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OF THE TTAB

Mailed: July 26, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SWIMC, Inc.<sup>1</sup>

Serial No. 76600805

Frank P. Presta of Nixon & Vanderhye P.C. and Deron A. Cook, Esq., of SWIMC, Inc. for applicant.<sup>2</sup>

Doritt Carroll, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Seeherman, Grendel and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, SWIMC, Inc., seeks to register the mark PRO KOTE

<sup>1</sup> The application was assigned from Duron, Inc., the original applicant, to SWIMC, Inc., and the assignment has been recorded with the Assignment Division of the USPTO.

<sup>2</sup> The attorney of record for applicant is Frank P. Presta of Nixon & Vanderhye P.C., 1100 North Glebe Road, 8th Floor, Arlington VA 22201-4714. Deron A. Cook of SWIMC, Inc. filed the appeal brief in this case and listed the correspondence address as Robert E. McDonald c/o The Sherwin-Williams Company, 101 Prospect Avenue NW, 1100 Midland Bldg. - Legal Dept., Cleveland, OH 44115-1075. A courtesy copy of this decision will be sent to Mr. McDonald. However, absent a written request from applicant to change the correspondence address in accordance with Trademark Rule 2.18, Mr. Presta's address will remain the correspondence address of record.

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(in standard character form) for "interior and exterior paints" in Class 2.<sup>3</sup>

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 mark PRO-COAT (in typed form) for "sealer coatings for use on wood; wood varnishes; wood lacquers in the nature of a coating; coatings in the nature of adhesion promoters for other wood coatings" (in Class 2) as to be likely to cause confusion.<sup>4</sup>

When the refusal was made final, applicant appealed. Briefs have been filed.

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 likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key

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<sup>3</sup> Application Serial No. 76600805, filed July 6, 2004, based on an allegation of first use and first use in commerce "on or about 1987." The word "coat" is disclaimed. Applicant is the owner of related application Serial No. 76600804 for the mark PRO KOTE SUPREME for the same goods which is also currently on appeal before the Board. Because the two applications were handled by different examining attorneys who created different records in each case, and since the applications involve certain factual differences, the appeals in these cases have been decided in separate opinions.

<sup>4</sup> Registration No. 2892968, issued October 12, 2004. The examining attorney had initially refused registration under Section 2(d) on the basis of an additional registration (No. 2221557). That registration was subsequently cancelled by the Office and the refusal as to the registration was withdrawn.

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considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to the goods, keeping in mind that the question of likelihood of confusion is determined on the basis of the identification of goods set forth in the application and registration, without limitations or restrictions as to the actual nature of the goods, their channels of trade and/or classes of purchasers that are not reflected therein. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Applicant argues that wood varnishes and lacquers have a very different surface appearance and utility than applied paints. Applicant maintains that whereas house paints are typically tinted to a color selected by the consumer, wood varnishes and lacquers are generally not. In addition, applicant argues that the products are intended to meet entirely different, and not overlapping needs, concluding that consumers are likely to exercise caution in making sure that the right product is selected.

Applicant's and registrant's goods may be specifically different and have different compositions. However, the question is not whether purchasers can differentiate the goods, but rather whether purchasers are likely to confuse the source of the goods. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Thus, goods need not be similar or competitive in nature to support a finding of likelihood of confusion. *Id.* It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, if similar marks are used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Registrant's goods are varnishes, lacquers and sealer coatings all for use on wood surfaces. Applicant's goods are interior and exterior paints which, by the identification, are not limited to use on any particular type of surface and therefore may include use on wood surfaces. The respective goods are at least complementary, if not overlapping, products. They are all in the nature of decorative and/or protective coatings that can be applied to the same interior or exterior wood surfaces such as decks, floors, railings and furniture. It is clear that these closely related products, if offered under

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similar marks, would be perceived as emanating from the same source.

The website printouts made of record by the examining attorney show that both types of products in fact emanate from the same source. For example, the website for "LOWE'S" (lowes.com), sells both AMERICAN TRADITION paints, including AMERICAN TRADITION INTERIOR/EXTERIOR LATEX FLOOR PAINT, as well as AMERICAN TRADITION SKID-NOT INTERIOR/EXTERIOR SKID RESISTANT COATING; MINWAX paints as well as MINWAX finishes; and OLYMPIC paints as well as OLYMPIC "paint and stain varnishes." Similarly, the website for "Benjamin Moore Paints" (benjaminmoore.com) sells BENJAMIN MOORE paints as well as BENJAMIN MOORE coatings, stains, finishes and varnishes. The website for "Sherwin-Williams" (sherwin-williams.com) sells SHERWIN-WILLIAMS painting products as well as SHERWIN-WILLIAMS staining and primer products, and sealers and finishing coats.

Because the goods are closely related and there are no limitations in the application or registration, we must assume that the respective products are sold through all normal channels of trade for those goods, including home improvement stores and paint product stores, and that the goods reach all the usual purchasers, including ordinary consumers. In other words, we must assume that the channels of trade and the purchasers for the goods would be the same. See *Interstate Brands Corp. v. McKee*

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Foods Corp., 53 USPQ2d 1910 (TTAB 2000); and In re Smith & Mehaffey, 31 USPQ2d 1531 (TTAB 1994). The website evidence submitted by the examining attorney shows that the channels of trade and purchasers for both types of goods are in fact the same.

It is reasonable to assume, as applicant claims, that the consumers who would purchase applicant's and registrant's products would exercise some degree of care in selecting the products. However, even careful purchasers can be confused as to source under circumstances where similar marks are used on closely related goods. See In re Research Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers...are not infallible.").

We turn then to a comparison of the marks. In determining the similarity or dissimilarity of marks, we must consider the marks in their entirety in terms of sound, appearance, meaning and commercial impression. See du Pont, supra. See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The marks in this case, PRO KOTE and PRO-COAT, are identical in sound. They are phonetic equivalents that would both be pronounced the same. As the examining attorney points out,

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similarity in sound alone has been held to support a finding of likelihood of confusion. See *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968). See also *Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) ("Another factor weighing heavily in our decision is that the dominant portion of both parties' marks sounds the same when spoken"); and *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (similarity in sound between ISHINE (stylized) and ICE SHINE "is so substantial that it outweighs any differences in appearance and meaning."). Furthermore, the two marks have the same meaning in relation to the goods and they create the same overall commercial impressions, both suggesting the professional quality of the finishes.

As applicant points out, there are some differences between the marks in appearance, in particular, the hyphen in registrant's mark and the misspelling of "coat" as "kote" in applicant's mark. The marks are nonetheless similar in overall appearance. Both marks consist of two words, separated by a space or a hyphen, with each mark having the same number of letters and the identical first word "PRO." In any event, the identity in the sound, meaning and commercial impression of the marks far outweighs their differences in appearance.

Applicant contends that consumers are going to see product labels before making purchases and that therefore the "obvious

differences" in appearance "will not be missed." Brief, p. 4. However, when we consider that the comparison of the marks is not necessarily made on a side-by-side basis and that recall of purchasers is often hazy and imperfect, the visual differences in the marks are not so significant that they are likely to be remembered by purchasers when seeing these marks at different times in connection with closely related goods. Even if purchasers remember the specific differences in the marks, they are likely to perceive PRO KOTE as simply a variation of registrant's mark PRO-COAT, and assume that applicant's mark identifies a related product line coming from the same company.

We recognize that registrant's mark PRO-COAT is suggestive of registrant's varnishes and coatings, and therefore not entitled to the broadest scope of protection.<sup>5</sup> However, the mark is at least entitled to protection from registration of this highly similar mark for closely related goods. See *In re Colonial Stores, Inc.*, 216 USPQ 793 (TTAB 1992). See also *King*

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<sup>5</sup> Applicant argues, referring to printouts of five third-party registrations attached to its appeal brief, that the registered mark is weak and entitled to only a narrow scope of protection. The examining attorney has properly objected to this untimely submission. See Trademark Rule 2.142(d). Accordingly, the third-party registrations have not been considered. Even if we had considered this evidence, however, it would not change the result in this case. First, third-party registrations are not evidence that the marks shown therein are in use or that the public is aware of them. See *AMF Incorporated v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973) ("little weight is to be given such registrations in evaluating whether there is likelihood of confusion."). Further, none of the marks in those third-party registrations is as similar to the cited registration as applicant's mark.

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Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks.)

Finally, we point out that the asserted absence of evidence of actual confusion does not, as applicant claims, weigh in favor of applicant. We have no information regarding the nature or extent of applicant's and registrant's use or whether a meaningful opportunity for actual confusion ever existed. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Thus, we consider this factor to be neutral. See *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005).

In view of the foregoing, we find that purchasers familiar with registrant's wood varnishes, lacquers and coatings provided under its PRO-COAT mark, would be likely to believe, upon encountering applicant's mark PRO KOTE for closely related paints, that the goods originated with or are in some way associated with or sponsored by the same entity.

**Decision:** The refusal to register under Section 2(d) of the Trademark Act is affirmed.