THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Mailed:
August 14, 2003
Paper No. 16
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

NSI Enterprises, Inc.
v.
Barnett, Inc.

Opposition No. 116,679
to Application Serial No. 75/153,003

Christine M. Cason and William H. Brewster of Kilpatrick Stockton LLP for NSI Enterprises, Inc.

Arthur G. Yaeger of Arthur G. Yaeger, P.A. for Barnett, Inc.

Before Quinn, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

An application has been filed by Barnett, Inc. to register the mark LUMINA and design as shown below:

for "electrical hardware, namely, switches, boxes, cords, circuit breakers, outlets, ground fault interrupters, smoke

alarms, fuses, cover plates for outlets and wall switches, adaptors, electrical testers" in International Class 9, and for "flashlights, electrical lighting fixtures and electric light bulbs," in International Class 11.[1]

Registration has been opposed by NSI Enterprises, Inc. on the ground that, it has been using (through its wholly-owned subsidiary, Lithonia Lighting) the mark LUMINA on electric lighting fixtures since 1992; and that applicant's mark, if used in connection with the identified goods, so resembles opposer's mark as to be likely to cause confusion, to cause mistake or to deceive.

Applicant, in its answer, denied the salient allegations as to opposer's standing and priority as well as the likelihood of confusion claim. The parties have fully briefed this case, but an oral hearing was not requested.

The record consists of the file of the involved application; the trial testimony deposition of Douglas M. Baillie, Lithonia Lighting's director of marketing communications, with accompanying exhibits,[2] including a

---

[1] Application Serial No. 75/153,003 was filed on August 9, 1996 alleging a *bona fide* intention to use the mark in commerce.

[2] Opposer's notice of reliance listed items also placed into the record in the form of Mr. Baillie's trial testimony and accompanying exhibits.

copy of opposer's pending application[3]; and the trial testimony deposition, with exhibits, of Joel L. McEwen, applicant's director of advertising.

Opposer's standing

Applicant charges in its brief that opposer "has failed to establish its standing to be an Opposer herein." (applicant's appeal brief, p. 9). However, the evidence of record shows that opposer, through its related company, has used its LUMINA trademark continuously since at least 1992 in connection with electric lighting fixtures. Under Section 5 of the Trademark Act, 15 U.S.C. §1055, Lithonia Lighting's use inures to the benefit of opposer.[4] That opposer's claimed usage took place through a wholly-owned subsidiary in no way detracts from opposer's showing of standing. In view thereof, we find that opposer has

[3] Application Serial No. 75/374,852 was filed on October 17, 1997, claiming use of the mark LUMINA on "electric lighting fixtures" since at least as early as 1989.

[4] "Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public." [15 U.S.C. §1055].

established its standing to maintain this opposition proceeding.[5]

Opposer's priority

As noted above, the undisputed evidence of record establishes that opposer has used its LUMINA trademark continuously since at least 1992 in connection with electric lighting fixtures, a date well prior to the earliest date upon which applicant can rely, i.e., its August 9, 1996 application filing date. Hence, we find that opposer has also established its priority.

Likelihood of Confusion

We turn then to the substantive issue before us, namely, the question of likelihood of confusion.

Opposer contends that even if LUMINA is a suggestive designation as applied to lighting fixtures, its mark is entitled to protection from applicant's nearly identical mark used on the same and closely related goods.

[5] As noted, the evidence demonstrates opposer's common law rights. Hence, opposer's proving ownership of a later-filed, co-pending trademark application is not in any way critical to establishing standing herein. In any case, on this disputed point, we find that opposer has shown a chain of title for that application from National Services Industries, Inc. (the original applicant in the pending application) to NSI Enterprises, Inc. (opposer herein).

By contrast, applicant contends that "Lithonia Lightings' use of the term 'lumina' is merely descriptive or generic" (applicant's brief, p. 6) and is "incapable of distinguishing Lithonia Lightings' one piece contoured diffusers" (applicant's brief, p. 12); that the record reflects "little if any similarity of goods" between opposer's *catalogs* and applicant's *lighting fixtures* (applicant's brief, p. 19); that when compared in their entireties, applicant's stylized LUMINA mark has a vastly different appearance from the plain typeface of opposer's LUMINA mark; that there are "differences in the trade channels" (applicant's brief, p. 20); and that opposer has failed to demonstrate a single instance of actual confusion on the part of consumers (applicant's brief, p. 20).

After careful consideration of the facts before us and the relevant law on the issue of likelihood of confusion, we hold that applicant is not entitled to the registration it seeks.

In the course of determining the question of likelihood of confusion herein, we have followed the guidance of the predecessor to our primary reviewing Court. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). The *du Pont* case sets forth each factor that should be considered, if

relevant information is of record, in determining likelihood of confusion. We begin by looking at the goods of the parties.

The involved application lists “electrical lighting fixtures” among its identified goods. The record shows that the only item on which opposer uses the LUMINA mark is an electric lighting fixture.[6] Hence, for purposes of our likelihood of confusion analysis, these items are legally identical.

As to the actual products sold under these marks, the record shows that opposer, a large lighting fixtures manufacturer, has been using the LUMINA mark on a decorative, ceiling-mounted, fluorescent lighting fixture. This one-piece, contoured, light-diffusing lens is designed to provide general illumination in residential and light commercial applications. Opposer’s literature describes its features as having a “white acrylic lens” that “lifts and shifts off housing for easy maintenance,” creating “soft, uniform illumination” and “presenting a cloud-like appearance.”[7]

---

[6] The relevant uses of the mark appear in opposer’s sales catalogs from the years 1992, 1996 and 2000.

[7] We disagree with applicant’s arguments about opposer’s failure to show use of the LUMINA mark on electric light fixtures. The uses of opposer’s mark in three different sales catalogs (from 1992, 1996 and 2000) clearly comprise displays

Applicant markets and distributes plumbing, HVAC, electrical and hardware products. Its wide range of LUMINA products include smaller, indoor, contractor-grade, decorative, ceiling-mounted lighting fixtures for residential or commercial use.[8] Although applicant's catalog includes larger surface-mounted light fixtures that appear nearly identical to those of opposer,[9] these particular fixtures do not appear to be sold under the LUMINA mark.

Moving beyond applicant's identified lighting fixtures, opposer's lighting fixture is also closely related to the other electrical hardware and lighting components identified in both International Classes 9 and 11 in the opposed application -- particularly applicant's light bulbs, switches, boxes, wires and connectors.

In view of our finding that some of the goods are identical and that others are closely related, and inasmuch as neither party has placed any restrictions on their respective channels of trade, we must presume that the parties' respective goods will move in the same channels of

---

associated with the goods. *Cf. Land's End, Inc. v. Manbeck*, 797 F.Supp. 311, 24 USPQ2d 1314 (E.D. Va. 1992).

[8] Applicant's January-April 1999 catalog contains a special glossy section of LUMINA products (pp. 673-704), having surface mounted fistures on pp. 677 & 678.

[9] Applicant's January-April 1999 catalog, p. 671, 713-714.

trade to the same types of purchasers. Indeed, the testimony of Mr. Baillie on behalf of opposer[10] and the testimony of Mr. McEven on behalf of applicant[11] demonstrate that both parties send promotional catalogs to, *inter alia*, electrical wholesalers, lighting showrooms and facility maintenance personnel.

We continue our analysis by turning next to the similarity or dissimilarity of the respective marks in their entireties as to sound, appearance and meaning.

Applicant argues from dictionary definitions[12] that opposer's LUMINA mark is entitled to a narrow scope of protection in that it is merely descriptive or even generic. We note that the question of descriptiveness or genericness of the term LUMINA for lighting devices is not squarely before us. Furthermore, the dictionary entries submitted by applicant demonstrate only that this term may well be highly suggestive for lighting products. However, even if we were to assume that opposer's mark is weak, we note that "even weak marks are entitled to protection against registration of similar marks" for identical goods. *In re Colonial*

---

[10] Testimony deposition of Douglass M. Baillie, pp. 8-9.

[11] Testimony deposition of Joel L. McEven, pp. 11-12, 21-22.

[12] **Lumen**, n.: pl **LUMINA** 1. A unit of light (luminous power); the light emitted in a unit solid angle (steradian) by a uniform point source of one international candle." Webster's New International Dictionary, Second Edition.

Lumen, n. a unit of luminous flux – the light emitted in one second in a solid angle of one steradian from a point source

Stores, 216 USPQ 793, 795 (TTAB 1982). *See also In re The Clorox Co.,* 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover).[13]

In addition to trying to accord opposer's mark a minimal scope of protection, applicant places significant weight on the fact that its own composite mark contains the word LUMINA in all upper-case, black letters having an accent placed above the letter "U," and that this literal element is then superimposed over a highly-stylized "red squiggle"[14] representing a "lightening bolt."

However, while we must base our determination on a comparison of the respective marks in their entireties, we are guided, equally, by the well-established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in

---

of uniform intensity of one candela … pl. **lumina** … Chambers 20th Century Dictionary, New Edition 1983.

[13] Moreover, as to the *du Pont* factor focused on the number and nature of similar marks in use on similar goods, there is no indication in the record that anyone else is using any variations of LUMINA on related goods.

[14] Opposer is also correct in noting that the drawing is not lined for the color red, so this characterization does not factor into our analysis. On the other hand, to the extent that the squiggle is shown in several contrasting colors throughout applicant's catalogs, the sole word element (LUMINA) presented in black simply stands out visually that much more prominently, by comparison.

stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.,* 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this context, we agree with opposer that applicant cannot rely on its design element to distinguish its mark from opposer's mark. Where a composite mark comprises both word and design elements, the word generally predominates over design elements because the word is what creates an impression upon prospective purchasers and it would be remembered and relied upon in calling for these goods. *See In re Comexa Ltda.,* 60 USPQ2d 1118 (TTAB 2001); and *In re Appetito Provisions Co.,* 3 USPQ2d 1553 (TTAB 1987).

Specifically, it is the literal element of applicant's LUMINA and design mark that would be utilized by consumers when asking about or otherwise referring to its goods. As to sound and meaning, this element is identical to opposer's LUMINA mark. While it does create a somewhat different appearance, the addition of such a background design does not avoid a likelihood of confusion in this case given that the two marks have the same literal elements. The presence of an accent mark and the squiggle design element in applicant's mark are therefore

insufficient to distinguish applicant's mark from opposer's mark. Overall, when utilized in connection with the respective goods of the parties as indicated above, applicant's LUMINA and design mark engenders a commercial impression that is substantially similar to the commercial impression projected by opposer's LUMINA mark.

Applicant argues that under the *du Pont* factor focusing on the length of time during which there has been contemporaneous use of the parties' marks, opposer has provided no evidence of actual confusion between the parties' respective marks.[15] Of course, evidence of actual confusion is notoriously difficult to obtain, so we cannot conclude from the lack of such evidence that confusion is not likely to occur. Moreover, the test is whether there is a likelihood of confusion, not whether actual confusion has occurred. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

[15] While the instant application remains an intent-to-use application for which no statement of use has been filed, the record does show substantial commercial usage of the mark by applicant since sometime in 1996. Applicant's catalog shows thirty-three warehouse locations spread across much of the continental United States, and Mr. McEven testified to more than $20 million in sales of LUMINA products between October 1996 and the end of 2000. Nonetheless, the record does not contain sufficient evidence upon which we might base a conclusion that there has been a meaningful opportunity for actual confusion to have occurred.

In conclusion, we find that opposer has demonstrated its standing to bring this action and has established its priority; and we find that the parties' goods herein are legally identical and otherwise closely related, that the goods move in the same channels of trade to the same types of consumers, that the marks create substantially the same overall commercial impressions, and as a result, that opposer has shown a likelihood of confusion herein.

Decision: The opposition is sustained and registration to applicant is refused as to International Classes 9 and 11.