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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hagemeyer North America, Inc.

Serial No. 78582377

Sidney R. Brown of Jones, Day for Hagemeyer North America, Inc.

Emily Chuo,[1] Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Walters, Grendel and Drost, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark **VERSAPRO**, in standard character form, for Class 16 goods identified in the application, as amended, as:

> Paint brushes; wands, attached to cans of spray marking paint and not attached to machinery, for marking ground with paint for use in construction, excavation, underground utilities,

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[1] A different Trademark Examining Attorney handled this case prior to appeal.

> and traffic safety; trash can liners; and packaging, namely, boxes of paper or cardboard, and plastic bubble packs for wrapping or packaging.[2]

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark, as applied to the goods identified in the application, so resembles the mark **VERSAPRO**, previously registered[3] on the Principal Register (in standard character form) for

> Air compressors, tool bits for machines, bits for power drills, drill chucks for power drills, electric handle-held drilling machines and parts therefor, pile drivers, pneumatic hammers, impact wrenches, hydraulic jacks, electric knives, air brushes for applying paint, power-driven wrenches, extension bars for power tools, power tools, namely drills, routers, saws, screwdrivers, shears, wrenches and ratchet wrenches

in Class 7, and

> Bits for hand drills, blades for hand saws, manual jacks, pocket knives, garden tools, namely trowels, weeding forks, spades, hoes, hand tools, namely pliers, shovels, wrenches, screwdrivers, hammers, saws, scrapers, ratchet wrenches, socket

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[2] Serial No. 78582377, filed March 8, 2005. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1051(b), 15 U.S.C. §1051(b).

[3] Reg. No. 2540609, issued on February 19, 2002. Affidavits under Sections 8 and 15 accepted and acknowledged.

> sets, clamps, drills, planners [sic – planers?], tweezers, knives, scissors

in Class 8, as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant and the Trademark Examining Attorney have filed appeal briefs. After careful consideration of the evidence of record and the arguments of counsel, we affirm the Section 2(d) refusal to register.

Our likelihood of confusion 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 (the *du Pont* factors). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We begin with the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial

impression. *Palm Bay Imports, Inc., supra*. We find that applicant's VERSAPRO mark is identical in every respect to the cited registered VERSAPRO mark. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the goods as recited in the application and in the cited registration. It is settled that it is not necessary that the goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991);

and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Finally, in cases such as this where the applicant's mark is identical to the cited registered mark, there need be only a viable relationship between the respective goods in order to find that a likelihood of confusion exists. *See In re Shell Oil Co.,* 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc.,* 60 USPQ2d 1812 (TTAB 2001); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Applying these principles in the present case, we find that certain of the goods identified in applicant's application and certain of the goods identified in the cited registration are similar and related, for purposes of the second *du Pont* factor.[4] In particular, we find that applicant's "paint brushes" are related to the goods identified in the cited registration as "air brushes for applying paint" and "hand tools, namely ... scrapers."

Applicant's "paint brushes" are broadly identified in the application, and thus must be presumed to encompass all

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[4] If confusion is likely as to any of the goods or services identified in a particular class in an application, Section 2(d) bars registration as to all of the identified goods or services in that class in the application. *See Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 381 F.2d 328, 137 USPQ 881 (CCPA 1963); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 n.9 (TTAB 2004); *In re Alfred Dunhill Ltd.*, 224 USPQ 501, 504 (TTAB 1984); and *In re Multivox Corp. of America,* 209 USPQ 627, 632 (TTAB 1981).

types of paint brushes for use in all types of painting by all types of painters. These would include amateur and professional artists, commercial painters and ordinary homeowners undertaking do-it-yourself painting projects.

Applicant's "paint brushes" and registrant's "air brushes for applying paint" are similar and related in that they both are types of brushes used by artists, commercial painters and homeowners as means of applying paint. Applicant's "paint brushes" are complementary and related to registrant's broadly-identified "scrapers," which must be presumed to include paint scrapers. Paint scrapers and paint brushes would be purchased and used together as part of any painting project requiring the removal of old paint and the application of new paint.

For these reasons, we find that the "paint brushes" identified in applicant's application are similar and related to the "air brushes for applying paint" and the "scrapers" identified in the cited registration. As noted above, because applicant's mark is identical to the cited registered mark, there need be only a viable relationship between the respective goods in order to support a finding of likelihood of confusion. We find that the requisite viable relationship between the goods exists in this case.

The second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The third *du Pont* factor requires us to determine the similarity or dissimilarity of the trade channels for the respective goods. Applicant's identification of goods includes no trade channel restrictions or limitations as to its "paint brushes." Likewise, registrant's identification of goods includes no trade channel restrictions or limitations as to its "air brushes for applying paint" and its "scrapers." We therefore must presume that these respective goods are marketed in all normal trade channels for such goods and to all normal classes of purchasers for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). The evidence of record includes printouts from the websites of four art supply retailers that sell both paint brushes and air brushes for use by artists.[5] The normal trade channels for paint brushes and paint scrapers also would be the same, including hardware, home improvement, and painting supply stores. Because the trade channels for the respective goods are similar, the third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

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[5] These retailers are Discount Art Supplies (www.discountart.com), In2Art (www.in2art.com), Blick Art Materials (www.dickblick.com), and Madison Art Shop (www.madisonartshop.com).

The fourth *du Pont* factor requires us to consider the conditions of purchase. We find that although the purchasers of applicant's paint brushes and registrant's scrapers would include professional artists and commercial painters who might be expected to be knowledgeable about the tools that they use, the normal purchasers of these goods also must be deemed to include ordinary consumers such as amateur artists and homeowners undertaking do-it-yourself painting projects. These purchasers would exercise only a normal degree of care in purchasing these products. Even as to the professionals, their knowledge of the products themselves does not necessarily eliminate the confusion that is likely to result from the use of the identical VERSAPRO mark on these related goods. *See, e.g., In re Decombe*, 9 USPQ2d 1812. These products are not particularly expensive, and certainly not so expensive that the degree of care taken in purchasing them necessarily would immunize their purchasers from source confusion. For these reasons, and contrary to applicant's argument, we find that the fourth *du Pont* factor does not weigh significantly, or even at all, in applicant's favor in our likelihood of confusion analysis. To the extent that it does, it clearly is outweighed by the evidence of record on

the other *du Pont* factors which supports a finding of likelihood of confusion.

Balancing all of the evidence of record as it pertains to the relevant *du Pont* factors, we find that a likelihood of confusion exists. We have considered all of applicant's arguments to the contrary, but we find them to be unpersuasive. To the extent that any doubts might exist as to the correctness of our conclusion that confusion is likely, we resolve such doubts against applicant. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc., supra.*

Decision: The refusal to register is affirmed.