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THE TTAB

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Pinturas Wesco S.A.**

Serial No. 74/**133,048**

Lawrence E. Abelman of Abelman, Frayne & Schwab for applicant.

Susana B. Miraballes, Trademark Examining Attorney, Law Office
109 (**Deborah S. Cohn**, Managing Attorney).

Before Quinn, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

An application has been filed by **Pinturas Wesco S.A.** to register the mark "DURAPLAST" for "paints and coatings used to protect and decorate metal, glass, and ceramic[s] which are exposed to high temperature and to protect against corrosion of fluid containers".¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 74/133,048, filed on January 24, 1991, which alleges a bona fide intention to use the mark in commerce.

applicant's mark, when applied to its goods, so resembles the mark "DURAPLAS," which is registered for a "polyurethane finish coating for use by original equipment manufacturers to coat metal and plastic business machines and furniture during the course of their manufacture,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed,³ but an oral hearing was not requested. We affirm the refusal to register.

² Reg. No. 1,866,156, issued on December 6, 1994, which sets forth a date of first use anywhere of March 2, 1991 and a date of first use in commerce of March 25, 1991.

³ Applicant, with its initial brief, submitted copies of two search reports, apparently obtained from some unspecified private commercial database(s), each of which lists various third-party registrations for marks "in the paint and coating industry" which contain the prefix "DURA-" or the suffixes "-PLAS" or "-PLAST". Although one of such copies is simply a duplicate of a search report it previously furnished in response to the initial Office action and the other copy, while untimely under Trademark Rule 2.142(d), is merely cumulative in that it provides an updated listing, the Examining Attorney has reiterated in her brief an earlier objection to such evidence on the basis that "a search report is not proper evidence of third[-]party registrations" and that, "because [actual] copies were not provided, these registrations are not part of the record and should be disregarded." Applicant, other than repeating the contention in its initial brief that the existence of the third-party registrations it seeks to rely on "demonstrates the highly suggestive significance of both elements of the cited mark," has not responded to the Examining Attorney's objection in its reply brief.

The proper procedure for making third-party registrations of record is to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations taken from the Patent and Trademark Office's own computerized data base. See, e.g., *In re Consolidated Cigar Corp.*, 35 USPQ2d 1290, 1292 (TTAB 1995) at n. 3; *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) at n. 3 and *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. Inasmuch as applicant has failed to avail itself of either method, the Examining Attorney's objection to such evidence is sustained and the third-party registrations listed in applicant's search reports will not be given further consideration. We hasten to add, however, that even if such evidence

Turning first to consideration of the respective marks, we agree with the Examining Attorney that the marks "DURAPLAST" and "DURAPLAS" are "remarkably similar in appearance, sound, meaning, and overall commercial impression". While applicant's mark adds a letter "T" at the end thereof, this slight difference from registrant's mark is insignificant. Visually and aurally, the marks as a whole are virtually identical and, in terms of connotation and commercial impression, they are essentially indistinguishable since, as applicant asserts in its briefs, "[t]he DURA formative (durable) ... reflect[s] a product which will endure long years of use," while the suffixes "-PLAST" and "-PLAS" each "reflect a plastic coating or molding." Thus, although we concur with applicant that the respective marks are highly suggestive, the marks in their entireties nevertheless convey the same meaning and project an identical commercial impression. Clearly, even though such marks are highly suggestive, if they were used in connection with the same or closely related products, confusion as to source or sponsorship would be likely to occur.

Applicant argues, however, that "there are distinctions between the nature and purposes of the goods which ... must be viewed as diminishing the probability of a purchaser being confused". Specifically, besides being intended for use to protect against corrosion of fluid containers, applicant contends that application of its paints and coatings for protecting and

properly formed part of the record, it would make no difference in the disposition of this appeal.

decorating metal, glass and ceramic surfaces which are exposed to high temperatures "requires working with extremely high temperatures" which "may range between 150° to 200° Centigrade." Such goods, applicant insists, would be "used in an industrial process which requires a significant degree of pre-purchase sophistication, knowledge, and analysis." By contrast, applicant asserts that due to the "inherent nature of a polyurethane finish, which is a synthetic rubber polymer (thereby requiring the application of low temperatures)," registrant's goods, which are sold to original equipment manufacturers to coat metal and plastic business machines and furniture during the course of their production, "are completely different" from applicant's goods and "the channels of trade are likely to be disparate."

However, as the Examining Attorney correctly observes, it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). Moreover, it is also well established that the issue of likelihood of confusion must be determined in

light of the goods set forth in the involved application and cited registration and, in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1993); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, as noted by the Examining Attorney, the respective goods are "related coating products" which "serve similar functions, namely the coating of metals" to achieve a durable finish. Although applicant's goods, unlike registrant's products, are also useful in protecting against corrosion of fluid containers, it would appear to be the case that applicant's goods, like registrant's products, are both coatings which are suitable for sale to original equipment manufacturers for use as a protective finish to coat metal business machines and furniture during the course of their manufacture. Moreover, as the Examining Attorney points out, even though applicant's paints and coatings are for use, inter alia, in decorating and protecting metal surfaces which are exposed to high temperatures, nothing in the identification of its goods in the application limits or otherwise "indicate[s] at which point in the manufacturing process (before, during, or after) its product is employed." Thus, even if registrant's polyurethane finish coatings are applied at much lower temperatures than applicant's coatings are

designed to withstand, it is still the case that the respective goods are closely related in the sense that they are both durable plastic protective coatings which are suitable for sale to original equipment manufacturers for use in coating metal business machines and furniture during different stages in their manufacturing process.

Furthermore, while original equipment manufacturers may undoubtedly be careful and discriminating purchasers with respect to the protective coatings employed in their manufacture of metal business machines and furniture, that does not necessarily mean, as the Examining Attorney observes, that they are sophisticated or otherwise knowledgeable in the field of trademarks or immune from confusion as to origin or affiliation. See, e.g., Wincharger Corp. v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962); In re Decombe, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). This would be especially the case where, as here, virtually identical marks are utilized by applicant and registrant. Moreover, even if such purchasers were to take notice of the slight difference between applicant's "DURAPLAST" mark and registrant's "DURAPLAS" mark, it simply would not be unreasonable for those customers mistakenly to think that applicant's goods are merely a line of higher temperature protective coatings which emanate from the same source as registrant's lower temperature polyurethane finish coatings.

We conclude, therefore, that purchasers familiar with registrant's "DURAPLAS" mark for a "polyurethane finish coating

for use by original equipment manufacturers to coat metal and plastic business machines and furniture during the course of their manufacture" would be likely to believe, upon encountering applicant's essentially identical "DURAPLAST" mark for, in particular, "coatings used to protect and decorate metal, glass, and ceramic[s] which are exposed to high temperature," that such closely related durable plastic protective coatings emanate from or are affiliated with the same source. See, e.g., Albi Manufacturing Corp. v. Conchemco, Inc., 189 USPQ 544, 546 (TTAB 1975) ["APPLI-CLAD" mark for chemical formulations used as primers and finishes and protective and decorative coatings is likely to cause confusion with "ALBI-CLAD" mark for fire and heat retardant mastic coatings which also provide protective properties to treated surfaces]. To the extent, however, that we may have any doubt as to our conclusion, we resolve such doubt, as we must, in favor of the registrant. See In re Pneumatiques Caoutchouc Manufacture et Plastiques Kelber-Columbes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal under Section 2(d) is affirmed.

T. J. Quinn

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board