

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: November 3, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*In re Sérgio Tsugumiti Kobayashi*  
—

Serial No. 88073552  
—

John M. Skeriotis of Emerson Thomson Bennett LLC,  
for Sérgio Tsugumiti Kobayashi.

Grace Duffin, Trademark Examining Attorney, Law Office 120,  
David Miller, Managing Attorney.

—  
Before Bergsman, Greenbaum and Lebow,  
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Sérgio Tsugumiti Kobayashi, applied to register the mark shown below on the Principal Register for “Drinking flasks; Drinking vessels; Flasks; Insulated containers for food or beverage for domestic use; insulated flasks; insulated vacuum flasks; Vacuum flasks,” in International Class 21:<sup>1</sup>

<sup>1</sup> Application Serial No. 88073552 was filed on August 10, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce. The description of the mark reads as follows: “The mark consists of Letter ‘N’ in half circle to the right side, half circle is broken at the center point, three thick lines at an angle above the letter ‘N’, letters ‘DND’ below the half circle, the center of each of the letters ‘D’ are broken, the words ‘Do Not Disturb’ below the ‘DND’,”



The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified goods, so resembles the registered marks listed below, owned by different entities, as to be likely to cause confusion:

DONOTDISTURB, in typed drawing form, for "blank note cards; bookmarks; appointment books; announcement cards; business cards; blank cards; greeting cards; note cards; all occasion cards; cards bearing universal greetings; Christmas cards; gift cards; postcards, namely, blank, partially printed and picture post cards; printed paper signs," in International Class 16;<sup>2</sup> and

DO NOT DISTURB, in standard character form, for "Capri pants; Leggings; Lounge pants; Loungewear; Nightgowns; Pajamas; Tank tops; Tops as clothing," in International Class 25;<sup>3</sup>

When the refusal was made final, Applicant filed a request for reconsideration, which was denied. Applicant then filed an appeal. The appeal is fully briefed.

We reverse the refusal.

## **I. Applicable Law**

The fundamental purpose of Trademark Act § 2(d) is to prevent confusion as to

---

the center of each of the letters 'D' are broken. Color is not claimed as a feature of the mark.

<sup>2</sup> Registration No. 2468434, registered July 10, 2001; renewed.

<sup>3</sup> Registration No. 5738254, registered April 30, 2019.

source, and to protect registrants from damage caused by registration of confusingly similar marks. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985). Our analysis is based on all of the probative evidence of record. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and 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.”).

#### **A. Similarity or Dissimilarity of the Marks**

The first *DuPont* factor considers the “similarities or dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression.”

*In re Detroit Athletic Co.*, 903 F.3d 1296, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019).

The test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). Our focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Neutrogena Corp. v. Bristol-Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (CCPA 1969) (many consumers “may have but dim recollections from having previously seen or heard one or the other of the involved marks.”); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014).

Applicant’s DND DO NOT DISTURB and design mark is clearly similar to Registrants’ marks DO NOT DISTURB and DONOTDISTURB and, as the Examining Attorney points out, those marks are in typed or standard characters, which entitles the owners of those marks to display that wording in any lettering style or format, including the “DO NOT DISTURB” portion of Applicant’s mark.<sup>4</sup> *See*

---

<sup>4</sup> 14 TTABVUE 5 (Examining Attorney’s Brief). The registered DONOTDISTURB mark is a “typed drawing,” whereas the registered DO NOT DISTURB mark is in “standard

*In re Viterra Inc.*, 101 USPQ2d at 1909 (the rights reside in the wording or other literal element and not in any particular display or rendition); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) (“Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce.”); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009) (“rights associated with a word mark in standard character (or typed) form reside in the wording and not in any particular display of the word.”).

The Examining Attorney argues that the marks are significantly similar in appearance, sound, meaning, and overall commercial impression, because the word portion of Applicant’s mark is dominant and should be accorded greater weight in determining similarity; because they share the identical wording DO NOT DISTURB or DONOTDISTURB; because DND is a common abbreviation for DO NOT DISTURB as shown by the evidence of record, which merely reinforces the commercial impression of the mark being DO NOT DISTURB, particularly due to its position immediately above that wording; and because Applicant’s mere addition of a stylized N design does not obviate the marks’ similarities.<sup>5</sup>

Applicant disputes that the wording DO NOT DISTURB is dominant in its mark, arguing that “[a] consumer will give scarce attention to the ‘DO NOT DISTURB’

---

characters.” They are legal equivalents. *See 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.”).

<sup>5</sup> 14 TTABVUE 4-7 (Examining Attorney’s Brief).

phrase due its small print,” which “is the *least* prominent element” in its mark.<sup>6</sup> Instead, asserts Applicant, consumers “are likely to be drawn to the stylized letters ‘DND,’ which are prominently displayed and not present in [the registrations].”<sup>7</sup>

According to Applicant,

DO NOT DISTURB (the pronunciation of the Cited Registrations) is completely different from DEE-EN-DEE, which is how Applicant’s Mark would be pronounced by consumers because that is the most dominant portion of the mark and because it is phonetically short (three syllables) than the much small DO NOT DISTURB (four syllables); people regularly prefer a shorter pronunciation over a larger one.

Next, consumers are likely to be drawn to the stylized letter “N,” with a half circle that is broken at a center point. The half circle is positioned to the right side of the stylized letter “N.” Above the stylized letter “N” are three thick lines at an angle. Further, the second vertical line that forms the stylized letter “N” and the half circle are aligned to form what appears to be a stylized letter “D” with a broken portion.<sup>8</sup>

Applicant also disputes the Examining Attorney’s contention DND is a common abbreviation for DO NOT DISTURB because the Examining Attorney’s evidence from acronymfinder.com only ranks that abbreviation 6th out of 36 other meanings, and because the Examining Attorney’s other Internet evidence using DND as an abbreviation for DO NOT DISTURB relate to the use of that term in telecommunications.<sup>9</sup>

We agree with the Examining Attorney that the wording in Applicant’s mark is

---

<sup>6</sup> 12 TTABVUE 13 (Applicant’s Brief).

<sup>7</sup> *Id.* at 11.

<sup>8</sup> *Id.* at 12-13.

<sup>9</sup> *Id.* at 11-12 (referring to the Examining Attorney’s evidence provided with the December 3, 2018 Office Action, TSDR 11-14, and the April 27, 2020 Denial of Request for Reconsideration, 5 TTABVUE 6-20).

dominant over its design element. When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *Viterra*, 101 USPQ2d at 1908). While the design element, which Applicant identifies as a stylized N but which is not necessarily recognized as such, must be considered when viewing Applicant's mark as a whole, it does not obviate the overall similarities between the marks.

We also agree that the letters DND in Applicant's mark will be viewed by consumers as an acronym for the wording DO NOT DISTURB shown directly below it. We need no extrinsic evidence to make this determination; it is self-evident. While the abbreviation is shown at the center of the mark in larger font and may be first to catch the consumer's eye, it ultimately serves to reinforce and highlight the wording DO NOT DISTURB as the connotation of the mark. Considered in its entirety, Applicant's mark is a fancy, dressed-up version of the phrase DO NOT DISTURB, making it confusingly similar to the registered DO NOT DISTURB and DONOTDISTURB marks.

Notwithstanding their differences, Applicant's mark and the Registrants' marks are more similar than dissimilar in appearance, sound, connotation, and commercial impression. Accordingly, the first *DuPont* factor weighs in favor of a finding of likelihood of confusion.

## **B. Similarity or Dissimilarity of the Goods and Trade Channels**

The second *DuPont* factor considers the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *In re Detroit Athletic Co.*, 128 USPQ2d at 1051 (quoting *DuPont*, 177 USPQ at 567), and the third *DuPont* factor considers the “similarity or dissimilarity of established, likely-to-continue trade channels.” *Id.* at 1052. It is “not necessary that the goods be identical or even competitive to support a finding of a likelihood of confusion.” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). “[L]ikelihood of confusion can be found ‘if the respective goods are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Id.*

The Examining Attorney argues that “[c]onfusion as to the source of the respective goods is likely in this case because, as shown by the evidence of record, applicant’s goods and registrants’ goods are commonly provided by the same entity and marketed under the same mark, the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers.”<sup>10</sup> To support this contention, she provided a sampling of Internet webpages from a variety of well-known third-party retailers, all offering one or more of the goods found in the cited registrations, along with flasks or drinking vessels, including Nordstrom; Kate Spade; Bed, Bath & Beyond; REI; Yeti; Magnolia; Patagonia; Lululemon; Louis Vuitton; Adidas; Nike;

---

<sup>10</sup> 14 TTABVUE 17.



Hallmark; Lilly Pulitzer; Puma; Anthropologie; Urban Outfitters; Mitchells; Vineyard Vines; Brooks Brothers; Tory Burch; and Ralph Lauren.<sup>11</sup>

Applicant disputes the effect of the Examining Attorney's evidence, citing Professor McCarthy for the proposition that there is "no such thing as an 'under the same roof' rule. Merely because goods are commonly sold within one store under the same roof does not automatically mean that buyers are likely to be confused by similar marks on disparate goods as to source, connection or sponsorship."<sup>12</sup>

Applicant argues that

Even if some conglomerate companies (with a very diverse product offering) do make and sell all of these items, they are not sold or marketed in a related fashion. For example, drinking vessels are often sold in kitchen/dining departments (whether in physical stores or online), whereas tank tops, pajamas, leggings, and the like are sold in clothing departments, and appointment books, greeting cards, note cards, and the like are sold in stationary/office supply departments. These respective products are simply not encountered together by a consumer.<sup>13</sup>

The fact that particular goods can be purchased in the same type of specialty store is sometimes treated as an indication that the goods are related. This principle should be applied cautiously, however, since many 'big box' or general retail outlets sell a considerable range of goods under the same roof. The mere fact that, for instance, 7-

---

<sup>11</sup> December 3, 2018 Office Action, TSDR 15-38; May 20, 2019 Office Action, TSDR 8-122; August 30, 2019 Final Office Action, TSDR 8-113; 6 TTABVUE 3-15 (Denial of Request for Reconsideration, Part 2); 7 TTABVUE 3-21 (Denial of Request for Reconsideration, Part 3); 8 TTABVUE 2-17 (Denial of Request for Reconsideration, Part 4); 9 TTABVUE 2-20 (Denial of Request for Reconsideration Part 5); 10 TTABVUE 2-15 (Denial of Request for Reconsideration, Part 6).

<sup>12</sup> 12 TTABVUE 6 (Applicant's Brief) (citing J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:45 (5th ed. June 2019 update)).

<sup>13</sup> *Id.* at 8.

11 stores sell both magazines as well as hot dogs in the same store does not mean that magazines and hot dogs are related goods for purposes of the *DuPont* analysis. In such cases, it may be necessary to show that the relevant goods are sold in close proximity, or under circumstances such that consumers are likely to assume a relationship based on the similarity of the marks. *See, e.g., In re Ox Paperboard, LLC*, 2020 TTAB USPQ2d 10878 \*5-6 (TTAB 2020) (finding applicant's and registrant's goods complementary items used and sold together in packaging products for shipment: "This evidence shows that consumers may expect to find both Applicant's and Registrant's goods as identified in the involved application and cited registration as emanating from a common source. This evidence is not from 'big box' retail stores or online retailers selling a wide variety of goods, but rather from specialty retailers. This targeted type of retailing is narrower in scope, and the fact that more targeted sellers offer goods of both the Registrant and the Applicant tells us that the goods are related.").

"The mere fact that two different items can be found in a supermarket, department store, drugstore or mass merchandiser store is not a sufficient basis for finding that the goods are related." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *see also Federated Foods*, 192 USPQ at 29 (CCPA 1976) ("A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of

confusion from the use of similar marks on any goods so displayed”); *Shoe Factory Supplies Co. v. Thermal Eng’g Co.*, 207 USPQ 517, 526 (TTAB 1980) (“This contention [to equate different or unrelated goods by urging that they are all sold in supermarkets, department stores, and similar establishments] has been rejected ....”).

The Examining Attorney’s use evidence does not support the relatedness of Applicant’s drinking vessels and insulated containers and Registrants’ clothing and stationery goods. The Board has long recognized that “[n]ot everything that is sold by a large retail establishment selling a plethora of otherwise unrelated goods is necessarily connected, within the meaning of § 2(d) of the Act, to every other product that happens to be displayed or offered under the same roof,” *Sheller-Globe Corp. v. Scott Paper Co.*, 204 USPQ 329, 335 (TTAB 1979), and that principle applies with equal force to online retailers. The mere fact that some of the goods identified in the application and registration are available through common online channels of trade in which a host of other goods are also sold does not show that the identified goods are related. *See In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087-88 (Fed. Cir. 2014) (“The PTO goes too far ... in claiming that because both [applicant’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.’”).

A number of the well-known designers listed by the Examining Attorney (i.e., Kate Spade, Brooks Brothers, Lilly Pulitzer, Louis Vuitton, and Ralph Lauren) are known

for their clothing, designer bags, accessories and the like. The fact that they may also provide various miscellaneous items, such as water bottles or other knick-knacks, does not make them related to the company's primary goods. Indeed, there is no evidence of record showing that consumers would be aware that these companies provide such goods without actually searching for them.

Other mass providers such as the department store, Nordstrom, the outdoor sporting and clothing retailer, REI, and the home goods specialty provider, Bed, Bath & Beyond, referenced by the Examining Attorney offer a variety of goods along a particular theme but not necessarily emanating from that company. For example, the webpage excerpts provided by the Examining Attorney show that one can search the site by "brand." The Examining Attorney's search for "Christmas cards" yielded six results, returning Violet Chair and BASH branded cards, as well as kikki K branded planner refills. Her search for "flask" on the Nordstrom site returned 25 hits that included Hydro-Flask, Cathy's Concepts, John Varvatos, Best Made Co., Barbour, Ted Baker London, and Moore & Giles branded flasks.

In a similar vein, the Examining Attorney's search for "greeting cards" on REI's website had 42 results, including 25 Compass Paper Co. branded cards and 17 Pike Street Press branded cards. And the Examining Attorney's search for "water bottles" returned 365 hits, including 18 GSI Outdoors branded water bottles, 16 HydraPak branded water bottles, 33 Hyrdo-Flask branded water bottles, 26 Klean Kanteen branded water bottles, 19 Naglene branded water bottles, 17 Yeti branded water bottles, as well as 40 REI branded bottles and other brands.

In view of the foregoing, we find that the Examining Attorney's evidence falls short of proving that Applicant's drinking vessels and flasks are commercially related to Registrants' clothing and stationery goods or that they move through the same type of trade channels. The second and third *DuPont* factors therefore weigh against a finding of likelihood of confusion.

## **II. Conclusion**

In sum, we find no likelihood of confusion between Applicant's mark DND DO NOT DISTURB and Design and Registrants' marks DONOTDISTURB and DO NOT DISTURB. Notwithstanding that the marks are somewhat similar in overall appearance, we conclude that the goods are too dissimilar and unrelated, and do not move through the same channels of trade, to warrant a finding of likelihood of confusion. The second and third *DuPont* factors, accordingly, are dispositive in this case. *See e.g., Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single du Pont factor may not be dispositive. ... 'each [of the thirteen factors] may from case to case play a dominant role.'"); *see also North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 UPQ2d 1217, 1230-34 (TTAB 2015) (dismissing opposition to classes of goods and services where Opposer did not establish relatedness); *Itel Corp. v. Ainslie*, 8 UPQ2d 1168, 1171 (TTAB 1988) (dismissing opposition where marks were nearly identical but Opposer failed to prove relatedness).

**Decision:** The refusal to register is reversed.