

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: August 17, 2023

Mailed: September 6, 2023

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

—————  
*Graco Minnesota Inc.*

*v.*

*Zhejiang Rongpeng Air Tools Co., Ltd.*

Opposition No. 91247343

**Notice of Correction**

Stephen R. Baird and Molly R. Littman of Greenberg Traurig, LLP,  
for Graco Minnesota Inc.

Paulo A. de Almeida, Alex D. Patel and Andrew T. Rissler of Patel & Almeida, P.C.,  
for Zhejiang Rongpeng Air Tools Co., Ltd.

—————  
By the Board:

On August 31, 2023, the Board issued a final decision in this opposition proceeding sustaining the opposition on Opposer Graco Minnesota Inc.'s pleaded ground of likelihood of confusion under Section 2(d) of the Trademark Act.

It has come to the Board's attention that there is an inadvertent typographical error in the decision. Specifically, the first term in Applicant's name should read "Zhejiang" and not "Zhejang."

Accordingly, the Board's final decision issued on August 31, 2023 has been

Opposition No. 91247343

corrected to properly reflect Applicant's name. A corrected copy of the decision is being issued concurrently with this order.

Applicant's time for filing an appeal or commencing a civil action regarding the final decision continues to run from the August 31, 2023 mailing date of the final decision. Trademark Rule 2.145(d)(1), 37 C.F.R. § 2.145(d)(1).

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: August 17, 2023

Mailed: August 31, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

—————  
*Graco Minnesota Inc.*

*v.*

*Zhejiang Rongpeng Air Tools Co., Ltd.*

Opposition No. 91247343

Stephen R. Baird and Molly R. Littman of Greenberg Traurig, LLP,  
for Graco Minnesota Inc.

Paulo A. de Almeida, Alex D. Patel and Andrew T. Rissler of Patel & Almeida, P.C.,  
for Zhejiang Rongpeng Air Tools Co., Ltd.

—————  
Before Johnson, Acting Deputy Chief Administrative Trademark Judge, Pologeorgis  
and Hudis, Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Zhejiang Rongpeng Air Tools Co. (“Applicant”) seeks registration on the Principal  
Register of the mark **AEROPRO** for the following goods, as originally identified,  
in International Class 7:<sup>1</sup>

Coffee grinders, other than hand-operated; Compressed air machines;  
Electric hand-held drills; Electric nail extractors; Fertilizer distributing

—————  
<sup>1</sup> Application Serial No. 87645709 was filed on October 14, 2017, based on an allegation of  
use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming  
January 2, 2014 as both the date of first use and first use in commerce.

machines, other than hand-operated implements; Glue guns, electric; Lifting jacks other than hand-operated; Machine tools for forming, riveting, swaging, and flaring of metal and plastics; Mufflers for motors and engines; Painting machines; Pumps for machines; Rivet guns; Vacuum pumps.

By way of its amended notice of opposition, Graco Minnesota Inc. (“Opposer”) opposes the registration of Applicant’s mark on the following two grounds: (1) likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and (2) nonuse on the ground that Applicant failed to use its mark in commerce as of the filing date of its opposed use-based application.<sup>2</sup> In support of its likelihood of confusion claim, Opposer alleges (1) ownership of Registration No. 4009655 for the standard character mark AIRPRO for “paint spray guns” in International Class 7, and (2) prior common law use of the mark AIRPRO used in connection with a variety of industrial products, including but not limited to, paint spray guns, air spray guns, manual air spray guns, and automatic air spray guns .

Applicant filed an answer to the amended notice of opposition in which it denied the salient allegations asserted therein.<sup>3</sup> Additionally, Applicant asserted numerous affirmative defenses, most of which are mere amplifications of Applicant’s denials to the allegations in the amended notice of opposition and are not true affirmative defenses, so we do not address them as such. *See, e.g., DeVivo v. Ortiz*, 2020 USPQ2d

---

<sup>2</sup> Amended Notice of Opposition (23 TTABVUE 15-24). Citations to the record or briefs in this opinion also include citations to the publicly available documents on TTABVUE, the Board’s electronic docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable.

<sup>3</sup> Applicant’s Answer to Amended Notice of Opposition. (34 TTABVUE).

10153, at \*1 (TTAB 2020) (Applicant “raised certain ‘affirmative defenses’ that are mere amplifications of Applicant’s denials, and which we do not consider as separate affirmative defenses.”). Additionally, Applicant asserted the affirmative defenses of laches, acquiescence, and equitable estoppel.<sup>4</sup> Finally, Applicant asserted a defense that the amended notice of opposition fails to state a claim upon which relief may be granted.<sup>5</sup>

## I. Record

The record includes the pleadings<sup>6</sup> and, pursuant to Trademark Rule 2.122(b),

---

<sup>4</sup> The equitable defenses of laches, acquiescence and estoppel are often unavailable in opposition proceedings because these defenses start to run from the time a mark is published for opposition, not from the time of knowledge of use. *See Nat’l Cable Television Ass’n Inc. v. Am. Cinema Eds. Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). In view thereof, we strike these equitable defenses from Applicant’s answer. *NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Board may sua sponte dismiss any insufficient pleading). To the extent these affirmative defenses would be available, Applicant nevertheless did not pursue these defenses at trial or in its trial brief and, therefore, Applicant has waived these affirmative defenses. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at \*1 n.3 (TTAB 2020) (various affirmative defenses deemed waived because no evidence or argument presented at trial); *Syndicat Des Proprietaires Viticulteurs De Chateaufneuf v. Pasquier DesVignes*, 107 USPQ2d 1930, 1931 n.6 (TTAB 2013) (affirmative defenses neither pursued at trial nor argued in brief deemed waived).

<sup>5</sup> Failure to state a claim is not a true affirmative defense because it asserts the insufficiency of the pleading of Opposer’s claims rather than Applicant’s defense. *See Blackhorse v. Pro Football, Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001). Applicant did not file a motion to dismiss under Rule 12 of the Federal Rules of Civil Procedure. Accordingly, Applicant’s “defense” of failure to state a claim also is stricken.

<sup>6</sup> Opposer attached exhibits to its amended notice of opposition. *See* 23 TTABVUE 25-248. We do not consider these exhibits, except for the status and title copy of Opposer’s pleaded registration, as evidence because “an exhibit attached to a pleading [except for a status and title copy of a plaintiff’s pleaded registration(s)] is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the period for the taking of testimony.” Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c); *see also Poly-Am., L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1510 n.5 (TTAB 2017) (exhibits to the petition for cancellation, consisting of copies of patents, photographs of certain goods identified in the involved registrations, packaging for certain of the identified

37 C.F.R. § 2.122(b), Applicant's involved application file. The record also includes the evidence summarized below.

### A. Opposer's Evidence

1. First Notice of Reliance on the following:<sup>7</sup> (a) Applicant's responses to Opposer's discovery requests; and (b) copies of documents produced by Applicant during discovery.<sup>8</sup>
2. Second Notice of Reliance on the following:<sup>9</sup> (a) screenshot of Opposer's website, [www.graco.com](http://www.graco.com); (b) screenshot of Applicant's Facebook page; (c) screenshots of Applicant's Amazon page; (d) screenshots of third-party websites purportedly offering for sale AEROPRO-branded products; (e) screenshots of the online dictionary definition of the word "aero"; (f) screenshots of the website, [tcpglobal.com](http://tcpglobal.com), associated with a company that Applicant allegedly contracted to sell its AEROPRO products; (g) copies of archive.org screenshots of [tcpglobal.com](http://tcpglobal.com) from May 30, 2017, August 31, 2018, and February 18, 2019; (h) screenshots of Applicant's website [www.aeroprotools.com](http://www.aeroprotools.com); and (i) documents produced by Applicant in discovery.<sup>10</sup>
3. Third Notice of Reliance on the following:<sup>11</sup> (1) status and title copies of third-party registrations for marks listing both "paint spray guns" and "painting machines" in the identification of goods, and (2) screenshots of third-party websites offering for sale and selling paint guns, spray guns, and painting machines under or in connection with a single mark.

---

goods and Internet materials, was not evidence to the proceeding and therefore not considered), *aff'd*, No. 3:18-cv-00443-C (N.D. Tex. Oct. 29, 2019), *appeal dismissed*, No. 19-11180 (5th Cir. Feb. 4, 2020).

<sup>7</sup> 36 TTABVUE.

<sup>8</sup> Generally, documents produced by an adverse party during discovery are not admissible into evidence by the receiving party. *See* Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii). However, since Applicant did not object to this evidence on such grounds, we have considered the documents in our analysis for whatever probative value they merit. *See Exec. Coach Builders, Inc. v. Spa Coach Co., Inc.*, 123 USPQ2d 1175, 1176 n.9 (TTAB 2017).

<sup>9</sup> 37 TTABVUE.

<sup>10</sup> *See* fn. 8, *supra*.

<sup>11</sup> 38 TTABVUE.

4. Testimony Declaration of Kyle Liudahl (“Liudahl Decl.”), Opposer’s Associate General Counsel.<sup>12</sup>
5. Testimony Declaration of Wendy Hartley, Opposer’s Product Marketing Manager, and the following accompanying exhibits: (1) advertisements for Opposer’s AIRPRO mark used in connection with paint spray guns, (2) packaging for Opposer’s AIRPRO paint spray guns, (3) instructional materials for Opposer’s AIRPRO paint spray guns, and (4) a document stating the year-to-date number of units sold and sales revenue for Opposer’s AIRPRO paint spray guns.

### **B. Applicant’s Evidence**

1. Testimony declaration of Li Xiaorong, Applicant’s General Manager, and the following accompanying exhibits:<sup>13</sup> (1) photographs of Applicant’s AEROPRO painting machines, (2) dictionary definitions of the terms AERO and PRO, (3) copies of photographs of Applicant’s booth with some of its sales representatives and customers participating in the SEMA (Specialty Equipment Market Association) automotive industry trade show in 2017 in Las Vegas, Nevada, to promote AEROPRO painting machines, (4) screenshots of Applicant’s website [www.aeroprotools.com](http://www.aeroprotools.com) taken in 2019 and 2022 featuring its AEROPRO painting machines, (5) excerpts of Applicant’s 2016-2019 product catalogue featuring its AEROPRO painting machines, among other goods, and (6) dictionary definition of the term AIR.

### **C. Opposer’s Rebuttal Evidence**

1. Rebuttal testimony Declaration of Wendy Hartley, Opposer’s Product Marketing Manager, and the following accompanying exhibits: (1) advertisements for Opposer’s AIRPRO paint spray guns, (2) copies of packaging for Opposer’s AIRPRO paint spray guns, (3) copies of instructional manuals for Opposer’s AIRPRO paint spray guns, and (4) sales revenues for Opposer’s AIRPRO paint spray guns.<sup>14</sup>
2. Rebuttal testimony Declaration of Molly R. Littman, one of Opposer’s counsel.<sup>15</sup>

---

<sup>12</sup> 39 TTABVUE.

<sup>13</sup> 42 TTABVUE.

<sup>14</sup> 42 TTABVUE.

<sup>15</sup> 43 TTABVUE.

The case is fully briefed.<sup>16</sup> A hearing was held on August 17, 2023.

Both parties submitted printouts from various websites downloaded from the Internet. Although admissible for what they show on their face, *see* Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2), these webpages also contain hearsay that may not be relied upon for the truth of the matters asserted therein unless supported by explanatory witness testimony or other evidence. Fed. R. Evid. 801(c); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 (TTAB 2018); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1039-40 (TTAB 2010); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.08(b) (2023) (“The probative value of Internet documents is limited. They can be used to demonstrate what the documents show on their face. However, documents obtained through the Internet may not be used to demonstrate the truth of what has been printed.”).

## II. Preliminary Matters

### A. Applicant’s Motion to Amend the Identification of Goods

In its brief opposing Opposer’s first motion to compel, Applicant embedded an unconsented request to amend the identification of goods of its involved application to delete all the goods except for “painting machines.”<sup>17</sup>

---

<sup>16</sup> 44-47 TTABVUE.

<sup>17</sup> 18 TTABVUE 3. Applicant again embedded this unconsented request to amend the identification of goods in Applicant’s Brief. *See* Applicant’s Brief, p. 10; 46 TTABVUE 11. The better practice would have been for Applicant to file a stand-alone motion to amend its identification of goods instead of embedding the request to amend in a response to a motion to compel and in Applicant’s trial brief.

During the hearing, Opposer's counsel stated that Opposer consents to Applicant's motion to amend. Thus, Applicant's motion to amend the identification of goods in its application is **granted**. For purposes of this decision, the operative identification of goods for Applicant's involved application now reads as follows: "painting machines."

### **B. Opposer's Evidentiary Objections**

For the first time in its trial brief, Opposer objects to certain evidence submitted by Applicant during its assigned testimony period on the grounds of lack of foundation and relevance.<sup>18</sup>

Objections that the submitting party failed to authenticate, or to establish the proper foundation for, evidence are procedural and must be raised promptly to allow the opportunity for a cure. *See Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at \*4 (TTAB 2020), *rev'd on other grounds sub nom., Moke Am. LLC v. Am. Custom Golf Cars, Inc.*, 2023 WL 3232601 (E.D. Va. May 3, 2023); *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1637 n. 16 (TTAB 2007). Because the lack of foundation objection was raised for the first time in Opposer's trial brief, the objection is waived as untimely. *Sabhani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*13 (TTAB 2021); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 846 (TTAB 1984).

As for Opposer's relevancy objection, the Board is capable of weighing the relevance and strength or weakness of the objected-to evidence in this case, including any inherent limitations, and this precludes the need to strike the challenged

---

<sup>18</sup> See Appendix to Opposer's Trial Brief (44 TTABVUE 39-40 (confidential version)) and 45 TTABVUE 39-40 (redacted version).

evidence on relevancy grounds. We have accorded the evidence whatever probative value it merits, keeping Opposer's relevancy objections in mind, and we comment as needed on its probative value elsewhere in this opinion. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1755 (TTAB 2012); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007). Thus, Opposer's relevancy objection is overruled.

### **III. Entitlement to a Statutory Cause of Action**

Entitlement to a statutory cause of action, formerly referred to as "standing" by the Federal Circuit and the Board, is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *cert. denied*, 142 S.Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022); *Corcamore*, 2020 USPQ2d 11277, at \*4; *see also Empresa Cubana del Tabaco*, 111 USPQ2d at 1062.

Because Opposer's pleaded registration is of record, Opposer has met the requirements for establishing an entitlement to a statutory cause of action to oppose Applicant's involved application. *See N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015) (citing *Cunningham v. Laser Golf Corp.*,

222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000)). This registration forms the basis for a likelihood of confusion claim under 15 U.S.C. § 1052(d) that is not wholly without merit. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012).

#### **IV. Opposer's Trademark Act Section 2(d) Claim**

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority in the use of its pleaded mark, and that use of Applicant's mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Applicant's goods, *Cunningham*, 55 USPQ2d at 1848, even if Applicant does not present contrary evidence or argument. *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010).

As discussed below, the priority established through the presumptions afforded Opposer's pleaded registration avoids the assessment of priority of use based on Opposer's common law rights. Therefore, we need not reach likelihood of confusion based on Opposer's alleged common law rights in the mark AIRPRO.

##### **A. Priority**

Because Opposer's pleaded registration for the standard character mark AIRPRO is of record, priority is not an issue with respect to the goods listed in Opposer's

pleaded registration. *See Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

### **B. Strength of Opposer's AIRPRO Mark**

Before we make our comparison of the marks, we consider the strength, as well as any weakness, of Opposer's AIRPRO mark as used in connection with paint spray guns. We do so because a determination of the strength or weakness of this mark helps inform us as to its scope of protection. *See In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1745 (TTAB 2016) (“[T]he strength of the cited mark is — as always — relevant to assessing the likelihood of confusion under the *duPont* framework.”).

When evaluating the strength or weakness of a mark, we look at the mark's inherent strength based on the nature of the term itself and its commercial strength in the marketplace. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (measuring both conceptual and marketplace strength); *see also Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at \*17 (TTAB 2022) (quoting *DuPont*, 177 USPQ at 567); *New Era Cap Co. v. Pro Era LLC*, 2020 USPQ2d 10596, at \*10 (TTAB 2020) (“[T]he strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak.”) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). With regard to commercial strength, “[t]he proper standard is the mark's ‘renown within a specific product market,’ ... and ‘is determined from the viewpoint of consumers of like products,’ ..., and not from the viewpoint of the general public.” *Chutter, Inc. v. Great Mgt. Grp.*,

LLC, 2021 USPQ2d 1001, at \*31 (TTAB 2021), *appeal docketed*, No. 22-1212 (Fed. Cir. 2021) (quoting *Joseph Phelps Vineyards, LLC v. Fairmont Holdings*, 857 F.3d 1323, 122 USPQ2d 1733, 1734-35 (Fed. Cir. 2017)).

Because Opposer's pleaded registration for the mark AIRPRO issued on the Principal Register, without a claim of acquired distinctiveness, the mark AIRPRO is presumed to be inherently distinctive for these goods. Trademark Act Section 7(b), 15 U.S.C. § 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006) (a "mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods"). In other words, Opposer's AIRPRO mark must, at least, be suggestive because "marks that are merely descriptive cannot be registered unless they acquire secondary meaning under § 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), but marks that are suggestive are 'inherently distinctive' and can be registered." *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017).

Nevertheless, AIRPRO may be weak if it is shown to be highly suggestive of Opposer's paint spray guns. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). On the other hand, "the fact that a mark may be somewhat suggestive does not mean that it is a 'weak' mark entitled to a limited scope of protection." *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985).

### 1. Conceptual Strength of the AIRPRO Mark

Conceptual strength is a measure of a mark's distinctiveness and may be placed "in categories of generally increasing distinctiveness: . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1084 (1992). Applicant argues that Opposer's AIRPRO mark for "paint spray guns" is highly suggestive of the goods and, therefore, the mark is entitled to a narrow scope of protection.<sup>19</sup> In support of its argument, the only evidence Applicant submitted was the dictionary definitions of "air" and "pro."<sup>20</sup>

We disagree that Opposer's AIRPRO mark is highly suggestive of "paint spray guns." While the individual components of the compound mark AIRPRO, i.e., the terms "air" and "pro," may be suggestive of Opposer's goods, we do not find that the mark, in its entirety, is highly suggestive. First, Applicant did not submit any evidence that the compound mark AIRPRO, as a whole, is highly suggestive of Opposer's goods or that Opposer's AIRPRO mark is not greater than the sum of its individual components. Moreover, Applicant did not make of record any third-party registrations or third-party uses of marks similar to Opposer's mark for similar goods

---

<sup>19</sup> To the extent Applicant argues that Opposer's AIRPRO mark is descriptive of Opposer's goods, *see* Applicant's Brief p. 15, 46 TTABVUE 16, such an argument is an impermissible collateral attack on Opposer's pleaded registration, absent a counterclaim. *NASDAQ Stock Mkt. v. Antartica, S.r.l.*, 69 USPQ2d 1718, 1735 (TTAB 2003) ("The law, of course, is well settled that an applicant cannot collaterally attack opposer's registration in the absence of a counterclaim for cancellation."); *see also* Trademark Rule 2.106(b)(3)(ii), 37 C.F.R. § 2.106(b)(3)(ii) ("An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration."). Here, Applicant did not file a counterclaim seeking to cancel Opposer's AIRPRO registration on the ground that the mark is merely descriptive of the listed goods.

<sup>20</sup> Xiaorong Decl., Exhs. B and F, 42 TTABVUE 20 and 64-71.

to demonstrate that Opposer's mark, as a whole, is highly suggestive. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc.*, 115 USPQ2d at 1674.

Because there is no evidence of record to demonstrate that Opposer's AIRPRO mark for "paint spray guns" is conceptually or inherently weak, we find Opposer's AIRPRO mark is, at worst, somewhat suggestive, but not highly suggestive, of such goods. Suggestive marks, however, are inherently distinctive and should be accorded the scope of protection to which inherently distinctive marks are entitled. *See Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 750 (TTAB 1986); *Great Lakes Canning*, 227 USPQ at 485 ("[T]he fact that a mark may be somewhat suggestive does not mean that it is a 'weak' mark entitled to a limited scope of protection."). Thus, we accord Opposer's AIRPRO mark the normal scope of protection due an inherently distinctive mark.

## **1. Commercial Strength of Opposer's AIRPRO Mark**

### **i. Fifth *DuPont* Factor**

The fifth *DuPont* factor examines the extent to which the public perceives the mark as indicating a single source of origin, i.e., its commercial strength. *DuPont*, 177 USPQ at 567. For likelihood of confusion purposes, commercial strength may be measured indirectly by, for example, "the volume of sales and advertising expenditures of the goods sold under the mark ... and other factors such as length of time of use of the mark; wide-spread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the

products and services.” *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014).

To demonstrate commercial strength, Opposer provided a variety of evidence, some of which is confidential and therefore will be discussed only in general terms. The evidence of record shows that (1) Opposer first advertised its AIRPRO mark for its paint spray guns in 2007;<sup>21</sup> (2) Opposer serves customers in over 100 countries across 6 continents, including the United States;<sup>22</sup> and (3) between 2008-2022, Opposer sold a noteworthy amount of its AIRPRO product, resulting in notable sales revenues.

We initially note that Opposer’s length of use of its AIRPRO mark alone may be insufficient to demonstrate commercial strength. More significantly, Opposer’s sales and advertising figures of record concern all of its AIRPRO-branded products and is not limited to just “paint spray guns.”<sup>23</sup> Additionally, Opposer has failed to submit any evidence of (1) how its sales and advertising figures compare to its competitors in the industry, (2) the frequency with which consumers encounter its AIRPRO mark for paint spray guns, or (3) any context for its achievements in the paint spray guns trade, e.g., market share. Without comparative numbers, market share percentages, or other indicia that would put Opposer’s sales and advertising figures into context, it is difficult to place the apparent success or renown of Opposer’s AIRPRO mark in

---

<sup>21</sup> Hartley Decl., ¶ 12; 40 TTABVUE 4.

<sup>22</sup> *Id.* at ¶ 9; 40 TTABVUE 4.

<sup>23</sup> Opposer uses its AIRPRO mark on a variety of goods, namely, paint spray guns, air spray guns, manual air spray guns, and automatic air spray guns. *See* Hartley Decl., ¶ 7; 40 TTABVUE 3.

the United States. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co., Inc.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690-91 (Fed. Cir. 2018); *see also Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002). Thus, due to the dearth of supporting evidence regarding the commercial strength of Opposer's AIRPRO mark used in connection with paint spray guns in the United States on which Opposer has the burden of proof, the fifth *DuPont* factor is neutral.

**ii. Similar Marks on Similar Goods – 6th *DuPont* Factor**

We next address the sixth *DuPont* factor, the number and nature of similar marks in use on similar services. *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016). The Federal Circuit has held that evidence of extensive registration and use of a term by others for similar goods [or services] can be “powerful” evidence of the term's weakness. *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674. If the evidence establishes that the consuming public is exposed to widespread third-party use of similar marks for similar goods or services, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps.*, 73 USPQ2d at 1693.

As previously noted, Applicant has not submitted any evidence concerning third-party uses of the mark AIRPRO for goods similar to those listed in Opposer's pleaded registration. Thus, the sixth *DuPont* factor is neutral.

In sum, the evidence of record neither demonstrates that Opposer's pleaded AIRPRO mark is conceptually or commercially weak for the goods listed in its pleaded registration. Rather, the record shows that while Opposer's AIRPRO mark may be

suggestive of Opposer's goods, when viewed in its entirety, it is nonetheless inherently distinctive and thus is entitled to the normal scope of protection afforded inherently distinctive marks. As noted above, the commercial strength of Opposer's mark is a neutral factor in our analysis, due to the lack of supporting evidence.

### C. Similarity of the Marks

We next consider the first *DuPont* likelihood of confusion factor, which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *DuPont*, 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.*, 101 USPQ2d at 1721 (internal citation omitted). The focus is on the recollection of the average purchaser – here, a customer or potential customer of paint spray guns or painting machines – who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Opposer's mark is AIRPRO in standard characters. Applicant's mark is **AEROPRO**. Here, the parties' respective marks are similar in appearance because both marks begin with the letter A, display R as the third letter, and end with the suffix "pro." Furthermore, the record includes the dictionary definition of the term

“aero” in combining form (i.e., “prefix”) which is defined as “air.”<sup>24</sup> Based on this definition, we find that Opposer’s AIRPRO mark and Applicant’s **AEROPRO** mark engender the identical connotation and overall commercial impression.<sup>25</sup> Finally, in terms of pronunciation, the marks are likewise similar. *See, e.g., In re Quik-Print Copy Shops*, 616 F.2d 523, 205 USPQ 505, 507 n.9 (CCPA 1980) (finding “no legally significant difference” between “quik” and “quick”); *cf. In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING will be perceived as the phonetic equivalent of the descriptive term URBAN HOUSING).

Quite simply, we find that the marks are similar, particularly taking into account “the recollection of the average customer, who retains a general rather than specific impression of marks,” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018), and the fact that the “marks ‘must be considered . . . in light of the fallibility of human memory’ and ‘not on the basis of side-by-side comparison.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec.*

---

<sup>24</sup> 37 TTABVUE 189-190. The Board takes judicial notice of the dictionary definition of the phrase “combining form” which is defined as “a modified form of an independent word that occurs only in combination with words, affixes, or other combining forms to form compounds or derivatives, as electro- (from electric) in electromagnet or geo- (from Greek geō-, from gē “earth”) in geochemistry” THE AMERICAN HERITAGE DICTIONARY, [www.ahdictionary.com](http://www.ahdictionary.com) (accessed Aug. 21, 2023). “The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions.” *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at \*20 n.41 (citing *In re Cordua Rests, LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016)).

<sup>25</sup> Applicant also submitted a dictionary definition for the term “aero,” defining the term as an adjective meaning “of or for aircraft” or “of or relating to aeronautics.” *See Xiaorong Decl.*, Ex. B, 42 TTABVUE 19. However, this particular definition does not appear to be the combining form of the term “aero” as it is used in Applicant’s mark.

*Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)).

In sum, while we have not overlooked any differences between Opposer's and Applicant's respective marks, we nonetheless find that marks are more similar than dissimilar. Thus, the first *DuPont* factor favors a finding of likelihood of confusion.

#### **D. Relatedness of the Goods**

We next address the second *DuPont* likelihood of confusion factor focusing on the comparison of the goods identified in Applicants' involved application and the goods listed in Opposer's pleaded registration for the mark AIRPRO.

The goods identified in Applicant's broadly-worded "painting machines"<sup>26</sup> encompass Opposer's more delineated "paint spray guns" listed in its pleaded registration. *See e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture."); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018) (same). Because Opposer's goods are encompassed in Applicant's goods, the parties' respective goods are legally identical in-part.

Accordingly, the second *DuPont* factor heavily weighs in favor of a finding of

---

<sup>26</sup> We take judicial notice of the dictionary definition of the wording "painting machine," which is defined as "a machine for spreading liquid paint or calcimine upon surfaces to be painted." THE CENTURY DICTIONARY, [www.wordnik.com](http://www.wordnik.com) (accessed August 21, 2023).

likelihood of confusion.

#### **D. Similarity of Trade Channels/Classes of Purchasers**

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. Because there are no restrictions as to trade channels or classes of purchasers set forth in the identification of goods of Applicant's involved application or the goods listed in Opposer's pleaded registration, we presume that both Opposer's and Applicant's legally identical in-part products travel in the same or overlapping trade and distribution channels and will be marketed to the same or overlapping potential consumers. *See In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) ("With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and 'presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....")); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

Accordingly, the third *DuPont* factor also strongly favors a finding of likelihood of confusion.

#### **V. Conclusion**

We have considered all of the parties' arguments and evidence of record, and all relevant *DuPont* factors. We find that (1) Opposer's mark is entitled to the normal

scope of protection accorded an inherently distinctive mark, (2) the marks at issue are similar, (3) Opposer's goods listed in its pleaded registration are legally identical in-part to Applicant's identified goods, (4) that the goods would move in the same or overlapping trade channels, and (5) the parties' respective goods are offered to the same or overlapping classes of purchasers. We thus find that Opposer has established, by a preponderance of the evidence, that Applicant's **AEROPRO** mark for the identified goods (as amended) so resembles Opposer's AIRPRO mark for its listed goods as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

In view of our finding that there is a likelihood of confusion between Opposer's AIRPRO mark and Applicant's **AEROPRO** mark, we need not reach the merits of Opposer's remaining pleaded claim that Applicant failed to use its mark in commerce as of the filing date of its opposed application. *See Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1478 (TTAB 2017) (Board has "discretion to decide only those claims necessary to enter judgment and dispose of the case" as its "determination of registrability does not require, in every instance, decision on every pleaded claim."); *Multisorb Tech., Inc. v. Pactive Corp.*, 109 USPQ2d 1170, 1171-72 (TTAB 2013) ("Like the federal courts, the Board has generally used its discretion to decide only those claims necessary to enter judgment and dispose of the case. . . [T]he Board's determination of registrability does not require, in every instance, decision on every pleaded claim.").

**Decision:** The opposition is sustained as to Opposer's likelihood of confusion

Opposition No. 91247343

claim under Section 2(d) of the Trademark Act and, therefore, registration to Applicant is refused.