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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91247343
Party	Defendant Zhejiang Rongpeng Air Tools Co., Ltd.
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Attachments	AEROPRO Applicants Trial Brief.pdf(1047891 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Graco Minnesota Inc.,	)	Opposition No. 91247343
	)	Serial No. 87/645,709
Opposer,	)	Mark: AEROPRO
	)	
v.	)	
	)	
Zhejiang Rongpeng Air Tools Co., Ltd.,	)	
	)	
	)	
Applicant.	)	
	)	
	)	
	)	

APPLICANT'S TRIAL BRIEF

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I. INTRODUCTION

Opposer, Graco Minnesota Inc. ("Opposer") has opposed Applicant Zhejiang Rongpeng Air Tools Co., Ltd.'s ("Applicant") Trademark Application Ser. No. 87/645,709 for the mark AEROPRO (the "AEROPRO Mark") covering, in relevant part, "painting machines" in International Class 7 on the ground of priority and likelihood of confusion with Opposer's pleaded mark AIRPRO (the "AIRPRO Mark") for "paint spray guns, air spray guns, manual air spray guns, and automatic air spray guns." Notice of Opposition, 1 TTABVUE. Opposer has pleaded Reg. No. 4,009,655 for the mark AIR PRO covering "paint spray guns" in International Class 7. *Id.* Applicant disagrees and submits the marks AEROPRO and AIRPRO are sufficiently dissimilar such that there is no likelihood of confusion. This is especially true because AIRPRO is a suggestive, weak mark referring to "*air*" spray guns for paint which are of a "*pro*fessional" quality.

During discovery, the Board granted Opposer's motion to add a second claim of "non-use" alleging Applicant "has never used the Claimed AEROPRO mark in United States commerce." 23 TTABVUE 8. This claim is meritless because Applicant advertised and distributed its AEROPRO painting machines at the 2017 SEMA trade show in Las Vegas, Nevada, before filing the application. Opposer never took the depositions of Applicant's witnesses and did not bother to cross examine Li Xiaorong, Applicant's General Manager, who testified at length about Applicant's use of the AEROPRO mark in the U.S. *See* Declaration of Li Xiaorong ("Xiaorong Decl."), 42 TTABVUE. Accordingly, the Notice of Opposition should be dismissed with prejudice in its entirety.

II. STATEMENT OF THE ISSUES

(1) Whether Opposer has met its burden of proving, by a preponderance of the evidence, that Applicant's AEROPRO Mark for "painting machines" so resembles Opposer's

pleaded AIRPRO trademark for "paint spray guns," as to be likely to cause confusion; and

(2) whether Opposer's "non-use" claim should be dismissed in view of Applicant's advertising and distribution of AEROPRO painting machines at the 2017 SEMA trade show in Las Vegas before the filing date of the application.

III. DESCRIPTION OF THE RECORD

- Applicant has made of record the Trial Declaration of Li Xiaorong, General Manager of Applicant Zhejiang Rongpeng Air Tools Co., Ltd. and supporting exhibits.
- Opposer has made of record several Notices of Reliance and the Trial Declarations of Kyle Liudahl and Wendy Hartley, two employees of Opposer Graco Minnesota Inc., and Molly R. Litman, an attorney for Opposer.

IV. STATEMENT OF FACTS

A. Applicant and its AEROPRO Mark

Applicant is a producer of high-quality air-powered tools based in China. Declaration of Li Xiaorong, 42 TTABVUE ¶ 3. Applicant produces various air-powered and pneumatic tools including, in relevant part, air-powered *painting machines* under its AEROPRO Mark. *Id.* The AEROPRO painting machines are typically used for home improvement projects and indoor and outdoor painting – for example, to paint decks, walls, fences, small houses, and automobiles. *Id.*, Photographs of Applicant's AEROPRO painting machines are shown as follows:

AEROPRO
AIRLESS PAINT SPRAYER

Id., Ex. A.

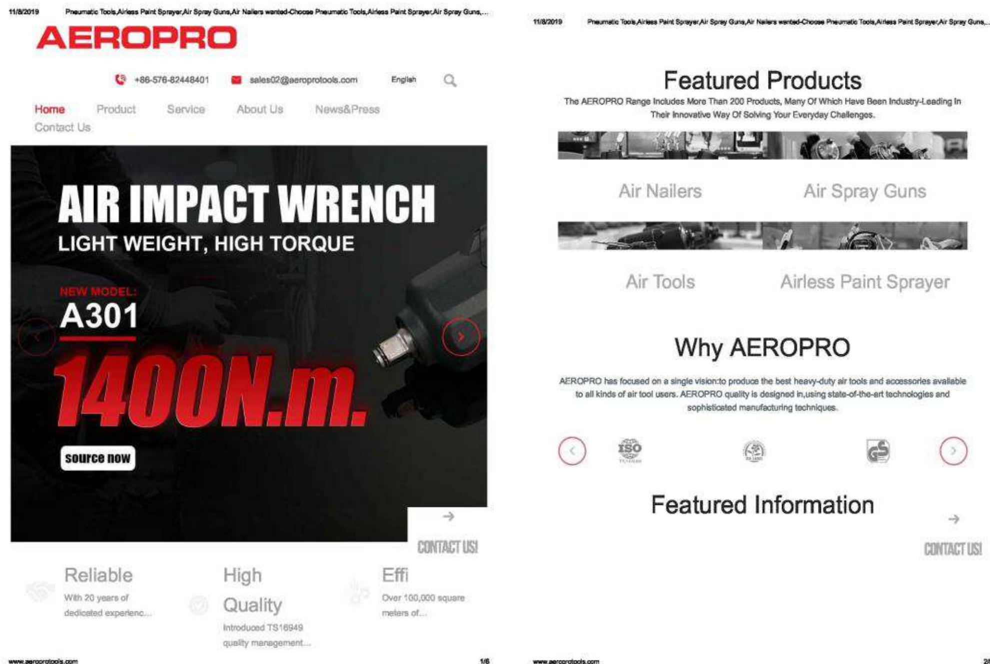
AEROPRO is a unique, fanciful term coined by the Applicant. *Id.*, ¶ 4. It is a combination of AERO-, which means "of or relating to aircraft or aeronautics," and -PRO, which is short for "professional." *Id.*, Ex B. (dictionary definitions for AERO and PRO). The first word AERO- is arbitrary and inherently distinctive when applied to painting machines, as these goods have nothing to do with "aircraft or aeronautics." *Id.* The second word -PRO is suggestive of "professional." *Id.* When considered as a whole, AEROPRO is an arbitrary and unique term coined by the Applicant. *Id.* It is an inherently distinctive and strong mark, and consumers will immediately distinguish the AEROPRO painting machines from the goods of others – especially owing to the first and dominant word AERO – which is unique, arbitrary, and memorable when applied to painting machines. *Id.* AEROPRO also has a highly distinctive sound: consumers will pronounce the mark as "ARROW PRO" in three syllables. *Id.*

Applicant has advertised its AEROPRO painting machines at trade shows in the United States for many years. *Id.*, ¶ 5. Below are photographs of Applicant's booth at the SEMA (Specialty Equipment Market Association) automotive industry trade show in Las Vegas, Nevada, in 2017 showing with some of Applicant's sales representatives and customers with the AEROPRO painting machines:

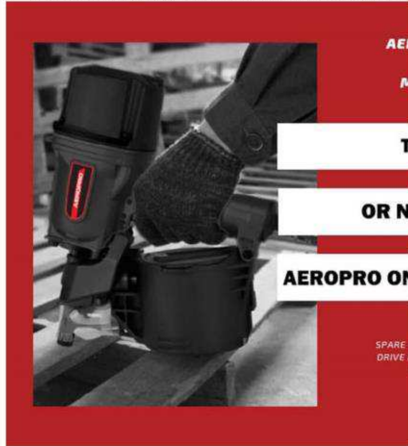
Id., Ex. C.

Applicant has advertised and distributed free samples of its AEROPRO painting machines directly to its customers at the SEMA trade shows in the United States. *Id.*, ¶ 6. For example, Applicant participated in and advertised its AEROPRO painting machines at the SEMA show in Las Vegas from November 5-8, 2013. *Id.* Applicant again attended the SEMA Show in Las Vegas from October 31, 2017 to November 3, 2017 and promoted the AEROPRO goods at its booth number 12925. *Id.* Applicant distributed free samples of its AEROPRO painting machines to its customers at the 2017 SEMA show. *Id.* No money was charged for the samples, but the goods were distributed to customers within the United States at this trade show. *Id.*

Applicant has also advertised its AEROPRO mark in the United States through its website at *www.aeroprotools.com*, which was first uploaded sometime around 2012. *Id.*, ¶ 7. Shown below are Internet screenshots taken from Applicant's website in 2019 showing its AEROPRO painting machines:



11/8/2019 Pneumatic Tools,Airless Paint Sprayer,Air Spray Guns,Air Nailers wanted-Choose Pneumatic Tools,Airless Paint Sprayer,Air Spray Guns,...



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With more than 20 years of hard work from our management team and dedicated staff, our company has reached the highest standard in Manufacturing, Exporting, Scientific and Technological Development of several grades of air tools from standard level, mid level as well as high level tools in China.

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Id., Ex. D.

Applicant also distributes AEROPRO catalogs featuring its painting machines, and it distributed AEROPRO catalogs to U.S. customers within the United States at the 2017 SEMA

show. *Id.*, ¶ 8. Below are excerpts of Applicant's 2016-2019 product catalogs featuring its AEROPRO painting machines, among other goods. The cover pages of the catalogs are shown as follows:

Id., Ex. E.

In an effort to secure federal protection for its AEROPRO Mark, on October 14, 2017, Applicant filed U.S. Trademark Application Serial No. 87/645,709 for the mark AEROPRO, opposed herein, based on its use of the mark in commerce for the following goods in International Class 7, as amended and published for opposition:

> <u>International Class 7</u>
>
> Coffee grinders, other than hand-operated; Compressed air machines; Electric hand-held drills; Electric nail extractors; Fertilizer distributing machines, other than hand-operated implements; Glue guns, electric; Lifting jacks other than hand-operated; Machine tools for forming, riveting, swaging, and flaring of metal and plastics; Mufflers for motors and engines; Painting machines; Pumps for machines; Rivet guns; Vacuum pumps

Id., ¶ 9.

B. Opposer and its Pleaded AIRPRO Mark

Opposer commenced this opposition asserting a claim of priority and likelihood of confusion based on its pleaded AIRPRO mark for air-powered paint spray guns, including Reg. No. 4,009,655 covering "paint spray guns" in International Class 7. 1 TTABVUE. Opposer alleges Applicant's AEROPRO Mark for "painting machines" is likely to cause confusion with its pleaded AIRPRO mark for paint spray guns. Applicant disagrees.

Opposer's mark AIRPRO is suggestive "***air***" spray guns for paint of a "***pro***fessional" quality. Opposer itself admits "[t]he commercial impression of Graco's AIRPRO Mark is that it *suggests* the origin of professional manual air spray guns." Opposer's Trial Brief at p. 15 (emphasis added). As such, AIRPRO is a suggestive and conceptually weak mark, and therefore it is entitled to a narrow scope of protection.

Opposer also claims Applicant "has never used the Claimed AEROPRO mark in United States commerce." 23 TTABVUE 8. This second claim is meritless because Applicant advertised and distributed samples of AEROPRO painting machines to its customers within the United States before filing the application, which constitutes use of the mark in commerce. *Id.*, ¶¶ 5-8 (trade show photos, catalogs, distribution of samples to customers at 2017 trade show within the U.S.). Accordingly, the Notice of Opposition should be dismissed with prejudice in its entirety.

V. ARGUMENT

Opposer's AIRPRO mark is highly suggestive of a "professional" grade "air" spray gun for paint, and it is therefore weak and entitled to a narrow scope of protection. In view of the weakness of the mark, AEROPRO and AIRPRO are sufficiently dissimilar such that there is no likelihood of confusion. Furthermore, Applicant advertised and distributed AEROPRO painting machines in the U.S. prior to filing the application, which constitutes use in commerce. Therefore,

Opposer's claims of priority and likelihood of confusion and "non-use" should be dismissed with prejudice.

A. Motion to Amend

As an initial matter, to eliminate discovery disputes and simplify the issues for trial - and to save the time and resources of the parties and the Board - on February 19, 2020, Applicant requested leave to amend the AEROPRO application to remove all goods except "painting machines." 19 TTABVUE 7. The Board deferred the motion to amend until final decision. 20 TTABVUE 3. **Applicant seeks registration of AEROPRO only for "painting machines".** The motion should be granted and all other items in the application should be removed. As such, only Applicant's "painting machines" are relevant and no other goods should be considered.

B. Opposer's Procedural Objections are Waived as Untimely

Opposer has attached an "appendix" to its brief containing objections to certain photographs of Applicant's goods and its representatives posing with customers at a 2017 SEMA trade show in Las Vegas (Exs. A and C to the Declaration of Li Xiaorong):

Opposer's Trial Brief, 45 TTABVUE 38-39. Opposer objects purely on procedural grounds, including "relevance" and "lack of foundation." *Id.* The photos showing Applicant's AEROPRO goods at a Las Vegas trade show and representatives posing with customers are clearly relevant to the case. Li Xiaorong was also present at the trade show and gave testimony properly laying the foundation for the photographs.

Moreover, these objections, raised for the ***first time*** in Opposer's trial brief, are purely procedural in nature, and Applicant could have cured any perceived deficiencies in the "foundation" had the objections been raised earlier in the proceeding. These objections are therefore **waived** as untimely and may not be considered.

"As a general rule, [procedural] objections that are curable must be seasonably raised, or they will be deemed waived." *See Moke America LLC v. Moke USA, LLC, 2020 USPQ2d 10400*, at *3-9 (TTAB 2020) ("Applicant waived its objection to the admissibility of the Mini Mania sales records because Applicant failed to assert its objection promptly after Opposer introduced the Todd Rome declaration into evidence"; also discussing curable vs. noncurable objections to testimony and exhibits, including lack of personal knowledge and lack of foundation); *Nahshin v. Prod. Source Int'l, LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 707.03(a) (2019) ("Objections

to trial testimony are not waived for failure to make them during or before the taking of the deposition, provided that the ground for objection is not one that might have been obviated or removed if presented at that time.”).

Here, Xi Liaoraong testified that Applicant advertised and distributed AEROPRO painting machines to its customers at trade shows in Las Vegas before filing the application, which constitutes use of the mark in commerce. *Id.*, ¶¶ 5-8 (trade show photos, catalogs, distribution of samples to customers at 2017 trade show within the U.S.). The photographs are vivid images of Applicant’s use of AEROPRO in commerce, buttressed by the 2016-2019 AEROPRO product catalogs and AEROPRO website (launched around 2012) promoting the mark within the United States.

Even if Opposer’s objections could be considered seasonably raised, Applicant could have cured the objections by supplementing with testimony that Li Xiaorong was physically present at the SEMA trade show when the photos were taken; that Li Xiaorong personally knows the individuals shown in the photos and attended the trade show together with them for the purpose of promoting AEROPRO products and distributing samples to customers; and that the photos show exactly what is described in the testimony, i.e., promotion of AEROPRO painting machines at the 2017 SEMA show.

Notably, Opposer inexplicably failed to object (or even challenge the testimony) through any of the following permissible means:

- Opposer could have taken the oral deposition of Li Xiaorong;
- Opposer could have taken Li Xiaorong’s deposition upon written questions;
- Opposer could have served written discovery inquiring about the photographs;
- Opposer could have cross-examined Li Xiaorong’s trial testimony;

- Opposer could have filed the objections during its testimony or rebuttal testimony periods;
- Opposer could have moved to strike the evidence if it had any good faith reason to question what is shown in the photographs, i.e., promotion of AEROPRO painting machines at the SEMA show in Las Vegas.

At any of these opportunities to object, Applicant would have cured the procedural objections with additional testimony. Had Opposer objected even as late as the rebuttal testimony period, Applicant could have moved to reopen its testimony period to cure the objections. **By waiting to object until after trial, Opposer has waived these procedural objections.** "Surprise" procedural objections after trial are not allowed when they could have been resolved via formalities earlier during the discovery or testimony periods. Opposer's procedural objections are therefore untimely and should be overruled.

Even if the Board sustains procedural objections to the photographs, none of them are material. Li Xiaorong has given <u>uncontradicted</u> testimony regarding the advertising and distribution of AEROPRO painting machines in the United States. Opposer has made the strategic choice not to depose or cross examine the witness. Therefore, the objections are immaterial and should not affect the Board's final decision.

C. <u>There is No Likelihood of Confusion Between AEROPRO and AIRPRO</u>

1. <u>Legal Standard for Likelihood of Confusion</u>

Turning to Opposer's first claim, the marks AEROPRO and AIRPRO are not likely to cause confusion. This is especially true considering AIRPRO is a suggestive and weak mark which refers to an "air" spray gun for paint of "professional" quality.

In determining likelihood of confusion, the Board should consider evidence relating to the

thirteen factors set forth in *In re E.I. DuPont DeNemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). The Board need not consider each and every DuPont factor. *Han Beauty, Inc. v. Alberto Culver Co.*, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). Rather, the Board is required to consider only those factors that are most relevant to a particular case and any one of the factors may be controlling. *In re Dixie Rests., Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *see also*, *In re E.I. DuPont DeNemours & Co.*, 177 USPQ 563, 567 (CCPA 1973) ("[E]ach [of the thirteen factors] may from case to case play a dominant role"). Here, the most relevant factors here, all of which weigh against a likelihood of confusion, are: (1) the conceptual weakness of Opposer's mark; (2) the dissimilarities between the parties' marks in overall appearance, sound, meaning, and commercial impression; and (3) the differences between the goods.

2. <u>Opposer's AIRPRO Mark is Suggestive and Weak</u>

Before comparing the marks for dissimilarities, Opposer's AIRPRO mark should be evaluated for conceptual weakness. The inherent strength or weakness of a mark is assessed based on the nature of the mark itself. *New Era Cap. Co. v. Pro Era LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011).

"The cases are legion that 'where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks." *Terry Nazon, d/b/a Terry Nazon Inc. v. Charlotte Ghiorse*, 119 USPQ2d 1178 (TTAB 2016) (precedential) (finding SEXSTROLOGY astrological horoscopes "highly suggestive") citing *Sure-Fit Prods. Co. v. Saltzson Co.*, 254 F.2d 158, 117 USPQ 295,297 (CCPA 1958); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109-10 (CCPA 1974) ("The expressions 'weak' and 'entitled to limited protection' are but other ways of saying . . . that

confusion is unlikely because the marks are of such non-arbitrary nature or so widely used that the public easily distinguishes slight differences in the marks under consideration . . . ."); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1478 (TTAB 2014).

Suggestive marks are considered weak and therefore entitled to a narrow scope of protection. *In re Hunke and Jochheim,* 185 USPQ 188, 189 (TTAB 1975)("[I]t is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as "weak" marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods").

Here, AIRPRO is a highly suggestive mark which refers to "air" powered paint spray guns of "professional" quality. Merriam-Webster dictionary (merriam-webster.com) defines the word "air" as meaning "the mixture of invisible odorless tasteless gases (such as nitrogen and oxygen) that surrounds the earth." Xiaorong Decl., Ex. F. More simply, this word refers to the "air" we breath. In the context of Opposer's "paint spray guns", the word AIR is merely descriptive - or at best suggestive - of a paint spray gun powered by compressed air. Consumers will immediately understand that AIR in AIRPRO describes *air-powered* paint spray guns, and therefore they are not likely to attribute any source identifying significance to the first word AIR in AIRPRO. As a descriptive and therefore weak term, "AIR" should be afforded a narrow scope of protection.

"PRO" is a noun or adjective which means "professional." *Id.*, Ex. B (dictionary definition). The combination AIRPRO is therefore suggestive of an "air" powered paint spray gun of "professional" quality. AIRPRO is therefore highly suggestive at best and should be considered a weak mark. As a highly suggestive mark, the scope of protection afforded to AIRPRO should be

restricted. *See Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557 (TTAB 2022) (precedential) ("MADE IN NATURE found highly suggestive because it "bring[s] to mind a quality of the goods for which the marks are registered – all natural without added man-made ingredients"); *See Am. Lebanese Syrian Assoc. Charities, Inc. v. Child Health Rsch. Inst.*, 101 USPQ2d 1022, 1029 (TTAB 2011) ("Cure4Kids" when used in connection with "medical and scientific research in the field of children's health" and "fund raising in support of funding research into cures for childhood diseases" is highly suggestive because it describes the purpose of the fund raising and medical research (i.e., to cure children)).

Opposer argues its AIRPRO mark is commercially strong, citing a high volume of sales. Applicant does not dispute Opposer's sales, but the sales evidence must be viewed in context. A mere high volume of sales does not transform AIRPRO from a weak, suggestive designation into a strong mark. There is no survey evidence, consumer or dealer testimony, or other evidence to put the sales numbers in context such that consumers would perceive AIRPRO as anything other than a suggestive term composed of two common words "air" and "pro." Opposer itself admits "[t]he commercial impression of Graco's AIRPRO Mark is that it *suggests* the origin of professional manual air spray guns. Opposer's Trial Brief at p. 15 (emphasis added). As such, AIRPRO should be deemed highly suggestive and entitled to a narrow scope of protection.

3. The Marks are Not Similar

When the scope of protection afforded to the suggestive mark AIRPRO is properly restricted, AEROPRO and AIRPRO are dissimilar in appearance, sound, connotation, and overall commercial impression such that confusion is not likely. The Federal Circuit and the Board have consistently held that one *DuPont* factor may be dispositive in the likelihood-of-confusion analysis, especially when that single factor is the dissimilarity of the marks. *See Champagne Louis*

Roederer S.A. v. Delicato Vinyards, 47 USPQ2d 1459, 1461 (Fed. Cir. 1998) (sustaining the Board's holding of no likelihood of confusion between CRYSTAL CREEK for wine and CRISTAL for champagne based on dissimilarities between marks); *Kellogg Co. v. Pack'em Enterprises*, 951 F.2d 330, 332-33 (Fed. Cir. 1991) (affirming the Board's holding of no likelihood of confusion between the marks FROOT LOOPS and FROOTIE ICE and elephant design based on the differences between the marks alone); *Keebler Co. v. Murray Bakery Prods.*, 9 USPQ2d 1736, 1739-40 (Fed.Cir. 1989) (sustaining finding of no likelihood of confusion between PECAN SANDIES and PECAN SHORTIES marks based only on dissimilarity-of-marks factor).

a. The Marks are Different in Meaning and Commercial Impression

First, the marks AEROPRO and AIRPRO are completely different in meaning and connotation when applied to the goods at issue. The meanings and commercial impressions of the marks are different when they are properly analyzed in the context of their respective goods. *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term CROSS-OVER was suggestive of the construction of applicant's bras, whereas CROSSOVER, as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear ... or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term PLAYERS implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and

children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear).

Here, Applicant's Mark AEROPRO is suggestive of aerospace or aerodynamics, conjuring images of a fast-moving airplane or spaceship. *See* Xiaorong Decl., Ex. B ("AERO" means "of or relating to aircraft or aeronautics"). Applied to painting machines, AEROPRO suggests the goods can paint "fast" with the aerodynamic precision of an airplane or spaceship. AERO- also has a scientific connotation inasmuch as it refers to aeronautics.

Opposer argues "aero" means "air, gas" but this is incorrect. Both dictionary definitions of record give the primary definition of "aero" as "of or relating to aircraft or aeronautics" (Merriam-Webster) and "of or for aircraft" and "of or relating to aeronautics" (Dictionary.com). Opposer's own dictionary evidence confirms AERO refers to "aerodynamics" and "aeronautics" and 37 TTABVUE 185-188, 192-193 (Cambridge dictionary, Macmillan). The Board should consider the *primary* definition of AERO as shown in the evidence of record.

On the other hand, Opposer's AIRPRO is descriptive or suggestive of a "professional" grade "air" powered paint spray gun. Opposer admits this. Opposer's Trial Brief at p. 15. The marks therefore have completely different connotations in the context of the goods – "*aerodynamics"* or "*aeronautics*" on one hand, and "*air"-powered "professional" paint sprayers*, on the other. Thus, the marks are highly dissimilar in meaning and commercial impression.

b. The Marks are Different in Sound

The marks are also different in sound, with Applicant's Mark AEROPRO having three syllables pronounced as "**ARROW PRO**" and Opposer's mark AIRPRO comprised of two, short syllables pronounced as "**ERR (as in "error") -PRO**." The dominant terms AERO- and AIR-

will also be heard *first*. Therefore, consumers will pronounce the marks differently. Even if the marks are found to be similar in sound – and they are not – similarity in sound alone is generally insufficient for a finding of a likelihood of confusion. “When marks are only similar in sound, we proceed a little more cautiously before determining that there is a likelihood of confusion.” *See Standard Brands Inc. v. Eastern Shore Canning Co.*, 172 F.2d 144, 80 USPQ 318, 321 (4th Cir. 1949), cert. denied, 337 U.S. 925 (1949) (V-8 and VA found not confusingly similar; “the phonetic similarity of the two marks cannot prevail, even if it is supposed … that the defendant’s goods are asked for as VA rather than as Virginia tomato juice or lima beans”); *Crown Radio Corp. v. Soundscriber Corp.*, 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974) (“As we stated in *General Electric Company Limited v. Jenaer Glaswerk Shott & Gen*, 52 CCPA 954, 341 F.2d 152, 144 USPQ 427 (1965), confusing similarity cannot be predicated on auditory response alone and one must consider the impression on the mind where stimuli of the auditory nerve are registered”). Therefore, the marks at issue are dissimilar in sound.

c. The Marks Are Different in Appearance

Last, the marks are dissimilar in appearance. Applicant’s Mark begins with AERO- which looks nothing like AIR-. The spellings of these words are almost completely dissimilar with most of the letters (“-IR” and “-ERO”) being different. Furthermore, consumers will focus on the *first* and *dominant* portions AERO- and AIR- and distinguish source on this basis. It is well established that “consumers are generally more inclined to focus on the *first* word, prefix or syllable in any trademark or service mark.” *See Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered”); *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“veuve” is the most prominent part of the

mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *In re Detroit Athletic Co.*, 903 F3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) ("the identity of the marks' two initial words is particularly significant because consumers typically notice those words first").

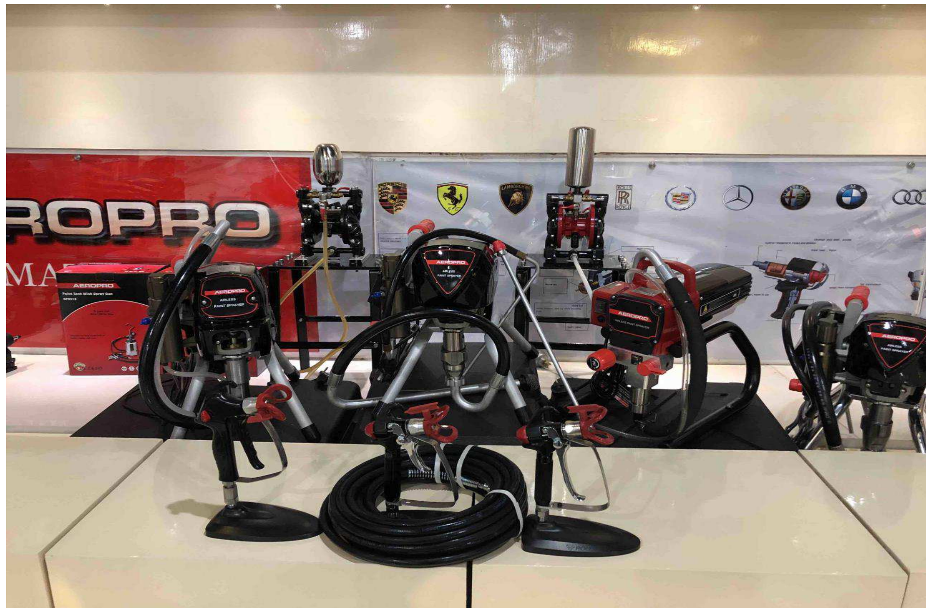
Therefore, the <u>first</u> and <u>dominant</u> term AERO significantly changes the marks in appearance. *See* TMEP §1207.01(b)(iii) (the addition or deletion of other matter in the marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions); *see Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although Opposer's and Applicant's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *See*, *e.g.*, *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric

store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

Overall, when the scope of protection afforded to the suggestive designation "AIRPRO" is properly restricted, the marks are highly dissimilar in appearance, sound, meaning, and commercial impression. This first and most important *DuPont* factor weighs heavily against a finding of a likelihood of confusion.

4. <u>The Goods are Not the Same</u>

Although Applicant's painting machines are used for painting, they are quite different from Opposer's paint spray guns. Applicant's painting machines are large contraptions including multiple interconnecting parts for providing air compression and precision application of paint to surfaces, shown as follows:



In contrast, Opposer's AIRPRO goods are small paint spray guns which are not the same as Applicant's larger AEROPRO apparatus:

There is no evidence in the record suggesting consumers would confuse Applicant's AEROPRO painting machines with Opposer's AIRPRO paint spray guns, especially where, as here, the mark AIRPRO is suggestive and weak, and AEROPRO and AIRPRO are highly dissimilar and the goods have significant differences in size, appearance, and function.

D. <u>Opposer's "Nonuse" Claim Fails</u>

For its second claim, Opposer argues "Applicant has never used, and certainly at the time of filing had never used, the AEROPRO mark in connection with any of the goods" in the application. Opposer's Trial Brief at p. 35. This allegation is false and contrary to the evidence in the record.

In addition to launching its AEROPRO website in 2012 and distributing its 2016-2019 catalogs in the U.S., Applicant has introduced photographs of its AEROPRO products, as well as photos of its representatives and customers at the 2017 SEMA show in Las Vegas. Applicant's General Manager Li Xiaorong also provided uncontradicted testimony that Applicant distributed painting machines to customers at the show:

> Applicant has advertised **<u>and distributed</u>** free samples of its AEROPRO painting machines directly to its customers at the SEMA trade shows in the United States. For example, Applicant

> participated in and advertised its AEROPRO painting machines at the SEMA show in Las Vegas from November 5-8, 2013. Applicant again attended the SEMA Show in Las Vegas from October 31, 2017 to November 3, 2017 and promoted the AEROPRO goods at its booth number 12925. **Applicant distributed free samples of its AEROPRO painting machines to its customers at the 2017 SEMA show**. No money was charged for the samples, but the goods were distributed to customers within the United States at this trade show.

Xiaorong Decl., ¶ 6 (emphasis added). Opposer dubiously questions the "relevance" of the photographs and argues Applicant has not provided sufficient details, such as the names of the customers or quantity of goods distributed.[1] Opposer argues there were "no sales" of AEROPRO products at the trade show, relying on the Board's ***non-precedential*** decision in *The Pep Boys Manny, Moe & Jack of Cal. v. Teera Hanharutaivan, et al.*, Opp. No. 91105133, 2004 WL 2368468, at *13 (TTAB Sept. 29, 2004), in which mere display and advertising of goods at a trade show without "a sale *or other conveyance to the ultimate customer*" was insufficient for use in commerce. *Id* (emphasis added). In contrast, here, **Applicant "conveyed" the AEROPRO painting machines by distributing samples at the trade show.** Use in commerce has never required a "sale" or financial transaction, and distribution of free samples at a U.S. trade show prior to the filing date is sufficient to meet this requirement. Notably, Opposer never bothered to take depositions or cross examine Li Xiaorong's testimony. Mere attorney argument is no substitution for witness testimony, and Applicant's clear and uncontradicted testimony demonstrates use in commerce prior to filing the application.

Last, Opposer also makes much of what it perceives as "inconsistencies" in Applicant's discovery responses and claimed first use of AEROPRO in the United States. There are in fact multiple dates of "first use" of AEROPRO, including the launch of Applicant's website in 2012; Applicant's attendance at the first SEMA show in 2013; distribution 2016-2019 catalogs in the

U.S. in 2017, and distribution of samples of AEROPRO painting machines at the SEMA trade show in Las Vegas in 2017. Applicant, a foreign trademark owner unsophisticated in U.S. trademark law, could not be expected to understand the arcane legal concept of "use in commerce" when it filed the application. Applicant's interrogatory responses with "multiple" first use dates demonstrate a reasonable misunderstanding of the concepts of "first use" and "use in commerce," with the correct answer depending on how the interrogatory is worded. U.S. trademark applications, for example, confusingly require two different "first use" dates, and Opposer's excessive written discovery in this case included countless different ways of asking when Applicant "first" used its AEROPRO mark. Simply put, Applicant gave clear, consistent, and uncontradicted testimony about advertising and distribution of AEROPRO products in the U.S. prior to the filing date, including supporting photographs, catalogs, and website screenshots. Opposer's "nonuse" claim therefore fails for lack of evidence.

VI. CONCLUSION

Applicant's AEROPRO mark for "painting machines" is dissimilar to Opposer's AIRPRO mark for paint spray guns, and there is no likelihood of confusion. Furthermore, Applicant advertised and distributed its AEROPRO painting machines in commerce prior to the filing of the application. Accordingly, the Notice of Opposition should be dismissed in its entirety with prejudice.

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[1] This information is not available.

PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing **APPLICANT'S TRIAL BRIEF** has been served on Stephen R. Baird, counsel for Opposer, on May 18, 2023, via email to:

bairds@gtlaw.com, solbergm@gtlaw.com, gtipmail@gtlaw.com, littmanm@gtlaw.com

By: _/Paulo A. de Almeida/________
Paulo A. de Almeida