this Board. The appeal is fully briefed. We affirm the refusal to register.

mark in commerce. The description of the mark states: “The mark consists of a kicking donkey between two horizontal lines, above the cursive word ‘KICKSMART’, the entirety surrounded by a geometric shape.” Color is not claimed as a feature of the mark.

² Registration No. 2067834, issued June 3, 1997; renewed twice. Before November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (Oct. 2018). Retail store services transferred from Class 42 to Class 35 in 1997.

³ Registration No. 2218164, issued January 19, 1999; renewed once. The mark is lined for the color red.

⁴ Registration No. 3653968, issued July 14, 2009. The description of the mark states: “The mark consists of the word ‘KICKS’ with an expanded stylized ‘K’ followed by the block letters ‘icks’.” Color is not claimed as a feature of the mark.

I. Likelihood of Confusion

Our determination under 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. *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 [or services] and differences in the marks.”).

We focus our likelihood of confusion analysis on the cited mark KICKS in typeset form, Registration No. 2067834. If we find that there is a likelihood of confusion between this mark and Applicant’s mark, there is no need for us to consider the likelihood of confusion with the other two cited marks. Conversely, if we find there is no likelihood of confusion with this mark, we would find no likelihood of confusion with the other cited marks. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity of the Services, Customers, and Channels of Trade

We first consider the second and third *du Pont* factors, the similarity of the services and channels of trade. Applicant and Registrant recite identical “retail convenience store services.” Therefore, we must presume that the channels of trade and classes of customers are the same. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 101

USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018). The second and third *du Pont* factors weigh heavily in favor of a finding that confusion is likely.

B. Similarity of the Marks

Next, we address the first *du Pont* likelihood of confusion factor, which focuses on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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) (quotation omitted).

Because the similarity of the marks is determined based on the marks in their entirety, our analysis is not predicated on dissecting the marks into their various components. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015).

On the other hand, in 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, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.

In re Nat'l Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Viterra*, 101 USPQ2d at 1908.

Where, as here, marks are used in association with identical services, the degree of similarity between them necessary to support a determination that confusion is likely declines. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant's mark is . Although we assess each mark in its entirety, wording often is considered the dominant feature of a mark comprising both literal and design elements. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *Viterra*, 101 USPQ2d at 1908. We find that to be appropriate here. Consumers are likely to view KICKSMART as indicating the source of Applicant's services, not only because it is wording but also because it is far larger than the kicking donkey image, and the remaining simple graphic elements are not distinctive. Indeed, the literal component KICKSMART is likely to be used alone in text and when spoken by consumers of Applicant's services. *Viterra*, 101 USPQ2d at 1911.

As we often have said, the lead element in a mark has a position of prominence; it is likely to be noticed and remembered by consumers and so to play a dominant role in the mark. *See, e.g., Palm Bay*, 73 USPQ2d at 1692 (stating that VEUVE is a prominent part of the mark VEUVE CLICQUOT because it is the first word in the mark); *Century 21*, 23 USPQ2d at 1700 (stating that consumers will first notice the identical lead word on encountering the marks). Here, the cited mark KICKS is the first literal portion of Applicant's mark.

While there is no rule that likelihood of confusion automatically applies where one mark subsumes another, in this case, the fact that the first syllable of Applicant's mark is the entire cited mark KICKS increases the similarity between the two. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (affirming Board decision that ML is likely to be perceived as a shortened version of ML MARK LEES, and stating that "the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical"); *Coca-Cola Bottling Co. of Memphis, Tenn., Inc. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER & design for club soda, quinine water, and ginger ale likely to cause confusion with BENGAL for gin); *In re Integrated Embedded*, 120 USPQ2d 1504, 1516 (TTAB 2016) (BARR GROUP, with "group" disclaimed, likely to cause confusion with BARR for engineering services); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (MACHO COMBOS, with "combos" disclaimed, likely to cause confusion with MACHO for restaurant entrees).

1. Third-Party Use and Registration of –MART Formatives

The facts of this appeal present another consideration enhancing the similarity of the marks. As discussed above, both marks are for "retail convenience store services." The Examining Attorney introduced Internet printouts displaying several examples of use by third parties of –MART formatives for such services, including Sprint Mart, Planet Mart, E-Z Mart, GoMart, Express Mart, Mapco Mart, and Redi Mart.⁵ In

⁵ September 19, 2016 Office Action at TSDR 8-14.

addition, the Examining Attorney submitted several pairs of existing, use-based registrations in which the third-party registrant owns a leading term and its –MART formative, both for retail food or convenience store services. These are:

- MOBIL and MOBIL MART, with “mart” disclaimed;
-  and MILLER MART, with “mart” disclaimed;
-  and , with “mart” disclaimed;
-  and NATURALMART; and
-  and MOTOMART.⁶

Third-party registrations like these may be relevant to show the sense in which a mark is used in ordinary parlance; that is, that an element of a mark has a normally understood and well-recognized descriptive or suggestive meaning. *Jack Wolfskin*, 116 USPQ2d at 1136. In this case, they demonstrate that –MART means a “market”⁷ operated by the same owner as the leading mark. The term MART thus encompasses retail convenience store services. Combined with KICKS, it suggests that Registrant provides those services.

2. Applicant’s Arguments

Applicant focuses its arguments on the first *du Pont* factor. *See* Reply Brief at 1, 7 TTABVUE 2. Applicant argues that the marks make different commercial impressions, partly because its mark presents the visual pun KICK SMART. *See, e.g.*,

⁶ November 14, 2017 Final Office Action at TSDR 2-20, 25-28.

⁷ We take judicial notice that “market” is a definition of the noun “mart.” <https://www.merriam-webster.com/dictionary/mart>. The Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format. *E.g., In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018).

Reply Brief at 2, 7 TTABVUE 3. Applicant cannot rely on this consumer interpretation. *Cf. Viterra*, 101 USPQ2d at 1912 (stating that “there is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner”). Applicant also contends that the evidence of “wide spread [sic] use of the term MART as used in association with retail convenience store services” weighs against confusion “because consumers have been conditioned to look to the other elements of the marks” to distinguish the services. Appeal Brief at 7, 8, 4 TTABVUE 10, 11. That may be true, but given the pattern established by the Examining Attorney’s evidence, we think it is highly likely that consumers will believe the source of KICKS retail convenience store services also is the source of



retail convenience store services.

Applicant’s mark differs from the cited mark in sound and appearance. Considered as a whole, however, we find that Applicant’s mark is similar to Registrant’s mark in connotation and overall commercial impression. Bearing in mind that less similarity between the marks is necessary because the services are identical, we find that the first *du Pont* factor weighs in favor of a finding that confusion is likely.

II. Conclusion

We have considered all of the evidence of record and Applicant’s arguments, including those not specifically discussed, as they pertain to the relevant *du Pont* likelihood of confusion factors. To the extent that any other factors for which no evidence was presented by Applicant or the Examining Attorney may nonetheless be applicable, we treat them as neutral.

We have found that the first three *du Pont* factors weigh in favor of a finding that confusion is likely, with none weighing against. We conclude that Applicant's mark is likely to cause confusion with the mark in cited Registration No. 2067834 when used in association with the services identified in the application.

Decision: The refusal to register Applicant's mark is affirmed.