

This Opinion is not a
Precedent of the TTAB

Mailed: May 19, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wesco Group, LLC

Serial Nos. 87930506 and 87930522

David A. Lowe of Lowe Graham Jones PLLC
for Wesco Group, LLC

Paul Ferrer, Trademark Examining Attorney, Law Office 122,
Kevin Mittler, Managing Attorney.

Before Cataldo, Ritchie, and Heasley
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Applicant, Wesco Group, LLC, seeks registration on the Principal Register of the standard character marks LUMABASE and LUMABASE PERFORMANCE COATINGS (with PERFORMANCE COATINGS disclaimed). Both applications identify the following goods and services:

“Chemical preparations, namely, degreasing and cleaning solvents” in International Class 1;

“Automotive paints; Clear coating protectant for vehicles; Clear coatings used as paints; Clear protective coatings for vehicles; Coating compositions in the nature of paint for industrial applications; Coatings in the nature of automobile finishing; Colorants for use in the manufacture of paint; Colorants, paints and dyes for

general industrial use; Paint thinner; Paint thinners; Primer; Primers for preparing surfaces to be painted; Thinners for paint; Thinners for paints; Anti-corrosive coatings; Clear and pigmented coatings in the nature of paint; Corrosion inhibitors in the nature of a coating; Corrosion inhibitors in the nature of a coating; Paint primers; Polyurethane coatings for automobile finishing; Vehicle corrosion inhibiting preparations in the nature of a coating; Vehicle paints, namely, color paint chips to be used as examples of vehicle paint colors and pigments” in International Class 2;

“Alcohol for cleaning purposes; Automobile cleaners; Cleaning preparations; Automotive cleaning preparations” in International Class 3; and

“Development of software for computer-controlled mixing of pigments for vehicular paint” in International Class 42.¹

The Trademark Examining Attorney has refused registration of Applicant’s proposed marks for its identified goods in Classes 1 through 3 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the following registered standard character marks, issued on the Principal Register to two different entities:

ILLUMIBASE for “Refinish coating compositions in the nature of tint bases and tint bases sold as an integral component of automotive paints” in International Class 2;² and

LUMA for “Cleaning agents and preparations; Cloths impregnated with a detergent for cleaning; Laundry detergents; Washing preparations and laundry

¹ Application Serial Nos. 87930506 and 87930522 were filed on May 21, 2018, based on Applicant’s allegation of a bona fide intention to use the marks in commerce under Section 1(b) of the Trademark Act. 15 U.S.C. § 1051(b).

Page references to the application record are to the downloadable .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system. All references to the application record and TTABVUE are to Application Serial No. 87930506 unless otherwise stated.

² Registration No. 4363601 issued on the Principal Register on July 9, 2013. Section 8 and 15 declarations accepted and acknowledged.

bleach” in International Class 3.³

The refusals pertain only to Applicant’s identified goods in International Classes 1, 2, and 3, not to its services in International Class 42. When the refusals were made final, Applicant appealed. The cases are fully briefed. We consolidate the appeals because they involve common issues of law and fact with similar records. *See, e.g., In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1102 (TTAB 2018); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1214 (2019). We affirm the refusals to register.

I. Likelihood of Confusion

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts of record. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). *See Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant

³ Registration No. 5095831 issued on December 6, 2016. The owner of this registration also owns Registration No. 5324071, issued on October 31, 2017, for the mark LUMA WHITE (with WHITE disclaimed) for “Cloths impregnated with a detergent for cleaning; Laundry detergents; Washing preparations and laundry bleach” in International Class 3. Although the Examining Attorney has cited both of these registrations as grounds for his refusal, we consider LUMA more pertinent to our *DuPont* analysis than LUMA WHITE, as the mark and identified goods are closer to Applicant’s cleaning goods in Classes 1 and 3. *See, e.g., Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

to every case, and only factors of significance to the particular mark need be considered.”)).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the similarities between the goods. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. Relatedness of the Goods, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). A proper comparison of the goods “considers whether ‘the consuming public may

perceive [the respective goods or services...] as related enough to cause confusion about the source or origin of the goods and services.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)) *quoted in In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018). “[T]o support a finding of likelihood of confusion, it is not necessary that the goods be identical or even competitive. It is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods.” *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018).

1. Comparison with the Goods Identified in The ‘601 Registration for ILLUMIBASE

The ‘601 Registration for ILLUMIBASE identifies “Refinish coating compositions in the nature of tint bases and tint bases sold as an integral component of automotive paints.” The Applications identify:

Automotive paints; Clear coating protectant for vehicles; Clear coatings used as paints; Clear protective coatings for vehicles; Coating compositions in the nature of paint for industrial applications; Coatings in the nature of automobile finishing; Colorants for use in the manufacture of paint; Colorants, paints and dyes for general industrial use; Paint thinner; Paint thinners; Primer; Primers for preparing surfaces to be painted; Thinners for paint; Thinners for paints; Anti-corrosive coatings; Clear and pigmented coatings in the nature of paint; Corrosion inhabitants [sic] in the nature of a coating; Corrosion inhibitors in the nature of a coating; Paint primers; Polyurethane coatings for automobile finishing; Vehicle corrosion inhibiting preparations in the nature of a coating; Vehicle paints,

namely, color paint chips to be used as examples of vehicle paint colors and pigments in International Class 2.

Applicant attempts to distinguish the goods, arguing that “in contrast, the goods for the ILLUMIBASE cited registration relate to a very specific ‘**refinish[ing]** coating composition[.]’”⁴ We find that this fails to distinguish the goods.

As the Examining Attorney correctly notes, the respective goods are legally identical. Applicant’s goods comprise “Automotive paints; ... Coatings in the nature of automobile finishing; Colorants for use in the manufacture of paint; ... Clear and pigmented coatings in the nature of paint.” Applicant’s paint goods could be used in the initial finishing or later refinishing of automobiles, as they encompass both uses. Furthermore, a “colorant” is “a substance used for coloring a material,”⁵ so Registrant’s tint bases are a kind of colorant. Applicant’s Class 2 goods encompass Registrant’s goods inasmuch as the goods in the cited registration, as identified, are “an integral component of automotive paints.” *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.’”). The goods are thus legally identical.

To further show that the goods are related, the Examining Attorney made of record excerpts from websites showing that the same entities—PPG, Harris Paints, BASF, and Eastwood—provide the types of automotive coating and finishing goods

⁴ Applicant’s brief, 4 TTABVUE 7.

⁵ Merriam-Webster.com April 5, 2019 Office Action at 120; Examining Attorney’s brief, 6 TTABVUE 21.

identified in the Application and cited Registration under the same mark.⁶ This third-party evidence corroborates the relatedness of these goods. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) cited in *Ricardo Media Inc. v. Inventive Software, LLC*, 219 USPQ2d 311355, *3 (TTAB 2019).

2. Comparison with the Goods Identified in the '831 Registration for LUMA

The '831 Registration for LUMA identifies “Cleaning agents and preparations; Cloths impregnated with a detergent for cleaning; Laundry detergents; Washing preparations and laundry bleach” in International Class 3. The Applications identify “Alcohol for cleaning purposes; Automobile cleaners; Cleaning preparations; Automotive cleaning preparations” in International Class 3 and “Chemical preparations, namely, degreasing and cleaning solvents” in International Class 1.

Applicant argues that the cited Registration “relate[s] to laundry detergents and impregnated cloths and cleaning agents,” whereas “Applicant’s good relate to *vehicle* paint and cleaning products....”⁷ Applicant continues:

Importantly, the Office fails to show that each and every listed good is conflicting or even overlapping, choosing instead to focus on what it calls “broad wording” found in just a few of the goods descriptions. But the Office admits that only a few of the goods were not limited to vehicles: “to wit: (i) degreasing and cleaning solvents in International Class 001; and (ii) Cleaning preparations in International Class 003.” Moreover, the Office admits that it did not even consider whether the fact that the majority of the goods that are limited to vehicles altered the likelihood of confusion analysis, which it must. The Office bears the burden of establishing the similarity of all of the claimed goods, not just the handpicked few it seeks to use to make its case.⁸

⁶ Examining Attorney’s brief, 6 TTABVUE 22-23; September 14, 2018 Office Action at 33-42; April 5, 2019 Office Action, at 105-110.

⁷ Applicant’s brief, 4 TTABVUE 6-7.

⁸ Applicant’s brief, 4 TTABVUE 7.

We disagree. “[W]e consider the applicant’s goods as set forth in its application, and the [registrant’s] goods as set forth in its registration.” *In re i.am.symbolic*, 123 USPQ2d at 1749. And we must consider them to include all goods of the type identified. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). We do not read limitations or restrictions into the identification. *Id.* at 1748; *In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 5 (TTAB 2019). Nor do we base our analysis on extrinsic evidence or attorney argument. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986).

Registrant’s “cleaning agents and preparations” are legally identical to Applicant’s Class 3 goods: “alcohol for cleaning purposes; automobile cleaners; cleaning preparations; automotive cleaning preparations.” *See Yawata Iron & Steel*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (finding goods identified in registration—carbon steel, alloy steel, semi-steel, and malleable and grey iron castings—legally identical to iron and steel goods identified in application); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (“Registrant’s goods are broadly identified as computer programs recorded on magnetic disks, without any limitation as to the kind of programs or the field of use. Therefore, we must assume that registrant’s goods encompass all such computer programs including those which are for data integration and transfer.”). Registrant’s goods encompass Applicant’s goods in Class 3, and are legally identical thereto.

Applicant's Class 1 goods, "chemical preparations, namely, degreasing and cleaning solvents," are identical in part and otherwise related in part to the goods identified in the '831 LUMA Registration. Registrant's "cleaning agents and preparations" are identical to Applicant's "chemical preparations, namely ... cleaning solvents" in Applicant's Class 1 goods. And the Examining Attorney's third-party evidence establishes that Registrant's "cleaning agents and preparations" are related to Applicant's remaining Class 1 goods, "degreasing ... solvents."

The Examining Attorney further adduces evidence of third-party websites offering cleaning agents and preparations of the sort offered by Registrant and degreasing and cleaning solvents of the sort offered by Applicant. For example:

- **409** Cleaner/Degreaser "Instantly cuts through grease and dirt."⁹
- **ZEP** Industrial Cleaner and Degreaser.¹⁰
- **MC-1000** "Neutral All-Purpose Cleaner and Degreaser."¹¹
- **RUST-OLEUM KRUD KUTTER** Cleaner/Degreaser.¹²
- **EASY-OFF** Specialty Kitchen Degreaser Cleaner.¹³
- **CITRASOLV** Natural Cleaner and Degreaser Concentrate.¹⁴

This third-party use evidence demonstrates that Applicant's identified degreasing goods are related to the cleaning goods identified in the '831 LUMA Registration, as

⁹ Uline.com, April 5, 2019 Office Action at 53.

¹⁰ HomeDepot.com, April 5, 2019 Office Action at 54-59.

¹¹ Walmart.com, April 5, 2019 Office Action at 60.

¹² *Id.* at 76.

¹³ *Id.* at 86.

¹⁴ *Id.* at 99.

such goods are often sold together, or even blended together in the same product, and are offered by the same source under the same mark. *See In re Detroit Athletic Co.*, 128 USPQ2d at 1051. This evidence supports a finding that the respective goods are related products that will be encountered by the same purchasers from the same sources. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69 (TTAB 2009).

Additionally, the Examining Attorney adduces evidence of third-party registrations showing that Registrant’s cleaning agents and preparations and Applicant’s degreasing and cleaning solvents and cleaning preparations, including those for used cleaning automobiles. E.g:

Registration No.	Mark	Pertinent Goods
4274194	AQUA-GREEN-CLEAN	Chemical preparations, namely, degreasing and cleaning solvents; All purpose cleaning preparations; cleaning agents and preparations;
4621007	PUREOUS	Chemical preparations, namely, degreasing and cleaning solvents; Cleaning agents and preparations; Cleaning and washing preparations
4849793	EAGLE CHEMICALS INC. EST. 1972 & Design	Chemical preparations, namely, degreasing and cleaning solvents; All-purpose cleaning preparations; All-purpose cleaners; Cleaning preparations for motor vehicles, namely, finishing waxes and automotive shampoos;
5083148	F12 SOLUTIONS	Chemical preparation, namely, degreasing and cleaning solvents; All purpose cleaning preparations; Automotive cleaning preparations; preparations for cleaning, protecting and preserving vehicle surfaces

5451913	FORCEFIELD	Chemical preparation, namely, degreasing and cleaning solvents; All purpose cleaning preparations; Cleaning and washing preparation; Cleaning preparations for cleaning surfaces; Automotive cleaning preparations; Preparations for cleaning, protecting and preserving vehicle surfaces; ¹⁵
---------	------------	--

These registrations suggest that the relevant goods—degreasing and cleaning solvents and cleaning agents and preparations, including those used to clean automobiles and other motor vehicles—are of a type that may emanate from the same source, under the same mark. *See In re Country Oven*, 2019 USPQ2d 443903, at * 8-9; *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013) (“The use-based, third-party registrations . . . also have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark.”). Hence, Applicant’s Class 1 goods are identical in part and related in part to the goods identified in the ‘831 LUMA Registration. Additionally, we may find that there is a likelihood of confusion when only one item in a class of goods is commercially similar to the other party’s goods. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (It is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods within a particular class in the application); *see also Research in Motion Limited v. Defining Presence Mktng. Grp., Inc.* 102 USPQ2d 1187 (TTAB 2012) (“Likelihood of

¹⁵ Sept. 14, 2018 Office Action at 18-39.

confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application.”); *Hewlett-Packard Development Co., L.P. v. Vudu, Inc.*, 92 USPQ2d 1630, 1633 n.4 (TTAB 2009) (“it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application or registration”) (internal citations omitted).

3. Channels of Trade and Classes of Customers

As the Examining Attorney has established, Applicant’s Class 2 goods (automotive paints, coatings, and colorants) and Class 3 goods (cleaners) are legally identical to the goods identified in the ‘601 and ‘831 Registrations, respectively. Goods that are legally identical are presumed to travel in the same channels of trade to the same classes of purchasers. *In re Yawata Iron & Steel Co.*, 159 USPQ at 723 (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *In re FabFitFun*, 127 USPQ2d at 1672-73. Judging from the goods, the primary class of purchasers would be automobile body shops, although individuals could purchase such goods, as well.

The Examining Attorney has also established that Applicant’s Class 1 goods are identical in part (cleaning preparations) and related in part (degreasing solvents) to the cleaning agents and preparations in the ‘831 LUMA Registration. Identical goods are presumed to flow through the same channels of trade to the same classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (Absent restrictions in an application and/or registration, identical goods are “presumed to travel in the same channels of trade to the same class of purchasers.”)

quoted in *Zheng Cai v. Diamond Hong*, 127 USPQ2d at 1801. And goods that are related in part “could be offered and sold to the same classes of purchasers through the same channels of trade.” *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003); *L. & J.G. Stickley, Inc. v. Cosser*, 81 USPQ2d 1956, 1971 (TTAB 2007) (“Because the goods of both parties are at least overlapping, we must presume that the purchasers and channels of trade would at least overlap.”). These purchasers would encompass any businesses or individuals using cleaning preparations, which would include auto body shops and general consumers using automotive cleaning preparations.

For these reasons, the second and third *DuPont* factors weigh in favor of a likelihood of confusion.

B. Similarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrants’ marks in their entirety, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

We are mindful that where, as here, the marks are used in association with goods that are legally identical or identical in part, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Bridgestone*

Ams. Tire Operations LLC v. Fed. Corp., 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

1. Comparison with the ‘601 Registration’s ILLUMIBASE mark

We begin by comparing the applied-for LUMABASE mark with the registered ILLUMIBASE mark. As the Examining Attorney observes, the marks—consisting of LUMA+BASE on one hand and ILLUMI+BASE on the other—evoke the same connotation, as both suggest a bright base coat for automobiles. Dictionary definitions submitted during the course of examination show that “luma” is defined as “the brightness in an image...,”¹⁶ and “illuminate” as “to provide or brighten with light.”¹⁷

The Examining Attorney states:

As shown by the attached dictionary definition and Internet evidence, LUMA is defined as the brightness of an image. On the other hand [the] wording “illuminate” means to “brighten with light”, as shown by the attached dictionary definition. Accordingly the terms LUMABASE and ILLUMIBASE, as applied to applicant’s and registrant’s respective “protective coatings” and related goods for vehicles and automobiles, clearly convey the same idea and stimulate the same impression, that of a luminous base.¹⁸

Applicant begs to differ, arguing that “If one improperly dissects the marks into components, there is no dictionary definition of ‘lumi’ and ‘luma’ is a ‘monetary unit of Armenia worth one hundredth of a dram’—unrelated to any meaning of the

¹⁶ Wordlink.com, April 5, 2019 Office Action 11.

¹⁷ AHDictionary.com, April 5, 2019 Office Action 24.

¹⁸ April 5, 2019 Office Action 6; Examining Attorney’s brief, 6 TTABVUE 10.

discussed terms. See dictionary.com (retrieved 3.13.19).”¹⁹ With respect to the shared suffix “base,” Applicant argues that

Base is [de]fined as “the bottom support of anything” or “a fundamental principle or groundwork” at the same source. While that term is common in both Applicant’s LUMABASE mark and the ILLUMIBASE mark, if dissected, the differing prefix components remove any possible overlapping meaning.²⁰

Applicant’s arguments are not well taken. “[W]e must look to the likely consumer perception of the mark in connection with the identified goods, rather than applicant’s [suggested] connotation.” *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1886 (TTAB 2011). The way Applicant intends to use its mark helps corroborate the meaning it conveys. See *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017). In this case, as the Examining Attorney correctly observes, the applied-for mark LUMABASE, for use on paints, primers, coatings, colorants, and dyes, as well as automotive cleaners, clearly connotes that these goods will produce and maintain a bright, luminous base coat on automobiles. So too with ILLUMIBASE, for legally identical goods.

This common connotation, taken alone, would suffice to support a finding of similarity. *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (“the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark”). But the marks are also similar in sight and sound. Each mark is structured the same, with LUMA or

¹⁹ Applicant’s brief, 4 TTABVUE 5.

²⁰ Applicant’s brief, 4 TTABVUE 5-6.

ILLUMI preceding BASE. Applicant argues that “three-syllable ILLUMI is very different in sight and sound from two-syllable LUMA.”²¹ But if the marks are considered in their entirety, as they must, the differences are negligible. LUMABASE and ILLUMIBASE differ by only one syllable, and by the registered mark’s use of the short vowel “I” instead of “A” at the end of ILLUMI. To the extent that there is any minor difference in pronunciation, those who hear the marks spoken by others are unlikely to even notice the difference. *In re Viterra*, 101 USPQ2d at 1912. Slight differences in the sound of similar marks do not avoid a likelihood of confusion. *In re Energy Telecomms. & Elec. Ass’n*, 222 USPQ 350, 351 (TTAB 1983) (finding the wording of applicant’s mark ENTELEC & design and the cited registered mark INTELLECT similar in appearance and substantially identical in pronunciation); *Breon Labs. Inc. v. Vargas*, 170 USPQ 532, 536 (TTAB 1971) (the resemblances between the marks BRONCO-FEDRIN and BRONKEPHRINE in both sound and appearance are of such nature that they frequently would sound alike when spoken and look so nearly alike when written that confusion is likely).

Applicant’s other applied-for mark, LUMABASE PERFORMANCE COATINGS, adds the disclaimed descriptive words “performance coatings,” but that does not distinguish the marks. As the Federal Circuit and the Board have repeatedly declared:

Disclaimed, generic or descriptive matter generally has less significance in likelihood of confusion determinations. *See In re Nat’l Data Corp.*, 224 USPQ at 752; *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Nat’l Data Corp.*, 224

²¹ Applicant’s brief, 4 TTABVUE 5.

USPQ at 752 (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion”); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

In re Information Builders, 2020 USPQ2d 10444, at *7.

If anything, Applicant’s addition of “PERFORMANCE COATINGS” reinforces LUMABASE’s connotation of providing a bright, luminous base coating—the very connotation it shares with ILLUMIBASE. Both applied-for marks are therefore similar to the registered mark ILLUMIBASE in sight, sound, connotation, and commercial impression.

2. Comparison with the ‘831 Registration’s LUMA mark

We next compare the applied-for LUMABASE mark with the registered LUMA mark. Applicant’s LUMABASE mark adopts the registered mark LUMA in its entirety, adding the suffix BASE.

The Examining Attorney contends:

[T]he addition of the word BASE in the applied-for mark does not obviate the similarities in the marks because adding a term to a prior mark does not obviate the similarities in the marks, as in the present case, nor does it overcome a likelihood of confusion. *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii).²²

²² Examining Attorney’s brief, 6 TTABVUE 8-9.

Applicant counters that the decisions on which the Examining Attorney relies involved the addition of separate words—e.g., BENGAL and BENGAL LANCER—whereas LUMABASE is a single word.²³ It continues:

Applicant’s LUMABASE is a three-syllable, combined term compared to the two-syllable LUMA mark and the two-word LUMA WHITE mark. Under controlling law, the integrated BASE term incorporated into Applicant’s LUMABASE cannot simply be ignored. Conspicuously, the BASE term is missing from the marks of the cited registration. Likewise, the WHITE terms in the second mark is nowhere to be found in Applicant’s mark.

The Office Action engages in improper dissection of the marks, focusing exclusively on the similar LUMA component of the respective marks while completely ignoring the additional components.²⁴

We agree with the Examining Attorney, however, that Applicant’s appropriation of LUMA and addition of BASE, without a space, does not obviate the similarity between the marks. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845-46 (Fed. Cir. 2000) (finding similarity between LASER for golf clubs and golf balls and LASERSWING for golf practice devices, and noting that “the term ‘swing’ is both common and descriptive” and therefore “may be given little weight in reaching a conclusion on likelihood of confusion”) *cited in In re Detroit Athletic Co.*, 128 USPQ2d at 1049-50; *see also In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM similar to CONFIRMCELLS); *In re BASF AG*, 189 USPQ 424 (TTAB 1975) (finding LUTEX confusingly similar to LUTEXAL).

²³ Applicant’s brief, 4 TTABVUE 4; Applicant’s reply brief, 7 TTABVUE 2-3.

²⁴ Applicant’s brief, 4 TTABVUE 4.

The first part of a mark—in this case, LUMA—is most likely to be impressed on the mind of a purchaser and remembered. *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1115-16 (TTAB 2019) (citing *Century 21 Real Estate v. Century Life of Am.*, 23 USPQ2d at 1700). As Applicant concedes, “In fact, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).”²⁵

If the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See In re Mighty Leaf Tea*, 94 USPQ2d at 1260-61. Applicant cannot avoid likelihood of confusion by adopting Registrant’s entire mark and adding subordinate matter thereto. *See In re Jump Designs LLC*, 80 USPQ2d 1370, 1375 (TTAB 2006) (“The general rule is that a subsequent user may not appropriate the entire mark of another and avoid a likelihood of confusion by adding descriptive or subordinate matter thereto.”). As noted, the suffix BASE merely suggests a base coating that is rendered more luminous by products bearing the LUMABASE mark.

The other applied-for mark, LUMABASE PERFORMANCE COATINGS, emphasizes this purpose with its additional descriptive wording, “PERFORMANCE COATINGS.” *See In re Detroit Athletic Co.*, 128 USPQ2d at 1049-50 (quoting MCCARTHY ON TRADEMARKS § 23:50, at 23-283 (merely adding “a generic, descriptive

²⁵ Applicant’s reply brief, 7 TTABVUE 2.

or highly suggestive term[] . . . is generally not sufficient to avoid confusion”). If anything, the disclaimed descriptive wording reinforces the shared commercial impression of the respective marks. Just as this Registrant uses a variation of its LUMA mark, LUMA WHITE, on similar cleaning products, purchasers are likely to perceive the applied-for marks as variants of LUMA indicating companion lines of products: “Even those purchasers who are fully aware of the specific differences between the marks may well believe, because of the similarities between them, that the two marks are simply variants of one another, used by a single producer to identify and distinguish companion lines of products.” *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985).

And since purchasers would encounter them at different times, “[t]he marks ‘must be considered . . . in light of the fallibility of memory’ and ‘not on the basis of side-by-side comparison.’” *In re St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). “Considering the substantial similarities between the marks in this case, it seems to us that a purchaser who sees one mark and later encounters the other is likely to think, if the two marks are applied to the same or related goods and/or services, that the second mark is the same mark he had seen earlier, or, if he realizes that there are some differences in the marks, that the second is simply a slightly varied version of the first, with both serving to indicate origin in the same source.” *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1468 (TTAB 1988).

For these reasons, we find that the marks are more similar than dissimilar, and the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

C. Strength or Weakness of LUMA and LUMI Formative Registered Marks

The sixth *DuPont* factor requires us to consider the number and nature of similar marks in use on similar goods. *DuPont*, 177 USPQ at 567; *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016).

Applicant has submitted records of 35 use-based third-party registrations containing formatives of LUMA or LUMI to show that the cited registered marks are relatively weak and entitled to only a narrow scope of protection.²⁶ Applicant argues:

Here, evidence of third-party registration and use of marks with similar terms in similar fields further confirms that consumers have been conditioned to look to other elements or characteristics of the marks to distinguish the source of goods, and must be considered. TMEP 1201.07(d)(iii); *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1911 n.1912 (TTAB 1988) ...; *In re Broadway Chicken Inc.*, 38 USPQ2d 1559,1566 (TTAB 1996)....²⁷

As the Examining Attorney rightly observes, however, 32 of the 35 third-party registrations have no bearing on this case.²⁸ Twenty-eight (28) are for unrelated goods, such as adhesives and related chemicals, water purification, or manufacture of foams for cushions, mattresses, and pillows;²⁹ for ALUMI- or ALUMA- formative marks relating to aluminum or metal particles to improve conduction of electricity or heat transfer, or coating for cookware and electrical appliances;³⁰ or for color pigments for prints or cloth, industrial structures, or paint strippers.³¹ Under the

²⁶ Applicant's reply brief, 7 TTABVUE 6.

²⁷ Applicant's brief, 4 TTABVUE 8.

²⁸ Examining Attorney's brief, 6 TTABVUE 11.

²⁹ Applicant's brief, 4 TTABVUE 17-134, exhibits 9, 10, 15, 21, 30, 31.

³⁰ *Id.*, exhibits 2, 3, 5, 6, 8, 18, 22, 27.

³¹ *Id.*, exhibits 13, 19, 26.

sixth *DuPont* factor, “the controlling inquiry is the extent of third-party marks in use on ‘similar’ goods or services. . . . ‘It is less relevant that [the mark] is used on unrelated goods or services....’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (quoting *Century 21 Real Estate. v. Century Life of Am.*, 23 USPQ2d at 1701). See *In re i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration).

Three of the 35 registrations to which Applicant refers are the cited Registrations for ILLUMIBASE, LUMA, and LUMA WHITE.³² It is difficult to discern how the presence of these three cited Registrations weakens their distinctiveness. Finally, one registration from Applicant’s list of 35 registrations has been cancelled.³³ “A cancelled registration is only evidence that the registration issued and it does not carry any of the legal presumptions under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). See *Bond v. Taylor*, 119 USPQ2d 1049, 1054-55 (TTAB 2016); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011) (“‘dead’ or cancelled registrations have no probative value at all.”). As such, we have given no consideration to this particular registration.” *In re Information Builders*, 2020 USPQ2d 10444, at *6 n. 19.

³² *Id.*, exhibits 16, 25, 28.

³³ *Id.*, exhibit 1, LUMINOVA, Reg. No. 2082054, cancelled.

That leaves three third-party registrations that have some bearing on this case:

Registration and Exhibit Number	Mark	Goods
Reg. No. 2187120 Ex. 4	LUMACHROME	Chemical products for use in chromium plating processes Cl. 1.
Reg. No. 3239670 Ex. 12	ALUMA-STEEL	All-purpose cleaners, automobile cleaners, automobile polish, automobile wax, carburetor and choke cleaning preparation, carpet cleaners, chrome polish; cleaning preparations for automobiles, fragrances for automobiles; glass cleaners, paint remover, windshield washing fluid, Cl. 3.
Reg. No. 4800600 Ex. 23	ALUMA 45	Corrosion inhibitors in the nature of a coating; paint primers, Cl. 2. ³⁴

Contrary to Applicant’s contention, these few third-party registrations, standing alone, do not show commercial weakness of the cited registrations—i.e., a “crowded field” in the perception of relevant purchasers. The *Broadway Chicken* case, on which Applicant relies, relied on more than third-party registrations; it considered the extensive use of *Broadway*-formative marks and trade names for restaurant establishments throughout the country, as evidenced by 80 white and yellow page listings, the American Business Directory of more than 575 entities whose names contain “Broadway,” and 500 Dun & Bradstreet “Broadway” listings. From this the Board concluded that “the evidence offered by applicant is sufficient to establish prima facie that a significant number of third parties are using trade names/service marks containing the term BROADWAY for restaurant/’eating place’ services, as well

³⁴ Applicant’s brief, 4 TTABVUE 29-31, 54-56, 92-94.

as for goods and services related thereto.” *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561-62, 1565 (TTAB 1996).

Not so here, where Applicant’s relevant evidence is limited to three third-party registrations and no additional evidence of third-party use. As the Board has declared, “... Applicant’s citation of third-party registrations as evidence of market weakness is unavailing because third-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences.” *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016). So Applicant’s third-party registration evidence does not establish that the cited registered marks are commercially weak.

Third-party registrations can, however, show the **conceptual** weakness of a mark or part of a mark:

However, third-party registrations are relevant evidence of the inherent or conceptual strength of a mark or term because they are probative of how terms are used in connection with the goods or services identified in the registrations. “Third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.” *E.g.*, *Institut National Des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). *See also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674–75 (Fed. Cir. 2015); *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). Third-party registrations used in this manner are not evidence that customers are accustomed to seeing the use of other, similar, marks in the marketplace, but rather evidence that a term is suggestive or descriptive of the relevant goods or services. Such terms may be

conceptually weak because the more descriptive a term is, the less likely prospective purchasers are to attach source-identifying significance to it.

In re Morinaga, 120 USPQ2d at 1745-46.

The decision on which Applicant relies, *In re Dayco Products-Eagle Motive Inc.*, exemplifies this effect of third-party registrations on conceptual strength. 9 USPQ2d 1910, 1911-1912 (TTAB 1988) (“In our view, the submission of the third party registrations is probative to demonstrate that ‘IMPERIAL’ has been adopted by others in the vehicular field to refer to that term’s ordinary significance as a laudatory designation.”).

In this case, however, we have already noted the suggestive significance of LUMA and ILLUMI, connoting the bright, luminous coating resulting from Applicant’s and Registrants’ products. Applicant’s citation of a few third-party registrations neither adds to nor detracts from this suggestive connotation. Even though the cited registered marks consist of or contain suggestive terms, they are deemed inherently distinctive. 15 U.S.C. § 1057(b); *In re Fiesta Palms*, 85 USPQ2d 1360, 1363 (TTAB 2007) (“inasmuch as the cited mark is registered on the Principal Register, we must assume that it is at least suggestive....”) (citing *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997)). And even weak marks are entitled to protection against confusingly similar marks. See *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *Matsushita Electric Co. v. National Steel Co.*, 442 F.2d 1383, 170 USPQ 98, 99 (CCPA 1971) (“Even though a mark may be ‘weak’ in the sense of being a common word in common use as a trademark, it is entitled to be protected sufficiently to prevent confusion from source

arising.”). Thus, Applicant’s cited third-party registrations do not weaken the scope of protection to which the cited registrations are entitled.

II. Conclusion

“[T]he Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1560 (Fed. Cir. 2001). For the above reasons, we conclude that Applicant’s applied-for marks, as used on the goods identified in the applications, so resemble the cited registered marks, as used on their identified goods, as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The refusals to register Applicant’s proposed marks are affirmed.