

**THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B.**

Mailed: August 2, 2012

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re SWIMC, Inc.

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Serial No. 85016796

Robert E. McDonald of SWIMC, Inc.

Robert J. Struck, Trademark Examining Attorney, Law Office  
109 (Dan Vavonese, Managing Attorney).

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Before Bucher, Bergsman and Kuczma  
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

SWIMC, Inc. ("applicant"), filed an application seeking registration of the mark COMPLETE in standard character form for "automotive paints," as amended, in Class 2.

The examining attorney issued a final refusal to register the mark pursuant to § 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), citing Registration No. 3370767 as a bar to registration.<sup>1</sup> Registration No. 3370767 is for the mark KILZ COMPLETE in standard character form

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<sup>1</sup> Registration No. 3370767 issued January 15, 2008.

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for "paint primer" in Class 2 and is owned by Masterchem Industries LLC.

Applicant and the examining attorney submitted briefs.

Likelihood of Confusion

Our determination of likelihood of confusion under § 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the 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, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

A. The similarity or dissimilarity of the marks as to appearance/sound/meaning and commercial impression

We first consider the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, meaning and commercial impression. *du Pont*, 177 USPQ at 567.

When considering the similarity of the marks, the test is not whether the marks can be distinguished when

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subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of overall commercial impression so that confusion as to the source of the services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

To the extent that applicant's COMPLETE mark and the cited KILZ COMPLETE mark both contain the word COMPLETE, when comparing the marks in their entireties, they are similar in sound, appearance and meaning.

Turning to the commercial impression of the marks, the word COMPLETE suggests that the respective paint and primer products "completely cover" the surfaces to which they are applied. This is a desired feature of coatings such as paints and primers. The presence of the word KILZ, a homonym for "kills," in the cited mark does not alter the commercial impression of the KILZ COMPLETE mark, i.e., that the primer completely covers the applied surface. Thus, the marks have similar commercial impressions and the word KILZ does not avoid the likelihood of confusion between the marks.

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In its appeal brief, applicant cited to application Serial No. 85250949, issued as Registration No. 4085130, for the mark SPRED COMPLETE for "coatings, namely, paints, primers . . ." arguing that the "Trademark Office has allowed several marks in class 002 incorporating the term 'complete,' . . . recogniz[ing] that these two word marks can co-exist on directly competitive products, Applicant's one word mark for Automotive Paints would also be able to coexist."<sup>2</sup> Third-party registrations may be submitted to demonstrate the meaning of a word which comprises a mark, or a portion thereof, in the same way dictionary definitions are used. *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). However, applicant failed to make the application of record. Even if applicant had submitted appropriate evidence of the application with its appeal brief, such evidence would be manifestly untimely and would not be considered. See Trademark Rule 2.142(d). In view of the foregoing, the third-party application that was untimely cited by applicant in its appeal brief is not probative evidence that similar marks co-exist.

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<sup>2</sup> Applicant's Appeal Brief, paragraph No. 3; application Serial No. 85250949 issued as Registration No. 4085130 on January 10, 2012, three months after applicant filed its Appeal Brief.

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Although the issue of likelihood of confusion must be judged on the basis of the facts and context of each case presented to the Board, likelihood of confusion has frequently been found where the entirety of one mark is incorporated within another. *See In re Champion International Corp.*, 196 USPQ 48, 49 (TTAB 1977) (resemblance between applicant's CHECK MATE and registrant's HAMMERMILL MICR CHECK-MATE marks for closely related products likely to cause confusion). *See also In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985) (addition of house mark in LE CACHET De DIOR does not avoid likelihood of confusion with registered CACHET mark) and *In re C.F. Hathaway Co.*, 190 USPQ 343, 345 (TTAB 1976) (HATHAWAY GOLF CLASSIC for knitted sport shirts likely to cause confusion with registered GOLF CLASSIC mark for men's hats); and *La Maur, Inc. v. Matney*, 167 USPQ 559 (TTAB 1970) (applicant's "ITALIAN STYLE" mark similar to registered "STYLE" mark). In view of the foregoing, the marks have similar commercial impressions.

Due to the shared term COMPLETE, the similarities in the appearance, sound, meaning and commercial impression of the marks outweigh the dissimilarities.

B. The similarity or dissimilarity and nature of the goods, channels of trade and classes of consumers

We turn next to the *du Pont* factor involving the similarity or dissimilarity of applicant's goods ("automotive paints"), in relation to the goods in the cited registration ("paint primer"). It is well-settled that the issue of likelihood of confusion between applied for and registered marks must be determined on the basis of the goods as they are identified in the involved application and registrations. *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).


The nature of the goods sold by applicant and the owner of the cited registration are similar in that automotive paints in its broadest meaning may encompass automotive paint primers and paint primer without further limitation includes automotive paint primers. Applicant's own specimen demonstrates the relatedness of its automotive paint and registrant's primer because its specimen identifies applicant's automotive paint as a "2K Primer Sealer."

The goods need not be identical or directly competitive to find a likelihood of confusion. See *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Rather,

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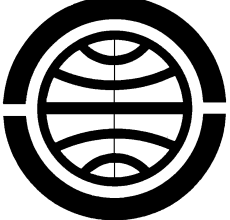


they need only to be related in some manner or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source. See *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000) and *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

In further support of the relatedness of applicant's automotive paint and the cited registrant's paint primer, the examining attorney submitted copies of third-party registrations that serve to suggest that applicant's automotive paints and registrant's paint primers are of a kind that may emanate from a single source.<sup>3</sup> The thirteen registrations, owned by twelve different owners (and including a registration owned by applicant), listed below demonstrate the relatedness of these goods:<sup>4</sup>

Registration No.	Mark	Goods	Owner
0441001		Automotive finish primers and surfacers, automotive paints, lacquer primers	E.I. du Pont de Nemours and Company

<sup>3</sup> These third-party registrations and others submitted by the examining attorney were attached to the 7/21/2010 Office Action and the 2/11/2011 Final Office Action.

<sup>4</sup> Only the goods that are pertinent to the goods identified in applicant's application and the cited registration are listed in the chart.

1610333		Clear and pigmented coatings in the nature of a paint, automotive paint, primers, base coats, clearcoats and sealers	SWIMC, Inc.
2813288	COLLISION PRO	Automotive clearcoat paints; paint primers	Association of Automotive Aftermarket Distributors
2865526	EUROSTAR REFINISHING PRODUCTS	Automobile paints and paint primers	International Autobody Marketing Group, Inc.
2955475	FINISH PRO	Automotive paint, namely aerosol spray paint; paint-related products, namely automotive finishing products in the nature of clear coats, primers	Liberty Bell Equipment Corp. TA Medco
3004006	MEDALLION	Automotive paint, and primer used in the field of professional auto body and fleet repair	Teknol, Inc.
3017096	GLASURIT	Automotive Paints; paint primers	BASF Coatings Aktiengesellschaft
3141105	EASTWOOD	Paints for automobiles, paint primers	Easthill Group, Inc.
3205846	LUXECOLOR	Paint for use in manufacture of automobiles; paint primers	Liang Wang
3215319		Paint primers and automotive paint	AutoZone Parts, Inc.
3345118	CALIFORNIA CLEARS	Paint primers, paints for automobiles	TCI Products, Inc.
3570823		Paint for use in the manufacture of automobiles, paint primers	Peishen Feng
3659799	DUPONT	House mark for full line of automotive paints, primers	E.I. du Pont de Nemours and Company

Although such registrations are not evidence that the marks shown therein are in use or that the public is



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familiar with them, they nonetheless have probative value to the extent they are based on use in commerce and serve to suggest that the goods identified therein are of a kind which may emanate from a single source under a single mark. *See In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The foregoing third-party registrations serve to suggest that it is common for the same entity to provide automotive paint and paint primer under the same mark. Thus, consumers encountering applicant's automotive paint and the cited registrant's paint primer in connection with similar marks are likely to believe the goods emanate from the same source.

We next consider the similarity or dissimilarity of the established and likely to continue trade channels for applicant's and registrant's respective goods, and the condition under which and buyers to whom sales are made, i.e., impulse versus careful, sophisticated purchasing, under the third and fourth *du Pont* factors.

The amended identification of goods limits applicant's goods to paints used for automotive applications. In light of this limitation, applicant argues that there is no likelihood of confusion because as shown in its specimens,

its automotive paints have been "[f]ormulated for application by trained professionals using proper equipment under controlled use conditions. Not intended for the retail trade . . . ." <sup>5</sup> However, this limitation listed in small print on the paint can label is of no consequence where applicant's identification of goods does not reflect a corresponding restriction and where the cited registration has unrestricted trade channels. The difficulty with applicant's argument is that this proceeding concerns applicant's right to register a trademark, not applicant's actual trademark use. Because the scope of the registration applicant seeks is defined by its application rather than its actual use, it is the application that we must look to in determining applicant's right to register:

The authority is legion that 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 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 are directed.

*Octocom Systems Inc. v. Houston Computers Services Inc.*,  
918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

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<sup>5</sup> See applicant's January 21, 2011, Response to Office Action.

Likewise, in considering the scope of the cited registration, we look to the registration itself, and not to extrinsic evidence about the registrant's actual goods, customers, or channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958).

Because there is no limitation as to trade channels or classes of purchasers in the description of goods in either the application or the cited registration, we must presume that applicant's automotive paints and registrant's paint primers are marketed in all normal trade channels for such goods and to all normal classes of purchasers for such products. See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *Elbaum*, 211 USPQ at 640.

In that regard, applicant's automotive paints are presumably marketed and sold to those requiring paint for automotive applications. Given the relationship between automotive paint and paint primers established by the third-party registrations and applicant's specimen, and that registrant's identification of goods is broad enough to encompass all types of primers including automotive paint primers, at least some of registrant's customers are part of the general consuming public for applicant's automotive paint. Thus, applicant's customers who may be

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interested in purchasing automotive paint, upon seeing the registrant's KILZ COMPLETE paint primer, may assume that applicant's goods are related to or affiliated with registrant's KILZ COMPLETE primer. To the extent that applicant's automotive paints and registrant's paint primers are offered to the general consuming public, the channels of trade and classes of purchasers overlap. This overlap weighs in favor of a finding of likelihood of confusion, under the third and fourth *du Pont* factors. *In re Wilson*, 57 USPQ2d 1863, 1866 (TTAB 2001).

While applicant expects the professional painters who apply its automotive paint would exercise special care in the selection of paint products, there is no evidence in the record to support this contention.<sup>6</sup>

C. Balancing the factors

In view of the similarity of the marks in their entirety in sound, appearance, meaning and commercial impression, the relatedness of applicant's automotive paint to the paint primer in the cited registration, and the overlap in the channels of trade and classes of customers, we find that applicant's COMPLETE mark for automotive paint is likely to cause confusion with the KILZ COMPLETE mark in

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<sup>6</sup> Applicant's Appeal Brief, paragraph No. 2.

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Registration No. 3370767. Moreover, where the goods of the applicant and cited registrant are similar and/or closely related as they are here, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); also see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004).

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