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T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WD-40 Manufacturing Company

Serial Nos. 78817680, 78817703 and 78826409

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Before Seeherman, Zervas and Bergsman, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On February 17, 2006, WD-40 Manufacturing Company
("applicant") filed two applications for registration on
the Principal Register under Section 1(b) of the Trademark
Act, 15 U.S.C. § 1051(b), one for the mark NO-RUST SHIELD
(application Serial No. 78817680), and one for the mark
WD-40 NO-RUST SHIELD (application Serial No. 78817703).
Both marks are in standard character form and both
applications recite "lubricating oil and penetrating oil"

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in International Class 4 in their identifications of goods. On March 1, 2006, applicant filed a third application (Serial No. 78826409) for registration on the Principal Register under Section 1(b) for the mark



also for "lubricating oil and penetrating oil." Applicant has entered a disclaimer of "NO-RUST" in application Serial No. 78817680 and a disclaimer of "NO RUST" in the remaining applications.

Registration of all three marks has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of Registration No. 2072686 (renewed August 8, 2007) for the mark RUST SHIELD (in typed form), with RUST disclaimed, for "kitchen and bathroom liquid for consumers, namely a hand-applied coating used in the home on enamel and porcelain sinks, tubs, and shower enclosures to prevent water rust stain development." Registration of the two marks containing the term WD-40 has also been refused under Trademark Rule 2.36, 37 C.F.R. § 2.36, in view of applicant's failure to claim ownership of Registration No. 0670503 for the mark WD-40 (in typed form, second renewal on September 10, 1998) for "rust prevention and

corrosion control, protective and decorative coatings." Applicant has, however, in response to the Examining Attorney's requirement, claimed ownership of two other registrations, namely, Registration No. 1007258 for the mark WD-40 in typed form for "lubricating oil and penetrating oil" and Registration No. 3010487 for the mark



for "lubricating oil and penetrating oil."¹

After the refusals were made final, applicant filed appeals to the Board. The Board consolidated proceedings for purposes of briefing after applicant filed its brief in each case; the examining attorney then filed her brief. As discussed below, the refusals to register under Section 2(d) and the requirements under Trademark Rule 2.36 are reversed.

¹ In her final Office action in connection with the NO-RUST SHIELD mark, the examining attorney also made final her requirement that applicant provide additional product information about its goods pursuant to Trademark Rule 2.61(b), 27 C.F.R. 2.61(b). However, in her brief, the examining attorney did not address this requirement. We therefore consider the examining attorney to have withdrawn her requirement for additional information in the NO-RUST SHIELD application.

Before addressing the merits of the refusals, we consider one preliminary matter, i.e., the examining attorney's submission of an entry for "WD-40" from wikipedia.org. Because of the nature of Wikipedia as a collaborative online encyclopedia, a Wikipedia article at any given time may contain significant misinformation. Accordingly, "the Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information." *In Re IP Carrier Consulting Group*, 84 USPQ2d 1028 (TTAB 2007). In the present case, the examining attorney submitted the Wikipedia entry with her denial of applicant's request for reconsideration. Inasmuch as applicant did not have an opportunity to rebut the Wikipedia evidence, we accord it no probative value.²

Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in

² While the opportunity to request remand to submit new evidence is available to an applicant, the evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. Trademark Rule 2.142(d). Thus, in view of the inherent limitations of Wikipedia entries, examining attorneys should submit these entries prior to a request for reconsideration.

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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 Fondée 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 turn first to a consideration of the strength of the cited registration, since that factor plays a significant role in our analysis in this case. Registrant's mark is RUST SHIELD for "kitchen and bathroom liquid for consumers, namely a hand-applied coating used in the home on enamel and porcelain sinks, tubs, and shower enclosures to prevent water rust stain development." Registrant has recognized that RUST is a descriptive term and has disclaimed it. See *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012 (TTAB 1988); *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985). "Shield" is defined in relevant part in *The American Heritage Dictionary of the English Language* (4th ed.) as "a thing that provides protection." See definition submitted by the examining attorney with the final Office action. Registrant's goods as identified in

the identification of goods function to prevent rust stains; the goods hence function as a shield against rust stains. Accordingly, registrant's mark is highly suggestive of its goods, and therefore the registration is entitled to only a very limited scope of protection. This *du Pont* factor favors applicant.

With that in mind, we turn to a consideration of the goods. The examining attorney has argued that both lubricants and coatings have similar characteristics. The only support the examining attorney has submitted for this position is a "News Story" from thomasnet.com regarding a lubricating oil. The article is entitled "Lubricating Oil delivers dry protective coating" and depicts a product with the designation "Lube-It All." While the article states that the product "instantly forms a dry coating that penetrates fine scratches and gaps" and that it "lubricate[s] all metal surfaces to prevent rust and corrosion," it also states that the product is for use on metal, plastic and electrical materials and for automotive and heavy-duty surfaces. Because respondent's identification specifically limits use of respondent's coating to enamel and porcelain sinks, tubs and shower enclosures, the article has little probative value. There is hence no compelling evidence to support the examining

attorney's contention that lubricating oil and coatings (presumably including registrant's coating) have similar characteristics.

The examining attorney also argues that both registrant's and applicant's goods are used to prevent rust. This is not correct; registrant's goods are used to prevent the development of rust stains, which are not actually rust, due to water on enamel and porcelain sinks, tubs and shower enclosures, rather than the development of rust per se. In addition, nothing in the record indicates that enamel and porcelain kitchen and bathroom fixtures rust.

Further, the examining attorney relies on several third-party registrations which she contends recite both coatings and lubricating and/or penetrating oil in their identifications of goods. Third-party registrations that individually cover a number of different goods and that are based on use in commerce serve to suggest that the listed goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). She listed the following third-party registrations in her brief and, because we presume that she listed those she felt were most probative, we have concentrated our discussion on them:

Registration No. 1556372 for, inter alia, penetrating oil and lubricants for machinery and non-machinery applications (Int. Cl. 4); and polyurethane wood and metal finish coatings, corrosion resistant coatings (Int. Cl. 2);

Registration No. 1141941 for, inter alia, corrosion resistant coating (Int. Cl. 2); and penetrating oil and lubricants for machinery and other non-machinery applications (Int. Cl. 4);

Registration No. 1603246, for, inter alia, epoxy antiskid coating, epoxy patching and resurface preparations for concrete and masonry, floor coating compositions, namely, concrete and terrazzo sealing and curing compositions, high gloss metal floor finishing composition, stainless steel rust and corrosion proof coating, and general purpose coating for industrial and automotive devices (Int. Cl. 2); and "petroleum based products for use on equipment and roads, namely, ... multipurpose grease, [and] penetrating oil" (Int. Cl. 4); and

Registration No. 2439049 for, inter alia, preservatives against rust and oxidation in the nature of a coating (Int. Cl. 2); and all purpose penetrating oils (Int. Cl. 4).

We do not find these registrations particularly probative because they do not specify that the coatings are used in connection with enamel or porcelain to prevent rust stains or generally in connection with the same type of goods specified in registrant's registration.³

³ For the same reason, applicant's registrations (for dissimilar marks) on which the examining attorney relies have little probative value; they do not specify the nature or use of the recited coatings. Additionally, the examining attorney's argument that the present goods are related because applicant's website shows that applicant produces a variety of goods is not well taken. The webpages of record from the website do not show

We turn next to a consideration of the marks. We acknowledge that the differences between RUST SHIELD and NO-RUST SHIELD are minor. However, in this case where the registered mark must be accorded limited protection in view of its highly suggestive nature, and because of the differences in the goods, even the limited differences in the marks are enough to avoid a likelihood of confusion. Additionally, applicant's inclusion of its house mark WD-40 in two of its marks further distances these two marks from the cited mark. As applicant has pointed out, the Board has found in the past that confusion is not likely when a house mark has been added to a highly suggestive registered mark. Specifically, in *Knight Textile Corp. v. Jones Investment Co., Inc.*, 75 USPQ 1313 (2005), involving the mark NORTON MCNAUGHTON ESSENTIALS, the Board stated:

[W]e find that purchasers are able to distinguish among various ESSENTIAL marks by looking to other elements of the marks. In this case, that other element is the presence of applicant's house mark NORTON MCNAUGHTON. We find that ESSENTIALS is a highly suggestive term as applied to clothing, and that applicant's addition of its house mark NORTON MCNAUGHTON renders the two marks sufficiently distinguishable, when viewed in their entireties, that confusion is not likely to occur. (Case citations omitted).

any goods similar to registrant's coating for preventing rust stain development.

Id. at 1316. We believe that the same holds true here, and that the addition of applicant's house mark renders applicant's mark sufficiently distinguishable from the cited mark when the marks are viewed in their entireties. Thus, the *du Pont* factor regarding the similarity or dissimilarity of the marks is resolved in applicant's favor.

In view of the foregoing, and because of the weakness of RUST SHIELD and the limited scope of protection to which the cited registration is entitled, we find that the examining attorney has not met her burden of establishing *prima facie* that there is a likelihood that applicant's mark for the goods recited in its application will be confused with registrant's mark for the goods set forth in its registration. The Section 2(d) refusals for each of the three applications involved in this appeal are reversed.

Claim of Ownership of Registration

Trademark Rule 2.36 provides that "[p]rior registrations of the same or similar marks owned by the applicant should be identified in the application." In response to the requirement by the examining attorney in the first Office action that applicant submit a claim of ownership of three registrations, applicant claimed two of

the registrations. Even though the examining attorney repeated her requirement for a claim of ownership of the third registration in each of the two actions she issued following the first Office action, applicant did not address this requirement in any of the papers it filed, including in its appeal brief.

TMEP § 812 addresses Rule 2.36. It explains that "[t]he rule does not precisely define when an applicant should claim ownership of prior registration(s)"; and that "[t]he main purpose of the rule is to provide the examining attorney with information necessary for proper examination." The examining attorney did not specify in making and repeating her requirement why the claim of ownership of the specific registration was necessary for proper examination. Although in her brief she mentions that "[n]ormally, identification of a registration is necessary because the registration would, if not owned by the applicant, be a basis for refusal under §2(d) of the Act," she did not offer this explanation in any of her Office actions and did not explain why a Section 2(d) refusal would issue for the third registration when applicant had claimed ownership of the other two registrations. Nor did she give any other explanation as to why the claim of ownership of that registration would

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provide any necessary information for examination. Because it was the burden of the examining attorney to explain why she required the claim of ownership for this particular registration and she did not do so, we find that applicant sufficiently complied with the requirement for a claim of ownership by listing the two registrations, and reverse her requirement for a claim of ownership under Rule 2.36.

Decision: The refusals of registration in application Serial Nos. 78817680, 78817703 and 78826409 under Section 2(d), and the requirements under Trademark Rule 2.36 in application Serial Nos. 78817703 and 78826409, are all reversed.