

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

JULY 21, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **The Valspar Corporation**

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Serial No. 74/**722,274**

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**John A. Clifford of Merchant Gould Smith Edell Welter & Schmidt**  
for applicant.

**Adam C. Striegel**, Trademark Examining Attorney, Law Office 105  
(**Thomas G. Howell**, Managing Attorney).

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Before Cissel, Hanak and Hohein, Administrative Trademark Judges.

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

An application has been filed by **The Valspar Corporation** to register the mark "FLUROPON HARDCOAT" for an "industrial coating in the nature of paint for use in the field of architectural metal finishing".<sup>1</sup>

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<sup>1</sup> Ser. No. 74/722,274, filed on August 29, 1995, which alleges dates of first use of April 30, 1993. The term "HARDCOAT" is disclaimed. Ownership is claimed of the following subsisting registrations: Reg. No. 810,730, issued on July 5, 1966, for the mark "FLUROPON" for "protective and decorative corrosion-resistant coatings for exposed surfaces, including hardware, for domestic, commercial and/or industrial buildings" and Reg. No. 1,302,336, issued on October 30, 1984, for the mark "FLUROPON CLASSIC" for an "industrial finish in the nature of a paint".

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles each of the following marks, which are owned by different registrants, as to be likely to cause confusion, mistake or deception:

(i) the mark "HARDCOTE," which is registered on the Principal Register, in the block letter format reproduced below,

for "finishes--namely, clear varnish and all colors of enamel made from that varnish, used as a protective or beautifying coat for all interior and exterior surfaces usually enameled";<sup>2</sup> and

(ii) the mark "HARDCOAT," which is registered on the Supplemental Register for a "coating in the nature of a paint for use in creating a paintable surface for industrial applications".<sup>3</sup>

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register in each instance.

Turning first to consideration of the respective goods, the Examining Attorney argues that "[t]he goods are closely related and sufficiently similar" inasmuch as "both the applicant's and registrants' goods involve similar coatings. In particular, the Examining Attorney contends that it is "common

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<sup>2</sup> Reg. No. 722,985, issued on October 10, 1961 and currently owned by the Bisonite Company, Inc., which sets forth dates of first use of 1920; first renewal.

<sup>3</sup> Reg. No. 1,888,072, issued on April 4, 1995 and presently owned by the T C Manufacturing Co., Inc., which sets forth dates of first use of November 5, 1993.

knowledge that paints and varnishes are sold at the same stores and are found side by side on the shelves of the stores that carry these items, such as paint stores, hardware stores, and home improvement stores."<sup>4</sup> Furthermore, inasmuch as the other "registrant's paints are described as a 'paint' for 'industrial applications,' and applicant's goods are described as an 'industrial paint' with further limiting language," the Examining Attorney insists that applicant's goods are encompassed by the language of "the second registrant's more broadly described goods".

However, as applicant points out in its brief, its goods are not just paints but are, instead, an industrial coating in the nature of paint for use in the field of architectural metal finishing. Thus, while the varnishes marketed by one of the registrants is similarly used on wood on metal as a protective and beautifying coat for both interior and exterior surfaces,<sup>5</sup>it is nevertheless the case that, as asserted by

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<sup>4</sup> Although the Examining Attorney also asserts, in this regard, that the Board has held "varnishes ... to be clearly related and sufficiently similar to paints under Section 2(d) of the Trademark Act," the case cited by the Examining Attorney in support of such proposition, *Conchemco, Inc. v. American Hardware Supply Co.*, 155 USPQ 767 (TTAB 1967), was reported in digest form. As the Board announced in *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 (TTAB 1992) at n. 9, the "citation of ... 'digest' Board decisions as precedent will no longer be allowed," and thus will be disregarded (except in certain limited circumstances not applicable herein), since "such decisions are meaningless as precedent because they fail to report the facts on which the decisions were based." Accordingly, no further consideration will be given to the Examining Attorney's reliance upon the digest opinion cited in his brief.

<sup>5</sup> We judicially notice, in this regard, that Webster's New World College Dictionary (3d ed. 1997) at 1477 defines "varnish" as, inter alia, "1 a) a preparation made of resinous substances dissolved in oil

applicant, the purchasers of its goods "are commercial manufacturers [who] are highly skilled and experienced in the purchase of such goods". Those goods, applicant additionally notes, are purchased with care and deliberation, rather than impulsively, since "architectural metal finishing requires a higher degree of skill, experience, and equipment than is typically found for varnishing on common painting". Moreover, while the other registrant's goods, like those of applicant, are concededly industrial coatings, we note that, as applicant insists, "purchasers are likely to be able to easily distinguish the goods of the parties," and hence would expect differences as to their source, inasmuch as the other registrant's goods are for use in creating a paintable surface rather than in finishing architectural metal products. The respective goods, in short, are specifically different.

Nevertheless, even if applicant's goods are considered to be closely related or sufficiently similar to the goods of each of the registrants, we agree with applicant that, in view of the highly suggestive nature of the mark "HARDCOTE" and the mere descriptiveness of the designation "HARDCOAT," contemporaneous use of applicant's "FLUROPON HARDCOAT" mark and the registrants' respective "HARDCOTE" and "HARDCOAT" marks is not likely to cause

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(**oil varnish**) or in alcohol, turpentine, etc. (**spirit varnish**), used to give a hard, glossy surface to wood, metal, etc. b) any of various natural or prepared products used for the same purpose 2 the hard, glossy surface produced ...." It is settled that judicial notice may properly be taken of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

confusion as to the source or sponsorship of the goods marketed thereunder. As applicant observes:

It is common to consider a "coat" of paint as the layer of paint applied to an object. For a protection layer on an object to be "hard" is easily anticipated by consumers. Therefore, the term HARD COAT (of HARDCOTE) [or of HARDCOAT] is a relatively [highly suggestive or merely] descriptive term for a protective coating. The goods listed in both of the cited registrations are just such protective coats. The mark HARDCOTE, and the mark HARD COAT [sic] should not be given a broad scope of protection.

The Examining Attorney nevertheless argues that, in addition to the "HARDCOAT" portion of applicant's "FLUROPON HARDCOAT" mark being identical, or essentially so, to each of the registered "HARDCOTE" and "HARDCOAT" marks in sound, appearance, meaning and commercial impression, "it is well settled that the mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d)". A more accurate statement of such principle, however, is set forth, for example, in *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984), in which the Board pointed out that:

[T]here is a general rule that a subsequent user may not appropriate another's entire mark and avoid likelihood of confusion therewith by merely adding descriptive or otherwise subordinate matter to it. See: *Bellbrook Dairies, Inc. v. Hawthorn Melody Farms Dairy, Inc.*, 253 F.2d 431, 117 USPQ 213 (CCPA 1958), and *In re South Bend Toy Manufacturing Co., Inc.*, 218 USPQ 479 (TTAB 1983). An exception to the rule may be found in those cases where the appropriated mark is highly suggestive or merely descriptive or has been frequently used by others in the field for the same or related goods or

services. See: In re Hunke & Jochheim, 185 USPQ 188 (TTAB 1975) and Jean Patou, Inc. v. Jacqueline Cochran, Inc., 133 USPQ 242 (SDNY 1962), affirmed[, ] 312 F.2d 125, 136 USPQ 236 (2nd Cir. 1963).

In the same vein, and thus likewise applicable to this case, the Board in Johnson Publishing Co., Inc. v. Cavin & Tubiana OHG, 196 USPQ 383, 387 (TTAB 1977), noted that:

It is recognized that, in determining the question of likelihood of confusion, the marks in issue must be considered in their entirety because that is the manner in which they are encountered in the marketplace. But, it is equally well settled that the disclaimed portion may be given less weight in a composite mark than the remaining arbitrary portion on the theory that individuals would recognize the descriptive character of the disclaimed portion and look to the remaining part as the source indicator.

See also In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applying the above principles to this case, applicant's mark is readily distinguished by the arbitrary term "FLUROPON," given the mere descriptiveness of the designation "HARDCOAT" as confirmed by applicant's compliance with the requirement for a disclaimer thereof. Plainly, such designation, as applied to industrial coatings, describes the tough or durable finish or coat provided thereby. Similarly, when used in connection with varnishes, the term "HARDCOTE" is highly suggestive of the hard surface produced by such products and, accordingly, the term "HARDCOTE," like its phonetic equivalent "HARDCOAT," is entitled to only a very limited scope of protection, as urged by applicant.

Consequently, and keeping in mind that industrial coatings and varnishes of the kinds involved herein are typically bought by sophisticated and discriminating purchasers who would exercise a high degree of care and deliberation given the quantities in which such products are customarily purchased and the nature of the industrial applications in which the goods are used, customers for applicant's goods would rely primarily on the arbitrary term "FLUROPON" as the source indicative element of applicant's "FLUROPON HARDCOAT" mark and would attribute to the designation "HARDCOAT" its merely descriptive significance. In view thereof, and in light of the highly suggestive connotation of the mark "HARDCOTE" for varnishes for interior and exterior finishing and the descriptive significance of the mark "HARDCOAT" for coatings in the nature of paint for creating a paintable surface in industrial applications, contemporaneous use of applicant's "FLUROPON HARDCOAT" mark for an industrial coating in the nature of a paint for use in the field of architectural metal finishing and the registrants' "HARDCOTE" and "HARDCOAT" marks for their respective goods is not likely to cause confusion as to source or sponsorship.

**Decision:** The refusal under Section 2(d) is reversed in each instance.

R. F. Cissel

E. W. Hanak

**Ser. No.** 74/722,274

G. D. Hohein  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board