

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

Hearing: October 13, 2010

Mailed: January 31, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Liberty Bell Equipment Corp.  
v.  
Graco Minnesota Inc.

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Opposition No. 91177965  
to application Serial No. 77017072  
filed on October 9, 2006

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Frank J. Bonini, Jr. of Harding, Earley, Follmer & Frailey  
for Liberty Bell Equipment Corp.

Douglas B. Farrow for Graco Minnesota Inc.

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Before Quinn, Walters and Bergsman,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Graco Minnesota Inc. ("applicant") filed an intent-to-use application for the mark FINISHPRO, in standard character form, for "paint sprayers," in Class 7.

Liberty Bell Equipment Corp. ("opposer") opposed the registration of applicant's mark on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). Specifically, opposer alleged that prior to any date upon which applicant may rely, opposer has been using the mark FINISH PRO in connection with automotive and marine paints, coatings, and finishes as well as related accessories, and that

applicant's mark FINISHPRO for "paint sprayers" so resembles opposer's mark as to be likely to cause confusion. Opposer pleaded ownership of the two federally-registered marks shown below:

1. Registration No. 2951274 for the mark FINISH PRO and design, shown below,



for the following goods:

Acetone for automotive, industrial and marine use, in Class 1;

Paint thinners and paint reducers, namely enamels and urethanes for automotive, industrial and marine use, Class 2;

Solvents and wax and grease removers for automotive, industrial and marine use, in Class 3;

Masking paper for automotive, industrial and marine use, in Class 16;

Plastic sheeting for automotive, industrial and marine use as drop cloths, vapor barriers and masking material, in Class 17;<sup>1</sup> and

2. Registration No. 2955475 for the mark FINISH PRO, in standard character form, for the goods set forth below.<sup>2</sup>

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<sup>1</sup> Issued May 17, 2005; opposer filed a combined Sections 8 and 15 declaration on November 11, 2010.

<sup>2</sup> Issued May 24, 2005; opposer filed a combined Sections 8 and 15 declaration on November 11, 2010.

Automotive paint, namely, aerosol spray paint; paint-related products, namely, automotive finishing coatings in the nature of clear coats, primers, surfacers, reducers, hardeners, activators, and paint thinners, in Class 2.

Applicant denied the salient allegations in the notice of opposition.

#### Preliminary Issue

On March 12, 2009, approximately one month after the close of discovery and before the opening of opposer's testimony period, applicant filed a motion to amend the description of goods in its application to "paint sprayers for use by professional painters and professional contractors in applying architectural coatings." Before opposer responded to applicant's motion, the Board deferred action on the motion until final decision.<sup>3</sup> In its brief on the case, applicant requested "that the decision in this matter be made pursuant to the amended description."<sup>4</sup> In its reply brief, opposer objected to the motion and argued that the motion to amend the description of goods should be denied as untimely because opposer conducted its discovery based on the unrestricted description of goods.<sup>5</sup>

An application which is the subject of an opposition may not be amended except with the consent of the opposer and the approval of the Board or except upon a motion

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<sup>3</sup> March 13, 2009 Order.

<sup>4</sup> Applicant's Brief, p. 10.

<sup>5</sup> Opposer's Reply Brief, pp. 7-8.

granted by the Board. Trademark Rule 2.133(a). "When a motion to amend an application or registration in substance is made without the consent of the other party or parties, it ordinarily should be made prior to trial, in order to give the other party or parties fair notice thereof." TBMP § 514.03 (2<sup>nd</sup> ed. rev. 2004). "The Board, in its discretion, may grant a motion to amend an application or registration which is the subject of an inter partes proceeding, even if the other party or parties do not consent thereto." *Id.*; see also *International Harvester Company v. International Telephone and Telegraph Corporation*, 208 USPQ 940, 941 (TTAB 1980) (Board permitted an amendment to the description of goods made prior to trial over the objection of opposer where applicant accepted judgment with respect to the broader description of goods).

Because applicant requested that we decide this case based on the proposed amended description of goods, we find that applicant has agreed to entry of judgment against applicant with respect to the unrestricted or original description of goods.

Because applicant's motion to amend its description of goods was filed before trial, we find that it was timely filed. Also, we find that opposer will not be prejudiced by the amendment because in response to opposer's interrogatory No. 6, applicant explained that it intended to use its

FINISHPRO mark to identify "HVLP and air-assisted airless sprayers for use by professional painters and professional contractors in applying architectural coatings."<sup>6</sup>

In support of its opposition to applicant's motion to amend its description of goods, opposer relies on *Coty US Inc. and Coty Cosmetics Inc. v. Frontier Cooperative Herbs*, Opposition No. 91105867 (TTAB 1996) (nonprecedential) "where an applicant, on the day discovery closed, filed a motion to amend its description of goods" that the Board held to be untimely.<sup>7</sup>

There, the opposers argued "that they relied on the published description of goods during discovery and conducted discovery on that basis ... they would have asked different discovery questions if applicant's goods had been identified differently." The Board agreed with opposers, that "applicant's motion to amend, coming on the last day of discovery was untimely ... [because] the motion was filed at a time that precluded opposers from conducting further discovery ... the proposed description may have been a significant factor in the way opposers may have framed discovery."<sup>8</sup>

We do not find *Coty* persuasive. First, by failing to designate the *Coty* decision as precedential, the Board has in effect declared that the *Coty* decision has no value as legal precedent. Nevertheless, the facts in this proceeding

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<sup>6</sup> Opposer's First Notice of Reliance. "HVLP" means "high velocity low pressure."

<sup>7</sup> Opposer's Reply Brief, p. 7.

<sup>8</sup> *Id.*

can be distinguished from those in *Coty*. As indicated above, during discovery, applicant readily explained to opposer that it intended to sell its products to professional painters and contractors for use in connection with architectural coatings, whereas in *Coty* there is no indication that applicant informed opposers that its massage and essential oil products were for use in connection with aromatherapy. In fact, it appears that applicant had "sandbagged" opposers because, during discovery, opposers objected to questions applicant asked of witnesses concerning aromatherapy products unaware that applicant intended to restrict its massage and personal oils to use in connection with aromatherapy. There is no such maneuvering by applicant in this case.

In view of the foregoing, applicant's motion to amend its description of goods is granted, we enter judgment against applicant on the original description of goods, and we will determine the issue of likelihood of confusion based on the amended description of goods.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b).

A. Opposer's testimony and evidence.

1. First notice of reliance on the following items:

- a. Copies of opposer's pleaded registrations prepared by the USPTO showing the current status of and title to the registrations;
- b. Applicant's responses to opposer's first set of interrogatories, including a copy of applicant's website attached as part of applicant's answer to interrogatory No. 5; and
- c. Applicant's responses to opposer's request for admissions;

2. Testimony deposition of Andrew A. Keim, opposer's president, with attached exhibits; and

3. The declaration of Andrew Keim, with attached exhibits, filed during opposer's rebuttal testimony period pursuant to a stipulation by the parties.

B. Applicant's testimony and evidence.

Applicant submitted the testimony deposition of Kate Grathwohl, applicant's Product Marketing Manager, with attached exhibits.

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc.*

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*v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189  
(CCPA 1982).

#### Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the goods covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

#### Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also*, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See 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. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988).

Opposer's marks are FINISH PRO, in standard character form, and FINISH PRO and design shown below.



Applicant's mark is FINISHPRO, in standard character form.

The marks are essentially the same. Applicant's mark FINISHPRO is simply a compressed version of opposer's mark FINISH PRO without a space between the two words. Without the space, FINISHPRO is equivalent in sound, meaning and commercial impression to FINISH PRO. See *In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007) (THEATL is similar to THE ATL); *Goodyear Tire & Rubber Company v. Dayco Corporation*, 201 USPQ 485, 488 (TTAB 1978) (FAST-

FINDER is legally identical to FASTFINDER). With respect to opposer's FINISH PRO and design mark, the words form the dominant element of the mark because it is the words that consumers will recall and use when referring to the products. *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Thus, opposer's composite mark is also similar to applicant's mark.

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

In analyzing the similarity or dissimilarity of the goods, the greater the degree of similarity between the applicant's mark and opposer's marks, the lesser the degree of similarity between the goods is required to support a finding of likelihood of confusion. *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 110, 1110 (TTAB 2007); *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203, 1207 (TTAB 2006), *aff'd unpublished*, Nos. 2006-1366 and 2006-1367 (Fed. Cir. 2006); *see also In re Shell Oil Co.*, 992 F.2d 1024, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) (even when goods are not intrinsically related, the use of identical marks can lead to the assumption that there is a common source). When virtually identical marks are involved, there only needs to be a viable relationship between the respective goods to find that a likelihood of

confusion exists. *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

Applicant is seeking to register the mark in connection with "paint sprayers for use by professional painters and professional contractors in applying architectural coatings." Opposer's marks have been registered for automotive paints and coatings and painting products accessories for automotive, industrial and marine use.

Applicant does not define "architectural coatings." Kate Grathwohl, applicant's Product Marketing Manager, testified as follows:

Q. [W]hat are those contractors painting?

A. [T]hey are painting your trims, your window frames, cabinets, mantles, anything that takes your architectural coating, you know, your fine finish coatings that are on the job for, you know, a house or a (sic) apartment complex or commercial building.<sup>9</sup>

She later testified that the paint sprayers were designed for woodwork.<sup>10</sup> Based on this scant record, it appears that architectural coatings are paints and finishes used in homes and buildings.

Despite the facts that applicant has restricted its paint sprayers to use in connection with "architectural

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<sup>9</sup> Grathwohl Dep., p. 9.

<sup>10</sup> *Id.* at 38.

coatings" and that opposer's products are used in the automotive, industrial and marine fields, there is evidence in the record that demonstrates that the restricted description of goods will not avoid a likelihood of confusion because applicant's paint sprayers may be used for automotive applications and presumably marine and industrial applications.

In applicant's "Fine Finish Solutions" brochure at page 3, there is a table displaying the features of the FINISHPRO paint sprayers.<sup>11</sup> The "FinishPro HVLP Sprayers" have "automotive quality" "finish quality." On the other hand, the "typical applications" listed do not include automotive, industrial or marine applications.

Page 9 of the brochure lists "Accessories for FinishPro HVLP." There is a needle for the spray gun applicator identified for use with "automotive finishes" (Part No. 256946, Needle #2). In addition, applicant sells an automotive air filter for its sprayer (Part No. 240273).

Opposer introduced applicant's manual for the HVLP EDGE Gun, an applicator used in connection with paint sprayers, including the FINISHPRO sprayer. The manual prominently states that the gun is "For the application of architectural paints and coatings."<sup>12</sup> The "Material/Fluid Set Selection

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<sup>11</sup> Grathwohl Dep., Exhibit 1.

<sup>12</sup> Keim Dec., Exhibit 3. The HVLP EDGE Gun is also advertised in the Fine Finish Solutions brochure referenced above.

Guide" provides settings for automotive and industrial finishes. While the EDGE spray gun is not the same as the FINISHPRO sprayer, the manual demonstrates that applicant's sprayers and guns may be used for automotive and industrial applications. In this regard, the excerpt about the FUJI spray gun at *fuji.com* promotes that product for use in connection with architectural coatings and with "Auto Refinishers."<sup>13</sup>

To further demonstrate the relationship between spray guns and opposer's products, we note that opposer's automotive paints, coatings and finishes are advertised as "RTS" or "Ready To Spray" and opposer's brochures display its products in connection with spray gun applications.<sup>14</sup> There are photographs of using spray guns in connection with automobiles. Mr. Keim, opposer's President, testified that opposer's paints, solvents, and primers are applied by spray painting.<sup>15</sup>

Finally, opposer introduced excerpts from four third-party websites purportedly to demonstrate that the products of the parties move in the same channels of trade. However, what we found was that there are no manufacturers of paint sprayers and accessories manufacturing paint, coatings, finishes and related accessories and vice versa.

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<sup>13</sup> Keim Dec., Exhibit 4.

<sup>14</sup> Keim Dep., Exhibits 21-23

<sup>15</sup> Keim Dep., p. 28.

Because paint sprayers may be used for both architectural applications as well as automotive applications, and because opposer's products may be used in paint spraying applications, we find that applicant's products and opposer's products are complementary products. Accordingly, we find that because of the similarity of the marks, the products of the parties may be sold under circumstances likely to give rise to the mistaken belief that they emanate from the same source.

C. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

The cost of applicant's paint sprayers range from \$1,200 to \$2,100 depending on the model.<sup>16</sup> Moreover, we do not have any doubt that purchasers of applicant's paint sprayers and opposer's automotive, industrial and marine paints, finishes and coatings will exercise a high degree of care in making their purchasing decisions. However, even professional painting contractors exercising a high degree of care are not immune to trademark confusion. Thus, although this factor favors a finding of no likelihood of confusion, given the fact that very similar marks are used in connection with complementary products, the record in this case is not sufficient to show that the degree of care

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<sup>16</sup> Grathwohl Dep., pp. 8, 10, and 12.

exercised by relevant consumers is sufficient to outweigh the other factors.

D. Balancing the factors.

In view of the facts that the marks of the parties are very similar, the goods are related, may move in the same channels of trade and may be sold to the same classes of consumers, we find that applicant's mark FINISHPRO for "paint sprayers for use by professional painters and professional contractors in applying architectural coatings" is likely to cause confusion with opposer's FINISH PRO marks.

Decision: The opposition is sustained and registration to applicant is refused.