

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: March 3, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Kelly-Moore Paint Company, Inc.

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Serial No. 78667467

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John E. Kelly of Kelly Lowry & Kelley, LLP for Kelly-Moore Paint Company, Inc.

Debra Lee, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

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Before Kuhlke, Cataldo and Bergsman, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Kelly-Moore Paint Company, Inc. seeks registration on the Principal Register of the mark KELLY-MOORE'S ACRY-SHIELD (in standard character form) for goods ultimately identified as "[i]nterior and exterior paints; paint thinners; paint pigments; interior and exterior latex enamels for metal, wood and concrete surfaces; stains for exterior wood, masonry, concrete and metal surfaces; paint primers and sealer coatings for use on drywalls, plaster and masonry surfaces; and acrylic flat finish and acrylic

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low sheen finish for exterior wood, metal, hard board, stucco, brick, concrete and fiber cement board, said goods being distributed through channels of trade consisting substantially exclusively of applicant's own network of retail paint stores" in International Class 2.<sup>1</sup>

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified goods, so resembles the registered mark ACRI-SHIELD (in typed form) for "finish in the nature of a paint for use on steel, wood and masonry" in International Class 2, as to be likely to cause confusion, mistake or deception.<sup>2</sup>

When the refusal was made final, applicant appealed and briefs have been filed. We affirm the refusal to register.

#### **Likelihood of Confusion**

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d

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<sup>1</sup> Application Serial No. 78667467, filed July 11, 2005, alleging first use of the mark anywhere and in commerce on March 15, 1970 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

<sup>2</sup> Registration No. 1310667, issued December 25, 1984, renewed.

1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Relatedness of the Goods

We begin by considering the possible relatedness of the goods. As a preliminary matter, we note that in response to the examining attorney's argument regarding applicant's trade channels, applicant, in its reply brief, seeks to amend its identification of goods to clarify that the limiting language "said goods being distributed through channels of trade consisting substantially exclusively of applicant's own network of retail paint stores," applies to all of the goods in the identification, and not, as the examining attorney has stated, only to "acrylic flat finish and acrylic low sheen finish for exterior wood, metal, hard board, stucco, brick, concrete and fiber cement board" by virtue of the location of the semi-colons separating the other goods. We accept applicant's proposed amendment and consider the Section 2(d) refusal with the limitation applying to all of the goods.

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In making our determination, we must consider the cited registrant's and applicant's goods as they are described in the registration and application, and we cannot read limitations into those goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

Applicant's "acrylic flat finish and acrylic low sheen finish for exterior wood, metal, hard board, stucco, brick, concrete and fiber cement board" are encompassed by registrant's "finish in the nature of a paint for use on steel, wood and masonry" and as such are legally identical to these goods. Moreover, applicant's remaining paint-related goods (e.g., paints, paint pigments, paint thinners, stains, paint primers) are related to registrant's paint finish. The examining attorney entered into the record several third-party use-based registrations where applicant's various paint-related items and registrant's paint finish have been registered by the same entity under a common mark. See, e.g., Reg. No. 2196987 for the mark M.A.B. for, inter alia, interior and exterior paints, paint primers, wood stains and exterior masonry finish for use on all above-grade masonry surfaces; Reg.

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No. 2614406 for the mark SAMPSON for, inter alia, finishes for wood and metal, namely, acrylic paints, paint primer and paint thinners; and Reg. No. 3020892 for the mark SIGMADUR for, inter alia, paints, stains, clear finishes, and paint thinners. These registrations serve to suggest that paint finish and other paint-related goods would be sold by the same entity under a common mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Even applicant, in addition to the involved application, has a registration that includes various paint products and finishes. See Reg. No. 2711280 KELLY-MOORE PAINTS for, inter alia, paint thinners, paint pigments, paints, paint primers and acrylic flat finish.

In an attempt to distinguish the goods, applicant relies on *In re W.W. Henry Co.*, 82 USPQ2d 1213 (TTAB 2007). In that case, the Board, by examining the terms in the respective identification of goods, found that they were not related:

However, to demonstrate that goods are related, it is not sufficient that a particular term may be found which may broadly describe the goods. When we examine the specific items in the identifications, they do not appear to be related in a manner that would be likely to cause confusion. Applicant's application is for a Portland cement based patch for use in patching, repairing or smoothing wall and floor surfaces,

namely, wood, drywall, plaster, concrete, block wall, tile and wood paneling prior to painting or wallpapering. This is the type of product that would be offered to do-it-yourselfers, handymen, and contractors through hardware and home improvement stores. On the other hand, the chemical filler preparations identified in the cited registration are specifically limited to use in the cosmetic repair of "polyolefin surfaces." Applicant has submitted extrinsic evidence which shows that polyolefin products are molded by plastic manufacturers and that its goods are used by such manufacturers.

Thus, in that case the Board looked to extrinsic evidence in order to understand the identification of goods and not to limit its application based on actual use. In this case, the identification in the registration, "finish in the nature of a paint for use on steel, wood and masonry," is not overly broad, indefinite or unclear as to terminology and we need not resort to any extrinsic or other evidence to understand these goods. Moreover, while applicant discusses the specimens of use in the cited registration, it is not clear what limitation is indicated by those specimens to obviate a finding that the goods are related.<sup>3</sup>

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<sup>3</sup> Although a printout of the cited registration retrieved from the USPTO's electronic database was attached to the office action, the registration file has not been made of record. In order to have the actual specimens of use considered by the Board, applicant would have needed to make them of record by submitting copies.

In view thereof, we find the goods legally identical or otherwise related and this factor weighs in favor of a likelihood of confusion.

Channels of Trade/Class of Purchasers

Applicant relies heavily on its argument that the restriction of the channels of trade in its identification obviates any likelihood of confusion. The fact that registrant's goods may not be sold in applicant's stores and applicant's goods are only sold in applicant's stores<sup>4</sup> does not completely obviate likely confusion in this case. We first note that registrant's identification is not limited and we must assume its goods would be available in hardware stores, large home improvement stores and paint stores. Further, with regard to the class of customers, there are no limitations in the application or registration and thus we must presume that they cover the ordinary purchasers which in both cases would include commercial consumers and the general public (i.e., the "do-it-yourselfers"). Thus, even with the limitation of applicant's trade channels, applicant's and registrant's goods are likely to be encountered by the same purchasers.

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<sup>4</sup> We note that the identification "substantially exclusively" does not preclude the possibility of sales outside of applicant's stores.

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Purchasers may be interested in more than one type of paint and finish and, thus, would shop in more than one store for paints and finishes. Purchasers who are comparison shopping for paints and finishes could easily encounter registrant's ACRI-SHIELD in one store and then see applicant's KELLY MOORE'S ACRY-SHIELD in applicant's store. Consumers shopping in this manner would likely believe that there was some association or relationship between the source of ACRI-SHIELD and KELLY-MOORE'S ACRY-SHIELD. Compare *In re Diet Center Inc.*, 4 USPQ2d 1975, 1976 (TTAB 1987) ("Moreover, even in absence of common, overlapping trade channels, we conclude that confusion is likely in this case for the reasons stated in the prior *Diet Center* case, *supra*. Specifically, it is our view that both products would appeal to people following a lower calorie diet and both products are designed to contribute to the goal of reduced calorie intake; ...") with *In re Shoe Works*, 6 USPQ2d 1890, (TTAB 1988) (no confusion where specifically different goods (shoes v. shorts and pants) and applicant's restricted trade channels (shoe stores) are not the normal channels (clothing stores) in which registrant's goods would be found, and a consent agreement with registrant was of record).

As the examining attorney states "[t]he fact that commercial and individual paint consumers may purchase KELLY-MOORE'S ACRY-SHIELD paint and paint related products through applicant's own retail establishments does not mean that the same consumers viewing registrant's ACRI-SHIELD paint products in other retail outlets and viewing advertisements for the relevant goods will not be confused as to their source." Br. pp. 7-8. Finally, applicant has indicated that some of its goods (one percent of total sales) are sold "through independent dealers" by "reason of acquisitions." Declaration of John E. Kelly (applicant's attorney) attached to July 31, 2006 Response. Therefore, based on the identification in the application and the declaration it remains possible that applicant's goods could be sold in the same store as registrant's goods.

In view of the above, the du Pont factor of the similarity of the class of purchasers favors a determination of likelihood of confusion and the limitation of trade channels in applicant's identification is not sufficient to outweigh the other relevant du Pont factors.

Similarity of the Marks

We now turn to our comparison of the marks where we must determine whether they are sufficiently similar that there is a likelihood of confusion as to source and, in

doing so, we must consider the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). We find the marks to be similar when compared in their entireties in terms of appearance, sound, connotation and commercial impression.

Noting that ACRY-SHIELD and ACRI-SHIELD are phonetic equivalents and appear nearly identical, the examining attorney argues:

Accordingly, the addition of the possessive form of applicant's KELLY-MOORE house mark to wording that is nearly identical to the registered mark creates the impression that the registered mark and the applied for mark refer to a single source. In other words, the issue here is that consumers are likely to believe that applicant is the source of registrant's goods. ... Thus, applicant's addition of its KELLY-MOORE house mark to wording that is almost identical to the cited registered mark aggravates the likelihood of confusion between the two marks, and consumers would mistakenly assume that applicant is the source of both marks. Br. pp. 9, 14.

It is well established that the addition of a house mark may not obviate the similarity between the marks overall or overcome a likelihood of confusion under Section 2(d). In re *United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (*CAREER IMAGE* for retail clothing store and clothing and *CREST CAREER IMAGES* for uniforms); In re *Riddle*, 225

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USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE for automotive service centers and ACCUTUNE for automotive testing equipment); Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co., 216 USPQ 168 (TTAB 1982) (MENNEN SKIN SAVERS for hand and body lotion and SKIN SAVERS for face and throat lotion). However, "there is no rule of law that if two product marks are confusingly similar, likelihood of confusion is not removed by use of a company or house mark in association with the product mark. Rather, each case requires a consideration of the effect of the entire mark including any term in addition to that which closely resembles the opposing mark." New England Fish Company v. The Herwin Company, 511 F.2d 562, 184 USPQ 817, 819 (CCPA 1975) citing Rockwood Chocolate Co. v. Hoffman Candy Co., 372 F.2d 552, 152 USPQ 599 (CCPA 1967). In making a determination, the Board will look to see if "there are some recognizable differences in the asserted conflicting product marks or the product marks in question are highly suggestive or play upon commonly used or registered terms [such that] the addition to applicant's mark of the housemark [is] sufficient to render the marks as a whole registrably distinguishable." Rockwood Chocolate Co, Inc., v. Hoffman Candy Company, 179 USPQ 743, 746 (TTAB 1973).

Applicant contends that registrant's mark is highly suggestive and deserving of limited protection.<sup>5</sup> Based on the asserted weakness of the term ACRI-SHIELD, applicant argues that the addition of its house mark serves sufficiently to distinguish the marks and the examining attorney has incorrectly applied the "house mark rule." Applicant asserts that this case falls within the exception presented in Knight Textiles Corp. v. Jones Investment Co., 75 USPQ2d 1313 (TTAB 2005) where the Board found no likelihood of confusion between applicant's NORTON MCNAUGHTON ESSENTIALS mark and registrant's ESSENTIALS mark both used on clothing. In Knight Textiles the Board found that the addition of the house mark was sufficient to distinguish the marks in issue in view of the highly suggestive nature of the term ESSENTIALS as used in connection with clothing items. The evidence of record in that case included twenty-three third-party registrations (owned by twenty-one different owners) of marks which included the word ESSENTIALS for clothing items and a

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<sup>5</sup> We note that applicant's arguments refer to the common terms as "descriptive." The cited registration enjoys the presumptions under Section 7(b) of the Trademark Act, and may not be attacked as being "merely descriptive." In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (while prima facie presumption of validity may be rebutted, ex parte proceeding is not the proper forum for such a challenge). Therefore, we construe applicant's arguments as contending that ACRI-SHIELD is highly suggestive.

judicially noticed dictionary definition of the word ESSENTIALS.

In this case, as the examining attorney has noted, there is no evidence that the term ACRI-SHIELD is widely used or registered in connection with finishes or other paint products such that the term has some suggestive significance prompting consumers to look to other elements for source identification. Applicant has submitted evidence in the form of listings retrieved from the Trademark Electronic Search System (TESS) displaying applications and registrations in International Class 2 containing the terms SHIELD, ACRYLIC and ACRI.<sup>6</sup> However, none of the examples use ACRYLIC or ACRI together with the word SHIELD. Moreover, many of these examples from the TESS database have no probative value inasmuch as they are either applications or dead registrations. The remaining live registrations for International Class 2 (paints) include, for example, Reg. No. 2845230 for ACRI-LOC, Reg. No. 1996952 for ACRI-LUSTRE, Reg. No. 1529183 for ACRI SHEEN, Reg. No. 3106337 for POND SHIELD, Reg. No. 3115293 for PERMA-SHIELD, and Reg. No. 3097718 for ULTRA-SHIELD. As noted above, none of the examples are for ACRI-SHIELD or

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<sup>6</sup> While the listing does not make the registrations properly of record inasmuch as the examining has not objected to the listing

ACRY-SHIELD or some other phonetic variant of this combination, other than applicant's and registrant's respective application and registration. Although the components of registrant's mark may be commonly registered in the "paints" class, the combined term ACRI-SHIELD is not, nor is it simply a combination of two possibly descriptive or generic terms, ACRYLIC and SHIELD. Rather, while it is highly likely that ACRI is derived by shortening the word ACRYLIC, it is not the word ACRYLIC. Although for some consumers the terms ACRI-SHIELD and ACRY-SHIELD may suggest that the goods are or act as "a protective coating of acrylic composition," we cannot say based on this record that the terms are so highly suggestive that the addition of the house mark to the product mark would obviate confusion similar to the circumstances in Knight Textiles. Therefore, we find that the record does not show that ACRI-SHIELD is so highly suggestive to fall into that category of exception discussed in the Rockwood Chocolate case and exemplified by the Knights Textile case.

Applicant's assertion that its KELLY-MOORE mark is well-known and famous also does not help in this effort to

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we have considered it. In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 n.6 (TTAB 1999).

distinguish the marks because purchasers familiar with registrant's ACRI-SHIELD finishes upon encountering applicant's KELLY-MOORE ACRY-SHIELD finishes and paints are likely to believe that applicant is the source of registrant's ACRI-SHIELD products.<sup>7</sup> "[E]ven if this had been shown to be the case, it would only serve to aggravate the likelihood of confusion that would arise from the contemporaneous use of the marks on the respective goods." In re Christian Dior, S.A., 225 USPQ 533, 535 (TTAB 1985) (addition of house mark DIOR to applicant's LE CACHET DE DIOR for shirts does not obviate likely confusion with CACHET for dresses and toiletries).

Overall we find that the examining attorney appropriately applied the relevant "house mark" case law and the cases cited by applicant are not persuasive of a different conclusion.<sup>8</sup>

Viewing the ACRY-SHIELD portion of applicant's mark, we find that it is identical in sound and meaning to the entirety of registrant's mark ACRI-SHIELD and highly similar in appearance and commercial impression. Applicant

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<sup>7</sup> We note that applicant did not introduce sufficient evidence to conclude that its KELLY-MOORE mark is famous.

<sup>8</sup> For example, *Coats v. Merrick Thread Co.*, 149 U.S. 562 (1893) involved an infringement case that comprised much more complicated factual circumstances including trade dress, an expired patent and generic terminology along with a house mark.

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has, in essence, "appropriated in its entirety" registrant's mark. See Phillips Petroleum Co. v. Jet-Aer Corp., 157 USPQ 98 (TTAB 1968). Further, as discussed above, the addition of applicant's house mark to its product mark is not sufficient in this case to obviate likely confusion. Overall, we find that the marks KELLY-MOORE'S ACRY-SHIELD and ACRI-SHIELD are sufficiently alike that when used on identical or closely related goods would likely cause confusion.

In view of the above, the factor of the similarity of the marks weighs in favor of likelihood of confusion.

#### Conditions of Sale

With regard to the conditions of sale, these goods would be purchased with a certain level of care both by commercial and individual consumers, however, not to such an extent to outweigh the other du Pont factors. See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992).

#### Lack of Actual Confusion

Applicant also argues that "there has been substantial concurrent use by Applicant and Registrant of their respective marks without a single instance of confusion." Br. p. 20. In an ex parte case, the absence of actual confusion is hardly unusual and seldom is a significant

factor in finding that there is no likelihood of confusion inasmuch as the Board has no way to know whether the registrant is unaware of any instances of actual confusion, nor is it usually possible to determine whether there has been any significant opportunity for actual confusion to have occurred. See *Majestic Distilling*, 65 USPQ2d at 1205 ("The lack of evidence of actual confusion carries little weight"). See also *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001). We further note that the case upon which applicant relies is an inter partes case where such evidence would carry more probative value. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1271 (TTAB 2003). However, the Board has recognized that there may be an exception to this general rule where there is shown to be a 'confluence of facts' which together strongly suggest, under the eighth du Pont factor, that the absence of evidence of actual confusion is meaningful and should be given probative weight in an ex parte case. See *In re Opus One, Inc.*, supra at 1817 (TTAB 2001); *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992). This "confluence of facts" includes no reported instances of actual confusion over a long period of sustained marketing success (e.g., 2.7 million automobiles) as attested to by "individuals seemingly in the best position to learn of the occurrence

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of actual confusion," goods that are a "major and expensive purchase" (automobiles), an opportunity for actual confusion has increased over time due to registrant's expansion of its products, and the applicant's mark is extremely well-known. In re General Motors, supra at 1471.

The record in this case does not support the "confluence of facts" necessary to accord this factor more weight than is usual in an ex parte context. Applicant's goods cannot be considered a "major and expensive purchase" in the same category as automobiles. Moreover, the record does not provide information as to the extent of its sales and advertising activity under the mark in issue, KELLY-MOORE'S ACRY-SHIELD, such that we can determine it to have enjoyed a "sustained success." Rather we think it appropriate to follow the general rule that, in an ex parte situation, the fact that the applicant has not experienced any instances of actual confusion is entitled to limited weight.

Accordingly, although we have considered such evidence in reaching our decision herein, we find that this factor does not outweigh the other relevant du Pont factors pointing to likely confusion.

Prior Use

Applicant argues that as the prior user its right to exclude others from using similar marks and "exceeds the comparable rights Registrant may have." Br. p. 21. In the context of an ex parte proceeding, applicant's prior use has no relevance. Section 7(f) of the Trademark Act provides as follows:

A certificate of registration on the principal register provided by this Act shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods or services specified in the certificate, subject to any limitations stated in the certificate. 15 U.S.C. §1057(b).

See also In re Majestic, 65 USPQ2d at 1206-07. There can be no doubt that prompt registration of trademark rights has numerous advantages and that delay in registering a mark may result in a refusal if another entity with subsequent use has, in the meantime, registered a confusingly similar mark.

Reverse Confusion

Finally, applicant's argument that the likelihood of "reverse confusion" does not pose a problem because "applicant was in fact first to use its relevant marks, i.e., ACRY-SHIELD and KELLY-MOORE'S ACRY-SHIELD, and

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therefore, if a customer came to believe Applicant was the 'senior' user, he/she would be absolutely correct" (Br. p. 23), is misplaced. The point is not that the consumer, upon seeing ACRI-SHIELD used on paint finish, believes that applicant is the senior user of the mark, but rather that applicant is the source of the paint finish.

In conclusion, we find that because the marks are highly similar, the goods are related, and the purchasers overlap, confusion is likely between applicant's mark and the mark in the cited registration. To the extent there are any doubts, we resolve them, as we must, in favor of the registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

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