

3/22/02

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 16
TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Graham Paint & Varnish Co. Inc.

Serial No. 75/737,714

Gail Tuler Friedman of Friedman & Friedman for applicant.

Ronald McMorrow, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Graham Paint &
Varnish Co. Inc. to register the mark ACRYPLEX for
"exterior, interior paint, and house paint for use on wood,
concrete, tile, plaster, wall board and structural surfaces
sold in retail paint and wallpaper stores, including
hardware and home improvement stores."¹

¹ Application Serial No. 75/737,714, filed June 28, 1999,
alleging dates of first use and first use in commerce of November
1957.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark ACRIPLEX for "scratch-resistant coating lacquers for plastic materials"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Applicant prefaces its arguments by stating that it owned Registration No. 654,345 for the mark ACRYPLEX for "paint," but that the registration inadvertently lapsed in 1997. Applicant goes on to contend that there is no confusion between its mark and registrant's mark due to differences between the goods, the channels of trade and the classes of purchasers. Applicant argues that registrant's goods "are used in factories, require professional application, and are used by extruders of plastic and makers of plastic and would not and could not be found in retail paint and wall paper stores or even in home improvement or hardware stores where Applicant's goods can be found." (brief, p. 6) Applicant further contends

² Registration No. 1,338,656, issued June 4, 1985; combined Sections 8 and 15 affidavit filed.

that registrant's goods are specialized and are bought by discriminating purchasers who exercise care, whereas applicant's goods are bought by do-it-yourself consumers. In support of its arguments, applicant submitted the declaration of James Nass, applicant's vice president of sales.

The Examining Attorney maintains that the marks are virtually identical, differing by only one letter, yet remaining phonetically equivalent. The Examining Attorney also contends that the goods are related, and that applicant has impermissibly attempted to limit the scope of registrant's goods. In connection with the similarity of the goods factor, the Examining Attorney submitted fifteen third-party registrations showing particular marks registered by different entities for both paints and lacquers.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential

Ser No. 75/737,714

characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

With respect to the similarity between the marks ACRYPLEX and ACRIPLEX, applicant essentially concedes this point, its brief being entirely silent as to this factor. The marks are virtually identical, differing only by the letter "Y" and "I" appearing in the middle of the respective terms. Nonetheless, the marks still look alike and are phonetic equivalents. In sum, the marks engender virtually the same overall commercial impression.

Another du Pont factor is the number and nature of similar marks in use on similar goods. The record is devoid of any third-party uses and/or registrations of the same or similar marks for goods of the types involved herein.

Insofar as the goods are concerned, we start with the premise that it is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken

Ser No. 75/737,714

belief that the goods originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978). Further, the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved registration and application. See, e.g., In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997), *quoting*, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also: Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Contrary to the gist of applicant's arguments, it is presumed that registrant's registration encompasses all goods of the nature and type identified, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential purchasers. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Thus, we must presume that registrant's lacquers for plastic materials are of the type that may be sold at retail to ordinary do-it-yourself consumers. Mr. Nass' statements about the specifics of

registrant's goods are of no consequence in our legal analysis. The legal comparison of the goods is based on the identifications of goods in the application and registration, regardless of what the record may reveal as to the particular nature of the goods, the particular channels of trade or the class of purchasers to which the sales of the goods are directed. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, supra at 1787. When the goods are compared in light of the legal constraints cited above, we find that the goods are related.

In comparing the goods, we have considered the third-party registrations based on use which the Examining Attorney submitted.³ The registrations show the same marks registered by the same entity for both paint and lacquer. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the goods listed therein, including paint and lacquer, are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB

³ Four of the fifteen registrations are based on foreign registrations and, thus, we have not considered the four inasmuch as there is nothing to indicate that the marks were used in this country such they would have been exposed to consumers here.

Ser No. 75/737,714

1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988).

We have considered the absence of actual confusion in this case. In this connection, we note applicant's reliance on the fact that it owned a registration (issued in 1957) for the same mark and the same goods as the mark and goods involved herein, but that the registration lapsed due to an inadvertent failure to renew in 1997. We also recognize that applicant's expired registration and the cited registration coexisted for about twelve years.

It is unnecessary, however, to show actual confusion in establishing likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); and *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). Further, as to the years of contemporaneous registration, we are, of course, not bound by an Examining Attorney's prior determination as to registrability. See: *In re Perez*, 21 USPQ2d 1075, 1077 (TTAB 1991). In sum, the lack of evidence of actual confusion does not significantly weigh in applicant's favor in showing that there is no likelihood of confusion in this case.

Ser No. 75/737,714

Inasmuch as the goods, as identified, are similar and the marks create virtually identical commercial impressions, there is a likelihood of confusion.

Decision: The refusal to register is affirmed.