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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Akzo Nobel Coatings International B.V.

Serial No. 85121039

David H. Vickrey for Akzo Nobel Coatings International B.V.

Dominic Fathy, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Bucher, Cataldo and Kuczma, Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Akzo Nobel Coatings International B.V. (“applicant”) filed an intent-to-use application under §1(b) of the Trademark Act, 15 U.S.C. § 1051(b), seeking registration of the mark:

CONTRACTOR PERFORMANCE

in standard character form for “coatings, namely, non-aerosol interior and exterior 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.

3170775 as a bar to registration.¹ Registration No. 3170775 is for the mark CONTRACTOR in standard character form for “protective and decorative coatings in the nature of aerosol paint” in Class 2 and is owned by SWIMC, Inc.

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 entirety 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 subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of overall commercial

¹ Registration No. 3170775 issued November 14, 2006.

impression so that confusion as to the source of the goods or 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 CONTRACTOR PERFORMANCE mark and the cited CONTRACTOR mark both contain the word CONTRACTOR, when comparing the marks in their entireties, they are similar in sound and appearance. This is particularly so in view of the fact that consumers are generally more inclined to focus on the first word in any trademark or service mark. See *Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

Turning to the meaning and commercial impression of the marks, the word CONTRACTOR imparts the same meaning in both marks; it suggests a type of person who is likely to use the respective non-aerosol and aerosol paint products. The addition of the word PERFORMANCE in the applicant's mark does not alter the commercial impression of the CONTRACTOR mark as a "contractor" is "one

that contracts to *perform* work or provide supplies.” (emphasis added).² Alternately, the mark CONTRACTOR PERFORMANCE suggests that the goods identified thereby are suitable for use by contractors in performance of their work. Thus, the marks have similar meanings and commercial impressions such that the addition of the word PERFORMANCE in applicant’s mark does not avoid the likelihood of confusion between the marks.

In its May 12, 2011 Response to the first Office Action and its Appeal Brief, applicant submitted a chart listing the following four registrations for marks containing the word “Contractor” for paint and floor finishes in Class 2 contending that “the weight given CONTRACTOR in the analysis of commercial impression is substantially reduced” by the presence of the registrations:³

CONTRACTOR App 78-621,064 Reg 3,170,775	USPTO Status: Registered USPTO Status Date: 14- NOV-2006 App 02-MAY-2005	2: Protective and decorative coatings in the nature of aerosol paint	SWIMC, INC. DELAWARE CORPORATION PO BOX 657 NEWARK, DELAWARE, 19715-0657
CONTRACTOR'S EDGE App 78-848,207 Reg 3,433,100	USPTO Status: Registered USPTO Status Date: 20- MAY-2008 App 28-MAR-2006	2: Interior and exterior paint	DUNN-EDWARDS CORPORATION CALIFORNIA CORPORATION 4885 EAST 52ND PLACE LOS ANGELES, CALIFORNIA, 90040
CHEMSPEC COMMERCIAL CONTRACTOR'S CHOICE App 78-153,176 Reg 2,972,763	USPTO Status: Registered USPTO Status Date: 19-JUL- 2005 App 12-AUG-2002	2: Coatings in the nature of resilient floor finishes	CHEMICAL SPECIALTIES MANUFACTURING CORPORATION MARYLAND CORPORATION 901 N. NEWKIRK ST. BALTIMORE, MARYLAND, 21205-3013
ACE CONTRACTOR PRO App 75-367,765 Reg 2,273,433	USPTO Status: Registered and renewed USPTO Status Date: 03- DEC-2008 App 03-OCT-1997	2: Indoor and outdoor paints, primers and varnishes	ACE HARDWARE CORPORATION DELAWARE CORPORATION 2200 KENSINGTON COURT OAK BROOK, ILLINOIS, 60523

² See <http://www.merriam-webster.com/dictionary/contractor>. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

³ See applicant’s May 12, 2011 response to Office Action and its Appeal Brief p. 5.

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 submit copies of the registrations or the electronic equivalent (i.e., complete printouts taken from any of the USPTO's automated systems), in order to make the registrations of record. Because the examining attorney failed to object to the foregoing chart submitted with applicant's May 12, 2011 Response, or to advise applicant of the insufficiency of this evidence, we deem any objection to be waived, and consider the evidence set forth in the attached chart. *See In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) and TBMP § 1208.02 (3d ed., rev. 2012).

With its Reply Brief, applicant submitted copies of four registrations.⁴ Applicant's submission of the copies of these registrations is untimely and accordingly, the copies of these registrations have not been considered. See Trademark Rule 2.142(d).

Moreover, we hasten to add that even if we had considered these registrations, it would not change the result herein. Of the four registrations identified in applicant's chart, one of them, namely, Registration No. 3170775 is the cited Registration. Registration No. 2972763 is for "resilient floor finishes" rather

⁴ These registrations included the first three registrations listed above, along with a copy of Registration No. 3752324 for the mark shown at right, which issued on February 10, 2010, well before the date of applicant's Appeal Brief was filed.



than aerosol or non-aerosol paint products, and the first word of the marks contained in the two remaining registrations are the house marks of the registrations' owners. Thus, aside from the cited registration, the remaining registrations in applicant's chart display marks and/or recite goods that are less similar to those at issue herein. In view of the foregoing, these few registrations do not impact the meaning of applicant's mark or the cited mark, nor do they support a finding that the cited mark is weak or otherwise entitled to a narrow scope of protection. In any event, the Board is not bound by the prior decisions of examining attorneys in allowing the foregoing marks for registration. It has been noted many times that each case must be decided on its own facts. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."); and *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987). In view of the foregoing, we are obligated to assess the registrability of applicant's mark on its own merits and not simply based on the existence of other registrations.

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 El Torito Restaurants, Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBO likely to cause confusion with registered MACHO mark); *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); *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 shared term CONTRACTOR, and further because the term PERFORMANCE in applicant's mark is consistent with and otherwise draws attention to the term CONTRACTOR as discussed above, 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 ("coatings, namely, non-aerosol interior and exterior paints"), in relation to the goods in the cited registration ("protective and decorative coatings in the nature of aerosol paint").

Applicant admits the similarity of the goods.⁵ Additionally, the examining attorney submitted copies of third-party registrations that serve to suggest applicant's non-aerosol paints and registrant's aerosol paints are of a kind that may

⁵ Applicant's Reply Brief p. 4.

emanate from a single source.⁶ Thus, the five registrations, owned by four different owners, listed below further demonstrate the relatedness of the goods:⁷

Registration No.	Mark	Goods	Owner
1900258		Aerosol paints, enamels and lacquers in the nature of coatings for use on wood, metal, plaster, masonry, glass, pottery and wicker; . . .; paint for home and automotive use . . .	Plasti-Kote Co., Inc.
2863041	PRIZMALITE	interior paint, exterior paint . . . interior aerosol paint, exterior aerosol paint . . .	Prizmalite Industries, Inc.
3036067	POWERED BY PRIZMALITE	Exterior paint, interior paint, exterior aerosol paint, interior aerosol paint, . . .	Prizmalite Industries, Inc.
3414822	SELECT-A-SPRAY	Bulk and aerosol paints for exterior and interior use on wood, plastic, metal fiberglass, plaster, concrete, glass and paper surfaces; pigmented and unpigmented coatings in the nature of paint for exterior and interior use on . . .	Gregory Alan Haage
3957008		Exterior paints; interior paints . . . enamels in the nature of paint dispensed by means of an aerosol spray . . .	Allpro Corporation

⁶ These third-party registrations submitted by the examining attorney were attached to the June 2, 2011 Office Action.

⁷ Only the goods that are pertinent to the goods identified in applicant's application and the cited registration are listed in the chart.

Although such registrations are not evidence that the marks shown therein are in use or that the public is 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, i.e., that it is common for the same entity to provide aerosol and non-aerosol paints under the same 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). Thus, consumers encountering applicant's non-aerosol paints and the cited registrant's aerosol paints in connection with similar marks are likely to believe the goods emanate from the same source.

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 non-aerosol paints and registrant's aerosol paints 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); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Given the relationship between aerosol and non-aerosol paints established by the third-party registrations and applicant's admission as to the similarity of the goods, at least some of registrant's customers are part of the general consuming public for applicant's non-aerosol paint. Thus, applicant's customers who may be interested in purchasing non-aerosol paint, upon viewing registrant's CONTRACTOR aerosol paint, may assume that applicant's goods are related to or

affiliated with registrant's CONTRACTOR paint. To the extent that applicant's and registrant's paints 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).

C. The number and nature of similar marks in use in connection with similar goods

Third-party use of similar marks is evidence of the weakness of the mark and is a separate *du Pont* factor to be considered in determining likelihood of confusion. *du Pont*, 177 USPQ at 567. Applicant argues that multiple parties use multiple marks containing the word "Contractor" on products highly similar to applicant's goods and that the number of such marks removes any likelihood of confusion between applicant's mark and the cited mark.⁸ In support of its position, applicant identified a common law user, Hirschfield's Paint Manufacturing, in the chart included its May 12, 2011 Response to the first Office Action. However, no evidence of Hirschfield's use of "Contractor" was submitted at that time.

In its Appeal Brief, applicant included a chart identifying the four registrations it identified in its May 12, 2011 Response, as well as three common law users of "Contractor" and attached copies of printouts from the internet showing use of "Contractor" by some of the registrants and common law users in connection with paint products.⁹ The examining attorney objected to applicant's submission of

⁸ Applicant's Brief pp. 8-9.

⁹ Applicant's Appeal Brief p. 7.

this evidence with its Appeal Brief. The objection is sustained. After an appeal is filed, if the applicant (or the examining attorney) desires to introduce additional evidence, they may request the Board to suspend the appeal and to remand the application for further examination. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). Accordingly, if applicant desired to submit additional evidence, its recourse was to file a request for remand. *See* TBMP § 1209.04 (3d ed., rev. 2012).

We have considered the third-party evidence timely submitted by applicant and discussed above, and find that it does not support a likelihood of confusion. The third-party registrations for marks containing the term “Contractor” for paint products and floor finishes without proof of their use in the marketplace are of little probative value in proving likelihood of confusion because they are not evidence that the marks depicted therein are in use or that the public is aware of them. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Applicant’s evidence of actual third-party use consists solely of the listing of Hirschfield Paint Manufacturing in its May 12, 2011 Response. Inasmuch as this single listing does not show actual use of the term by Hirschfield, we are unable to conclude there is significant third-party use of “Contractor” marks in connection with paint products such that the cited mark is weak and entitled to a narrow scope of protection.

Therefore, the *du Pont* factor involving the number and nature of similar marks in use in connection with similar goods does not favor applicant.

D. 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

non-aerosol paints to the aerosol paint products in the cited registration, and the overlap in the channels of trade and classes of customers, we find that applicant's CONTRACTOR PERFORMANCE mark for non-aerosol interior and exterior paints is likely to cause confusion with the CONTRACTOR mark in Registration No. 3170775. 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.