

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: May 29, 2015

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

RTX Scientific, Incorporated

v.

Nu-Calgon Wholesaler, Inc.

Cancellation No. 92055285

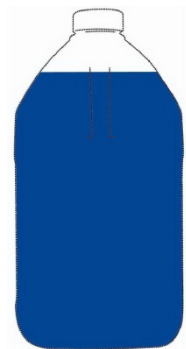
Joseph A. Mandour, III, Gordon E. Gray III and Ben T. Lila of Mandour & Associates, APC for RTX Scientific, Incorporated.

Julie C. Jennings and Michael J. Hartley of Senniger Powers LLP for Nu-Calgon Wholesaler, Inc.

Before Quinn, Mermelstein and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Nu-Calgon Wholesaler, Inc. (“Respondent”) owns a Principal Register registration issued under Section 2(f) of the Act for the mark shown below



for “cleaning preparation for air conditioning or refrigeration coils” (the “Registration”). The Registration includes a color claim and this description of the

mark: “The mark consists of the color blue as applied to the liquid portion of the goods inside the container. The dotted outline of the goods is intended to show the position of the mark on the goods and is not part of the mark.”<sup>1</sup>

In its petition for cancellation, RTX Scientific, Incorporated (“Petitioner”) alleges that it produces and sells “chemical products used in the Heating Ventilation and Cooling (HVAC) industry.” Petition for Cancellation ¶ 1. As grounds for cancellation, Petitioner alleges that Respondent’s involved mark is functional, merely descriptive of and generic for Respondent’s goods, and has not acquired distinctiveness “since registrant’s blue design is widely used by a variety of manufacturers in the HVAC industry for both identical and a variety of products.” *Id.* ¶ 3.<sup>2</sup> In its answer, Respondent “admits that color marks cannot be inherently distinctive,” Answer ¶ 3, denies the remaining salient allegations in the petition for cancellation and asserts as an affirmative defense that its mark has acquired distinctiveness.<sup>3</sup>

### **The Record and Evidentiary Objections**

The record automatically consists of the pleadings and the file of the involved Registration. In addition, Petitioner introduced the following:

---

<sup>1</sup> Registration No. 3888696, issued December 14, 2010 from an application filed October 21, 2009, based on first use dates of April 20, 1992.

<sup>2</sup> Petitioner also alleged fraud as an additional ground for cancellation, but that claim was previously found insufficient and never amended. Board’s March 22, 2013 order at p. 2 n. 2. In any event, Petitioner did not pursue this claim at trial or argue it in its Trial Brief, and the claim is accordingly waived. *Viacom International Inc. v. Komm*, 46 USPQ2d 1233, 1235 n.3 (TTAB 1998); *Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904, 1906 n.2 (TTAB 2005).

<sup>3</sup> Respondent also asserts as “affirmative defenses” that its mark is not functional or generic, which are merely amplifications of Respondent’s denials.

Notice of Reliance (TTABVue Dkt. No. 27) (“Petitioner’s NOR”) on Internet printouts.

Testimony deposition of Keith A. MacRae (TTABVue Dkt. No. 28) (“MacRae Tr.”), owner and vice president of ACE Chemical.

Testimony deposition of Dave E. Irvin (TTABVue Dkt. No. 29) (“Irvin Tr.”), founder and sales manager of Specialty Chemical, which was acquired by DiversiTech in 1998 following which Mr. Irvin “stayed on with DiversiTech.”

Testimony deposition of Scott Garner (TTABVue Dkt. No. 30) (“Garner Tr.”), executive vice president of Quest Vapco.

Testimony deposition of John Pastorello (TTABVue Dkt. No. 33) (“Pastorello Tr.”), Petitioner’s chief executive officer.

Testimony deposition of Roger D. Holder (TTABVue Dkt. No. 34) (“Holder Tr.”), Petitioner’s expert witness.

Rebuttal Notice of Reliance (TTABVue Dkt. No. 46) (“Petitioner’s Rebuttal NOR”) on Internet printouts.

Respondent introduced the following:

Testimony deposition of Lawrence Laliberte (TTABVue Dkt. No. 35) (“Laliberte Tr.”), director of purchasing for Thermal Supply.

Notice of Reliance (TTABVue Dkt. No. 36) (“Respondent’s NOR”) on Petitioner’s responses to Respondent’s interrogatories and requests for admission, portions of the discovery deposition of Mr. Pastorello (“Pastorello Disc. Tr.”), Internet printouts and third-party registrations.

Testimony deposition of William Oberheide (TTABVue Dkt. No. 38) (“Oberheide Tr.”), co-owner and manager of G&O Thermal Supply.

Testimony deposition of Lawrence Lannan (TTABVue Dkt. No. 40) (“Lannan Tr.”), technical director of Nuance Solutions, and Respondent’s expert witness.

Testimony deposition of Jeffrey Vendt (TTABVue Dkt. No. 41) (“Vendt Tr.”), Respondent’s director of marketing.

Testimony deposition of John Lawler (TTABVue Dkt. No. 43) (“Lawler Tr.”), Respondent’s vice president of marketing.

Testimony deposition of Paul I. Fleischut (TTABVue Dkt. No. 45) (“Fleischut Tr.”), an attorney with Respondent’s law firm.

Petitioner’s objection to Exhibit V to Mr. Lawler’s deposition on the ground of hearsay is overruled. Mr. Lawler testified that the exhibit consists of reports Respondent requires weekly from people with knowledge of the events described therein and that the records are kept in the course of Respondent’s regularly conducted business activity. Lawler Tr. 30-33. Petitioner has not shown that the sources of information in or methods of preparing the reports lack trustworthiness. Fed. R. Evid. 803(6).

Petitioner’s objections to Mr. Vendt’s and Mr. Lawler’s testimony about sales of Respondent’s blue NU-BRITE product and to Exhibit J to Mr. Vendt’s deposition are also overruled. Mr. Vendt and Mr. Lawler both testified sufficiently about how the records of Respondent’s sales are kept in the ordinary course of business, their review of those records and their responsibilities in connection with Respondent’s sales. Vendt Tr. 17-25; Lawler Tr. 20-24. Mr. Vendt testified that Exhibit J, a declaration which is part of the file history for the involved Registration, was true when signed and true today. Vendt Tr. 17.

Respondent's objection to Mr. Holder's expert report is sustained because the parties did not stipulate to the introduction of expert reports or testimony by declaration. *See Ate My Heart, Inc. v. GA GA Jeans Limited*, 111 USPQ2d 1564, 1566 n. 8 (TTAB 2014); Trademark Rule 2.123. Respondent's objection to Exhibit 137 to the MacRae deposition is overruled because Mr. MacRae testified that he oversees ACE's manufacturing and other operations, explained what the document consists of and who prepared it, and confirmed that it is an ACE business record. MacRae Tr. at 6, 14-15.

Respondent's objection to the testimony of Messrs. Garner, Pastorello, Holder, MacRae and Irvin concerning what these witnesses "think" HVAC industry customers believe about whether colors identify the source of products in the industry is overruled to the extent that Respondent seeks to exclude the testimony. We have considered these witnesses' testimony for what it is worth, and are able to weigh the probative value of this type of testimony. *See Fed. R. Evid.* 701.

Finally, Petitioner's objections to Mr. Vendt's testimony about the "Into the Blue" advertisement and Respondent being the first and exclusive user of blue for alkaline coil cleaners are overruled. The Board is capable of weighing this evidence and assigning to it the evidentiary weight it deserves.

**Respondent's Section 2(f) Claim of Acquired Distinctiveness**

In the initial, February 2, 2010 Office Action addressing the application which matured into the involved Registration, the Examining Attorney pointed out that "color marks are never inherently distinctive." The Examining Attorney

therefore suggested that Respondent either amend the application to seek registration on the Supplemental Register, or attempt to meet the “substantial” burden of establishing that the mark had acquired distinctiveness under Section 2(f).

In its July 29, 2010 response to the Office Action, Respondent chose the latter course, and submitted evidence of acquired distinctiveness including:

A declaration from Mr. Vendt who testified that: (1) NU-BRITE, the blue liquid coil cleaner product identified in the Registration, is the “industry’s number one selling condenser coil cleaner in the United States,” with steadily increasing sales since the product’s April 1992 inception with total sales of 1,500,000 gallons;<sup>4</sup> (2) Respondent “has spent over \$80,000 advertising its blue coil cleaner product”; and (3) Respondent’s mark “is recognized in the industry and by consumers to indicate [Respondent] as the source of the coil cleaner,” to the point that “end customers refer to the Nu-Brite coil cleaner as ‘blue,’ such as, ‘Give me 10 gallons of the blue coil cleaner.’”

A declaration from Mr. Oberheide, who testified that: (1) “I have been aware of [Respondent’s] color blue trademark for 16+ years because of its use of the trademark on its coil cleaner product, as well as in advertising and promotional materials”; and (2) Respondent’s “color blue mark operates to indicate [Respondent] as the source of blue colored coil cleaner, and I associate this color blue with [Respondent] as the source of blue colored coil cleaner.”

A declaration from Mr. Laliberte, who testified that: (1) “I have been aware of [Respondent’s] color blue trademark for 19 years because of its use of the trademark on its coil cleaner product, as well as in advertising and promotional

---

<sup>4</sup> Mr. Vendt’s declaration indicated that sales of NU-BRITE were “over 1,500,000 million gallons,” but in his deposition Mr. Vendt confirmed that the total was in fact 1,500,000 gallons. Vendt Tr. 89-91. The corrected figure is consistent with the body of the Office Action response at page 1.

materials”; and (2) Respondent’s “color blue mark operates to indicate [Respondent] as the source of the coil cleaner, and I associate this color blue with [Respondent] as the source of the blue colored coil cleaner.”

Respondent also submitted the following copies of advertisements which highlight

Respondent’s blue mark for its NU-BRITE coil cleaner:



**Relevant Facts and Arguments**

Mr. Lannan, who “developed” Respondent’s NU-BRITE product prior to its introduction in 1992, testified that the product is dyed blue because “that was the original request from [Respondent]. They specifically wanted a blue-colored product,” for “marketing reasons.” Lannan Tr. 17-19;<sup>5</sup> Lawler Tr. 15-20. Because of the product’s “high degree of alkalinity,” among other issues, it was difficult to find a way to color the product blue and keep it stable, and doing so significantly increases the product’s cost. Lannan Tr. at 18, 26-27, 35. Mr. Lawler testified that NU-BRITE is a “market leader” and Respondent’s best-selling coil cleaner. Lawler Tr. 16, 20.

There is a “two-step distribution market” for Respondent’s products, in that Respondent provides “specialty chemicals to air-conditioning and refrigeration wholesalers,” who in turn “sell to contractors, servicemen, and commercial and industrial customers of their own.” Lawler Tr. 15. Respondent’s competitors operate in a similar manner. MacRae Tr. 7-8 (ACE Chemical’s customers are “HVAC wholesalers nationwide” who in turn sell to HVAC “contractors mainly”); Irvin Tr. 9 (“we sold through wholesale houses who then sold to the retail customer which is the contactor”); Pastorello Tr. 10 (“Our customers are mainly the wholesaler that we sell directly to and the wholesaler who sells directly to contractors and service technicians.”); Laliberte Tr. 4-5.

---

<sup>5</sup> Respondent proffered Mr. Lannan as an expert witness, and paid him \$100 per hour for his time on this case. While the specific figures are confidential, Respondent “represents” a substantial portion of Mr. Lannan’s employer Nuance Solutions’s business.



Petitioner and Respondent compete with each other and with other HVAC chemical providers, including ACE (or Atlantic) Chemical, Rectorseal, Continental Research, Stewart Hall, QuestVapco (sometimes referred to as “Vapco”), Parker Hannifan (formerly Virginia KMP), DiversiTech and NRP. Irvin Tr. 8, 17; MacRae Tr. 7; Pastorello Tr. 9; Garner Tr. 9-10.<sup>6</sup> According to Respondent’s director of marketing Mr. Vendt, the “competitors that we face on a daily basis” are “Apex Engineering, [ACE] Chemical, Comstar, DiversiTech, Hydro-Balance, Highside, Parker Virginia KMP, RectorSeal, [Petitioner], Vapco, Sunbelt Labs, and Comstar.” Vendt Tr. 11-12; Lawler Tr. 16-17 and Exs. U, Y; MacRae Tr. 6 (ACE Chemical is also known as Atlantic Chemical).

These competitors have a history of asserting and defending against trademark claims related to their HVAC chemical products. In 1999, Petitioner sent a cease and desist letter to Respondent challenging Respondent’s use of the mark CAL-BLUE for a spray-on gas leak detector, based on Petitioner’s rights in the mark BIG BLU. Pastorello Tr. 17-20 and Ex. 5. In response, Respondent stated:

[the] BIG BLU mark designates a blue liquid product, BLU is generic or at least merely descriptive ... The use of blue in this field and other liquid chemical product fields is common. In the leak-detector field alone, National Refrigeration Product’s (NRP), Totaline, Bird Dog, Vapco (Cool-Zone Plus), Hydro-Balance (Bubble-Up), Atlantic (Ace Fact-Find), Diversitech (Pro-Air Bubble-Leak) and Trane (Service First) all use blue (see enclosures). Coloring an otherwise clear product to, for example, help indicate remaining product volume, and to distinguish it from other products in a company’s line (such as from

---

<sup>6</sup> According to Mr. Lawler, Stewart Hall was “bought out in the ‘90’s by a company called Continental Research who, in turn, was later acquired by RectorSeal.” Lawler Tr. 56.

[Respondent's] other gas leak products which are yellow and clear) is *de jure* functional, and not proprietary to Mr. Pastorello.

*Id.* Ex. 6.

Mr. Pastorello testified that Respondent's response to Petitioner's 1999 cease and desist letter "led me to believe that I could not pursue any type of trademark infringement against them. So it all made sense to me." *Id.* 19-20. Specifically, "an otherwise clear liquid, if it's colored, can show you how much fluid is left in the bottle and, therefore, coloring the product is functional." *Id.*

However, in June 2011, approximately six months after the involved Registration issued, Respondent sent a cease and desist letter to Petitioner, asserting rights in the color blue for its coil cleaner, citing the involved Registration and challenging Petitioner's VIPER BRITE product, "an air conditioning condenser coil cleaner, having a blue color." *Id.* Ex. 13. Petitioner later learned that at around the same time, Respondent sent ACE Chemical and DiversiTech, both of which also offer blue alkaline coil cleaners, similar cease and desist letters. At that point Mr. Pastorello "decided that [he] should proceed with cancellation of this trademark." *Id.* 15-17; Lawler Tr. Exs. S (Respondent's letter to DiversiTech) and W (Respondent's letter to ACE Chemical). Petitioner is splitting the cost of this cancellation proceeding with DiversiTech, Rector-Seal, QuestVapco and ACE Chemical. Pastorello Tr. 36-37.

Petitioner claims that blue is functional for alkaline coil cleaners for the reasons Respondent provided in response to Petitioner's 1999 cease and desist letter, and for another reason:

We have a self-imposed code that is used by all the major HVAC chemical manufacturers where pink-colored coil cleaners are acidic. The yellow-colored cleaners are predominantly multipurpose cleaners. Blue-colored coil cleaners are your alkaline condenser coil cleaners or brighteners. And green-colored coil cleaners are for use on evaporator coil cleaners. There are also green-colored products that are considered environmentally sound products. And then you have brown-colored coil cleaning products that's [sic] produced very high foam.

*Id.* 10-11. *See also*, Irvin Tr. 10 ("There was a green environmental indoor coil cleaner. There was a pink acid-foaming condenser coil cleaner. There was a blue-foaming condenser coil cleaner. Sometimes it would be a yellow-foaming condenser coil cleaner; but it was very much a matter of people bought the product by color code."); MacRae Tr. 8-9 ("Green has consistently or is known as a product that is used for evaporators. Yellow is a color which is a multi-purpose. Pink or red is acid-based which is used for the outside condenser. Then you get into blues and browns that are now used as alkaline cleaners, which are used for exterior condensers, as well."); Petitioner's NOR Ex. 140a ("Coil Cleaners are broken down in color. Red is acid based and is not recommended for the novice. Blue is foaming alkaline base and is very popular on coils where the foam is not a problem for cleanup ... Green is a self rinsing formula for use on coils that the dirt can be eliminated through the normal drain."). According to Mr. Pastorello, "the origins of the color code are because the simple litmus test, where – when litmus is dipped into an acid solution,

it turns pink. And when litmus is dipped into an alkaline solution, it turns blue. So I believe that is how we get the span of colors from blue to pink.” Pastorello Tr. 13.

Respondent disputes that there is a color code, pointing out that the alleged code is neither governmentally-mandated nor recorded anywhere. MacRae Tr. 21; Garner Tr. 32-33. In fact, there is no dispute that even if certain manufacturers follow the alleged code, there are exceptions to it, to the point that multiple HVAC chemical products, including alkaline coil cleaners, are colored, but not in conformance with the alleged code. Garner Tr. 24-26, 30-34 (agreeing that colors for alkaline coil cleaners vary widely, and that “there are at least five colors of alkaline coil cleaners”); MacRae Tr. 22-23; Pastorello Tr. 11-12, 31, 33-34; Irvin Tr. 10-11, 23-26; Holder Tr. 32, 40-41, 61-62; Laliberte Tr. 14 (not aware of any standard of color coding in the HVAC industry for coil cleaners);<sup>7</sup> Oberheide Tr. 19, 22; Lannan Tr. 31-35; Lawler Tr. 42, 48-49; Vendt 25-26; Respondent’s NOR Ex. JJ (Petitioner’s responses to Respondent’s Requests for Admission Nos. 2, 3).

Whether or not there is a color code followed by some or most HVAC chemical producers, many coil cleaners are blue and many are not. MacRae Tr. 16-19; Laliberte Tr. 11, 44. The following coil cleaners are or were blue, or in the “blue family”:

ACE’s Alkaline Coil Cleaner (“ACC”). Petitioner’s NOR Ex. 7a; Holder Tr. 28-31; Vendt Tr. Ex. 28 (response to Interrogatory No. 6).

---

<sup>7</sup> Mr. Laliberte’s company receives a rebate from Respondent based on its purchases of Respondent’s products.

ACE's Brite Coil Cleaner. MacRae Tr. 16-17; Lawler Tr. 25, 49.<sup>8</sup>

DiversiTech's Pro-Blue Coil Cleaner. Petitioner's NOR Ex. 140a, 144; Laliberte Tr. 30; Garner Tr. 19; Irvin Tr. 16;<sup>9</sup> Holder Tr. 21; Lannan Tr. 41; Vendt Tr. 65 and Ex. 28 (response to Interrogatory No. 6); Lawler Tr. 25, 49. Pastorello Tr. 22-23; Lawler Tr. 25; Lannan Tr. 41; Lawler Tr. Ex. DD.

NRP's Alka-Kleen. Pastorello Tr. 22; Vendt Tr. 64; Lawler Tr. 75.<sup>10</sup>

QuestVapco's HP Coil Cleaner. Petitioner's Rebuttal NOR Ex. 160 (blue appearance); MacRae Tr. 17; Irvin Tr. 17; Garner Tr. 11-13 and Ex. 147 (product is "clear turquoise" which Mr. Garner testified is "blue"); Vendt Tr. 62 (product is turquoise, which is "a green-blue combination"); Pastorello Tr. 22; Lawler Tr. 81.

Petitioner's Viper Brite. Pastorello Tr. 12-13, 20-22; Garner Tr. 19.<sup>11</sup>

Several witnesses agreed that a majority of coil cleaners offered by the major players in the industry, including some of those Mr. Vendt referred to as "competitors that we face on a daily basis," are blue. Irvin Tr. 27 ("By far a majority."); Holder Tr. 41 ("Most of them are blue, but there are other

---

<sup>8</sup> ACE's ACC "was the original, and AceBrite is the more recent product." MacRae Tr. 11.

<sup>9</sup> Mr. Irvin testified that prior to being acquired by DiversiTech, Specialty Chemical offered a blue alkaline coil cleaner called Free Foam. In 1999, Specialty Chemical began offering Super Foam, another blue alkaline coil cleaner which is the same product as DiversiTech's Pro-Blue. Irvin Tr. at 14-16. ("Pro Blue is basically Super Foam in the DiversiTech label. There is no difference.").

<sup>10</sup> While currently blue, this product used to be purple. Vendt Tr. 64; Holder Tr. 59-60.

<sup>11</sup> Several witnesses testified that Virginia KMP's Alki-Foam is also blue. MacRae Tr. 17; Garner Tr. 18-19; Irvin Tr. 17; Holder Tr. 28-31. However, Messrs. Pastorello, Lawler and Lannan testified that the product is actually "purple," and the product's Material Safety Data Sheet indicates that it is "purple." In addition, Mr. Irvin testified that RectorSeal and Hydro-Balance both "had a blue product" until he retired in 2008. Irvin Tr. 17. However, this testimony is vague and uncorroborated.

manufacturers that do have other colors.”); Pastorello Tr. 23 (“Most are predominantly blue.”); Garner Tr. 21-22 (“The majority” and “I would say greater than 50 percent.”). As for Mr. Vendt, he originally testified as follows:

10	Q	So does every HVAC chemical
11		manufacturer sell a blue alkaline coil cleaner?
12	A	No.
13	Q	How many sell a blue alkaline coil
14		cleaner?
15	A	Out of thirteen, six.
16	Q	Are you aware of other blue coil
17		cleaners besides Nu-Brite?
18	A	Yes.
19	Q	And how many?
20	A	Six. Oh, I'm sorry, restate the
21		question? I'm sorry.
22	Q	Are you aware of other blue coil
23		cleaners besides Nu-Brite?
24	A	Yes.
25	Q	How many?

---

**MIDWEST LITIGATION SERVICES**  
www.midwestlitigation.com      Phone: 1.800.280.3376      Fax: 314.644.133

---

**JEFFREY VENDT 5/8/2014**

---

Page 31

1	A	Six.
2	Q	Six besides Nu-Brite?
3	A	Correct.

Vendt Tr. 30-31. However, immediately thereafter, in response to the question “how many total coil cleaners on the market?,” Mr. Vendt testified “Including

[Respondent], there are over 88 coil cleaners on the market,” *id.* at 31, and this is the basis for Respondent’s argument that “[f]ewer than 10 percent of alkaline coil cleaners on the market are blue.” Respondent’s Trial Brief at 28.

Whether or not a majority of alkaline coil cleaners are blue, it is clear that either a majority or a large minority of the alkaline coil cleaners offered by major players in the industry are blue. Indeed, Mr. Vendt identified 12 specific “competitors that we face on a daily basis” (although he said there were 13 such competitors), and testified that including Respondent’s NU-BRITE product, there are seven blue alkaline coil cleaners. Vendt Tr. 11-12, 30-31. As Mr. Lannan explained when asked how many blue coil cleaners are on the market:

I know there’s major manufacturers in this business, but there’s also very small regional what we call bathtub-type manufacturers. So it could be a high number; but I’ve never seen a lot of the, you know, small-scale ones. But currently blue ones, I have to guess in the range of 10.

Lannan Tr. 78. While some of Mr. Lannan’s additional testimony is designated confidential, and will therefore not be discussed here, suffice it to say that according to Mr. Lannan, not all manufacturers are of “competitive concern” to Respondent, which is consistent with Mr. Vendt’s testimony about “competitors that we face on a daily basis.” *Id.* at 78-80. Furthermore, after sending its original cease and desist letters to Petitioner, DiversiTech and ACE Chemical in 2011, Respondent’s follow-up correspondence focused not on the “over 88 coil cleaners on the market,” but instead on “nationally-distributed products that compete with [Respondent’s] NU-BRITE alkaline coil cleaner,” “the major HVACR industry manufacturers” and

“industry giants.” Lawler Tr. Exs. U, Y, BB. In other words, it is clear that “the major HVACR industry manufacturers” and their “nationally-distributed products” of “competitive concern” are of more significance to Respondent and its competitors than small, regional or “bathtub-type manufacturers.” Furthermore, the trend in the industry is away from acid-based towards alkaline coil cleaners, and there is also “a trend to blue” coil cleaners generally. *Id.* 52-53; Lannan Tr. 100-101 (“I think there’s a trend in condenser coil cleaners going to blue, yes, recently,” specifically “these last few years.”). In short, there is no dispute that a large proportion of the coil cleaners sold by the industry’s major players are blue, and the “trend” suggests that this may only increase.

Furthermore, our focus here cannot be solely on *alkaline* coil cleaners, because Respondent’s Registration is not so limited, but is instead for “cleaning preparation for air conditioning or refrigeration coils,” without respect to whether the preparation is alkaline, acidic or neither.<sup>12</sup> See 15 U.S.C. § 1052(f). And there is at least one additional *acidic* coil cleaner which is also blue and therefore falls within Respondent’s identification of goods. Vendt Tr. 27 (“Nycos makes a blue coil cleaner that’s acidic.”).

In any event, and not surprisingly, Respondent’s witnesses testified that relevant consumers associate blue liquid coil cleaners with Respondent. Lannan Tr.

---

<sup>12</sup> For the same reason, Respondent’s claim that certain products do not compete with NUBRITE because they are comprised of “a different formulation” such as potassium hydroxide instead of Respondent’s sodium hydroxide formula, or are sold at a different price point, is irrelevant to the analysis of acquired distinctiveness. Respondent’s Trial Brief at 30. Respondent’s identification of goods is not limited to any particular formulation or price.



21-25 (wholesalers and end users “started referring to [Respondent’s] product as blue, the blue product. It almost seemed like it was a secondary name for the product.”); Lawler Tr. 24-25 (Respondent’s customers and their customers “will refer to Nu-Brite as the blue coil cleaner”); Vendt Tr. 25. Also not surprisingly, Petitioner’s witnesses testified that relevant consumers do not associate blue or other colors with the source of coil cleaners. Irvin Tr. 19; MacRae Tr. 18-19 (“I believe people recognize the application, not the source ... I think that the label and the bottle shape may tell them it came from Ace, but that would be it. Not the color ... Because there are so many other manufacturers in the marketplace using blue colors.”); Garner Tr. 20-21; Laliberte Tr. 24, 44 (consumers do not associate blue with a particular company “because there’s so many different blues out there right now”).<sup>13</sup>

While the evidence does not reveal exactly when all of the third-party blue coil cleaners were introduced, the record reveals the following:

ACE’s ACC was “first manufactured around ’81, ’82,” and continues to be sold. Pastorello Tr. 15-16; MacRae Tr. 11-15 and Exs. 135-137; Holder Tr. 30-31; Lawler Tr. 75.

ACE’s Brite Coil Cleaner was first sold “around 2000.” MacRae Tr. 16.

---

<sup>13</sup> Mr. Holder’s testimony was similar, but was based “in part” on an unscientific, unrecorded “survey” of 10 unidentified people at a single retail location. Mr. Holder is not experienced with conducting surveys. We find that the survey is entitled to no evidentiary weight, and despite Mr. Holder’s experience in the industry, we have not relied on any of his expert testimony or fact testimony based on the “survey.” *See* Holder Tr. 39, 42, 46-47; *see also, id.* 72-75 (Mr. Holder is a friend of Mr. Pastorello, a customer of Petitioner, did not research the coil cleaner industry and has never before served as an expert witness).

QuestVapco's HP Coil Cleaner was sold before NU-BRITE was introduced and is still being sold. MacRae Tr. 17; Garner Tr. 13-18 and Exs. 151 and 154.

Petitioner's Viper Brite was sold before Respondent's Registration issued and is still being sold. Pastorello Tr. 21; Garner Tr. 19-20; Respondent's Trial Brief at 8 (Petitioner "changed its straw colored coil cleaner that it had sold since about 1990 to the same royal blue color as [Respondent's] Nu-Brite product.").

NRP's Alka-Kleen was sold before Respondent's Registration issued. Lawler Tr. 75.

DiversiTech's Pro-Blue or its other blue coil cleaners were sold before Respondent's Registration issued and Pro-Blue is still being sold. Specialty Chemical's Super Foam was also sold before NU-BRITE was introduced. Garner Tr. 19-20; Pastorello Tr. 16-17; Lawler Tr. 75; Holder Tr. 21; Irvin Tr. 14-17.<sup>14</sup>

Respondent concedes that "there are several other HVAC chemical manufacturers currently selling various shades of blue colored coil cleaners," and more specifically that seven coil cleaners "available on the market" are blue, including Respondent's NU-BRITE product. Respondent's Trial Brief at 24, 28.

### **Standing**

Petitioner produces HVAC chemical products and competes with Respondent, and Respondent sent Petitioner the 2011 cease and desist letter based on the involved Registration. Pastorello Tr. 8-10 and Ex. 13; Vendt Tr. 11-12. This

---

<sup>14</sup> Mr. Vendt testified that he "believes" these products "came in after Nu-Brite." Vendt Tr. 31. However, his testimony is equivocal and contradicted by other witnesses, and in any event, as explained below, the question is whether these products "came in" prior to the date on which the Registration issued, not whether they "came in" prior to Respondent's first use of its mark. The record also reveals that Virginia KMP's Alki-Foam was sold before NU-BRITE was introduced and is still being sold. MacRae Tr. 17-18; Garner Tr. 18-19.

establishes Petitioner's standing. *Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987); *Kistner Concrete Products, Inc. v. Contech Arch Technologies, Inc.*, 97 USPQ2d 1912, 1918 (TTAB 2011); *Stuart Spector Designs, Ltd. V. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1553 (TTAB 2009); *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1428 (TTAB 2007); *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999); *Ipcor Corp. v. Blessings Corp.*, 5 USPQ2d 1974 (TTAB 1988).

### **Acquired Distinctiveness**

In *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009) our primary reviewing court set forth the burdens of proof and persuasion in cancellation proceedings grounded in Section 2(f) of the Act:

The party seeking to cancel registration of a mark always bears the burden of persuasion, that is, the ultimate burden of proving invalidity of the registration by a preponderance of the evidence. Initially, the party seeking cancellation also bears the “burden to establish a prima facie case” that the registration is invalid. *Yamaha [Int’l Corp. v. Hoshino Gakki Co., Ltd.]*, 840 F.2d 1572, 6 USPQ2d 1001, 1007 n.9 (Fed. Cir. 1988)]. In a Section 2(f) case, the party seeking cancellation bears the initial burden to “establish a prima facie case of no acquired distinctiveness.” *Id.* at 1576. To satisfy this initial burden, the party seeking cancellation must “present sufficient evidence or argument on which the board could reasonably conclude” that the party has overcome the record evidence of acquired distinctiveness – which includes everything submitted by the applicant during prosecution. *Id.* at 1576-77. The burden of producing additional evidence or argument in defense of registration only shifts to the registrant if and when the party seeking cancellation establishes a prima facie showing of invalidity. The Board must then decide whether the party seeking cancellation has satisfied its ultimate burden of

persuasion, based on all the evidence made of record during prosecution and any additional evidence introduced in the cancellation proceeding.

*Id.* at 1629-30.

Here, the Registration is for the color blue for Respondent's coil cleaner. It is settled that color may serve as a trademark, but only if it has acquired distinctiveness. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995) ("We cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained 'secondary meaning' and therefore identifies and distinguishes a particular brand (and thus indicates its 'source')."); *see also Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) ("with respect to at least one category of mark – colors – we have held that no mark can ever be inherently distinctive"). More specifically, it is also settled that "[b]y their nature color marks carry a difficult burden in demonstrating distinctiveness and trademark character." *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 420 (Fed. Cir. 1985); *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1434 (TTAB 2007). And where, as here, "the use of colors is common in a field, an applicant has a difficult burden in demonstrating distinctiveness of its claimed color." *In re Howard S. Leight and Assoc. Inc.*, 39 USPQ2d 1058, 1060 (TTAB 1996); *see also In re Florists' Transworld Delivery Inc.*, 106 USPQ2d 1784, 1792 (TTAB 2013) (applicant seeking registration of color mark "bears a heavy burden" to establish acquired distinctiveness). The question is whether Respondent's mark had

acquired distinctiveness at the time it was registered. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571-72 (TTAB 1988) (“We believe that the critical date is the date of registration, because if a mark which is not registrable in the absence of proof of distinctiveness was not in fact distinctive at the time of the issuance of the registration thereof, then the registration was invalidly issued.”); Respondent’s Trial Brief at 28 (“it is the time of trademark registration that is relevant with respect to a claim of acquired distinctiveness”); *see also*, *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501, 1506 n. 7 (TTAB 1993) (petitioner “could prevail in this action if the record revealed that either as of [the registration date] or as of the present time, the green wrapper lacked acquired distinctiveness”).

Here, Petitioner has met its initial burden of establishing a prima facie case that Respondent’s mark had not acquired distinctiveness at the time it was registered in 2010 (and does not currently have and never had acquired distinctiveness). Indeed, the record reveals, and Respondent concedes, that its use of blue is not “substantially exclusive.” Rather, at least ACE, QuestVapco, Petitioner, NRP and DiversiTech/Specialty Chemical offered blue “cleaning preparations for air conditioning or refrigeration coils” at the time the Registration issued, and Nyco offers a blue acidic coil cleaner which falls within Respondent’s identification of goods. Pastorello Tr. 15-17, 21; MacRae Tr. 11-17 and Exs. 135-137; Holder Tr. 21, 30-31; Lawler Tr. 75; Garner Tr. 13-20 and Exs. 151 and 154; Irvin Tr. 14-17; Vendt Tr. 27; Respondent’s Trial Brief at 8, 24, 28. In other words, Respondent’s mark is not distinctive. *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d

1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”). *See also*, *ERBE Elektromedizin GmbH v. Canady Technology LLC*, 629 F.3d 1278, 97 USPQ2d 1048, 1057 n.4 (Fed. Cir. 2010) (“the record evidence shows that at least one of ERBE’s competitors, ConMed, uses blue flexible endoscopic probes for use in argon plasma coagulation and thus ERBE does not maintain exclusive use”); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142, 1145-46 (TTAB 1990). To the extent that QuestVapco’s HP Coil Cleaner is turquoise and other coil cleaners are different shades of blue than Respondent’s blue, that does not detract from Petitioner’s showing that Respondent’s use of blue has not been substantially exclusive. *Saint-Gobain*, 90 USPQ2d at 1441; *Edward Weck*, 17 USPQ2d at 1145.

Respondent’s evidence does not overcome Petitioner’s prima facie case. To the contrary, while we recognize that Respondent has distributed some “look for” advertising touting the blue color of its coil cleaner, its other evidence is underwhelming, especially considering the circumstances of this case. Neither Respondent’s use of the color blue for well over 20 years nor the handful of witnesses who submitted affidavits during prosecution of Respondent’s application or testified at trial that they recognize the color blue as Respondent’s mark are sufficient where it is undisputed that color is commonly used in the HVAC chemical

industry, and more specifically that the color blue is commonly used for coil cleaners. *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1633 (Fed. Cir. 2003); *Saint Gobain*, 90 USPQ2d at 1435; *In re Ferris Corp.*, 59 USPQ2d 1587, 1592 (TTAB 2001).

Applicant's sales and advertising expenses are designated confidential, and therefore cannot be discussed specifically, but suffice it to say that in cases such as this, significantly higher sales and advertising costs than Respondent has established for its involved mark have been found insufficient to establish acquired distinctiveness. *Saint Gobain*, 90 USPQ2d at 1437; *In re Howard S. Leight*, 39 USPQ2d at 1060; *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Edward Weck*, 17 USPQ2d at 1146. *See also*, *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (\$85,000,000 in annual sales revenue and \$2,000,000 in annual advertising expenditures insufficient); *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705 (TTAB 1998) (\$56,000,000 in sales revenue and 740,000 tires sold insufficient).

Finally, Respondent argues that its competitors which use blue for coil cleaners are "infringers," and that "actual confusion" among consumers establishes that its mark has acquired distinctiveness. We are not persuaded. Respondent is correct that its use need not be entirely exclusive, and that "inconsequential or infringing" uses do not defeat its 2(f) claim. *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999). However, in this case, the third-party

uses revealed by the record are not inconsequential, as they include blue coil cleaners offered by at least four of the competitors Respondent “face[s] on a daily basis.” And while Respondent may have believed that these uses were infringing in 2011 when it sent its cease and desist letters, it chose not to take action against these uses then or in the four years since. As for the alleged “actual confusion,” Respondent cites Mr. Lawler’s testimony and weekly reports from account managers. Lawler Tr. 30-33 and Ex. V. But neither the testimony nor the documents establish actual confusion. If anything, they establish that consumers were aware that multiple sources offer blue coil cleaners. *Id.*

In short, Petitioner has satisfied its ultimate burden of persuasion, based on all the evidence of record, that Respondent’s use of blue for its coil cleaner is and was not “substantially exclusive,” and that the mark did not acquire distinctiveness prior to the issuance of the Registration or thereafter.

### **Conclusion**

Because the Registration is for a color mark and issued under Section 2(f), Respondent’s mark is not inherently distinctive. *See, Wal-Mart Stores*, 529 U.S. at 205, 54 USPQ2d at 1068; *Cold War Museum*, 586 F.2d at 1352, 92 USPQ2d at 1629. Petitioner has established that Respondent’s mark has not acquired distinctiveness. The mark is therefore not distinctive and we need not reach Petitioner’s remaining claims.



Cancellation No. 92055285

**Decision:** The petition to cancel is granted and the Registration will be cancelled in due course.