

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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February 6, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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E-Conolight LLC
v.
Luman Lighting, LTD.
—

Opposition No. 91196949
—

Julie F. Kirby of Jansson Shupe & Munger LTD for E-Conolight LLC

Sergei Orel of Law Office of Sergei Orel, LLC for Luman Lighting Limited
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Before Seeherman, Adlin, and Gorowitz, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Luman Lighting Limited (applicant) filed an application to register the mark LUMAN (in stylized form), as shown below,

LUMAN

for the following Class 11 goods, as amended:

“light bulbs; fittings for discharge lamps and incandescent lamps; electric light bulbs; electric lamps; lamps; LED light bulbs; LED lighting fixtures; LED light assemblies for street lights, signs, commercial lighting, automobiles, buildings and other

architectural uses; LED downlight fixtures; LED lamps; LED street lights; LED lighting fixtures; LED flashlights; electric discharge tubes for lighting; sockets for electric lights; light diffusers; chandeliers; ceiling lights; flares; plastic guard devices for lighting; luminous tubes for lighting; electric torches for lighting; safety lamps for underground use; fluorescent lighting tubes; fluorescent lamps; street lamps; lights for vehicles; lighting apparatus for the theatrical and film stage; lanterns; electric lighting fixtures and fittings for incandescent lamps; apparatus for lighting sports arenas and replacement parts therefor.”¹

E-Conolight LLC (opposer) has opposed the application on the ground of likelihood of confusion (Section 2(d) of the Trademark Act) with its mark LUMA for “various lighting-related goods, including electrical lighting fixtures and related products.” Opposer alleges prior common law use of this mark for its goods and also alleges ownership of Reg. Nos. 1317965 and 3209664.

Applicant filed an answer in which it denied the salient allegations in the notice of opposition.²

Only opposer filed a brief at final hearing.

The Record and Evidentiary Issues

By rule, the record includes the file of the opposed application and the pleadings. Trademark Rule 2.122(b).

¹ Application Serial No. 77822323, filed on September 9, 2009, based on Section 1(b) of the Trademark Act (“intent-to-use”).

² Applicant asserted fifteen “affirmative defenses” with its answer. Most of these “defenses” are really further explanations of the denial of likelihood of confusion. To the extent that applicant pleaded any true affirmative defenses, it did not pursue them and we therefore consider them waived.

Applicant attached a number of documents to the answer, labeled Exhibits A – H. However, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence during the period for the taking of testimony. Trademark Rule 2.122.

Neither party followed the Trademark Rules, particularly with respect to the submission of evidence.

Opposer attached plain copies of the certificates of its pleaded registrations to the notice of opposition, which is insufficient to make the registrations of record.

A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO showing the current status and title of the registration.

Trademark Rule 2.122(d)(1) (emphasis added). Opposer did not otherwise make its pleaded registrations of record, such as by submitting a current printout from the USPTO database showing the current status and title of the registrations, or by submitting the registrations as part of the testimony of a competent witness who testified as to their status and title. See Trademark Rule 2.122(d)(2); *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009). Accordingly, opposer failed to make its registrations of record.

On April 30, 2012, the last day of its testimony period, opposer filed its brief along with the declarations of Julie F. Kirby (its attorney), Theodore O. Sokoly (Executive Vice President of Rudd Lighting, Inc., opposer's parent), and Brad Cors and John Delucco (both customers of opposer). In other words, the brief was filed prematurely and the evidence was not properly introduced.

Absent stipulation by the parties or compliance with Trademark Rule 2.122(d)(1), evidence must be introduced by either testimonial deposition or notice of reliance. *See*: Trademark Rules 2.122 and 2.123. As such, the declarations submitted would not normally have been considered. However, on August 21, 2012, the parties filed a “Joint Motion to Reset Remaining Schedule and to Establish Various Points on Evidence and Evidence-Taking,” in which they requested the reopening and resetting of pretrial disclosures and trial dates, and stipulated to the admission of evidence by declaration and in manners other than deposition. The motion was granted on August 28, 2012. Accordingly, the declarations and exhibits submitted in accordance with the stipulation, including applicant’s responses to certain of opposer’s interrogatories and requests for admission, are part of the record.

Applicant re-submitted all of the documents that were attached to its answer and, in view of the parties’ stipulation, these documents are also of record. They include USPTO assignment abstracts of title for Reg. Nos. 1317965 and 3209664; pages from both applicant’s website and opposer’s website; dictionary and Wikipedia entries; a webpage from the website of third-party, Luma Lighting Design (www.lumald.com); and third-party registrations for marks containing the term LUMA.

Analysis

- Standing

To establish standing, opposer must rely on its common law use. Opposer has shown through declarations that it has used and continues to use the mark LUMA for electric lamps and electric lighting fixtures. As such, opposer has established its standing in this proceeding. *See: Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1324-25 (Fed. Cir. 1987); *Kistner Concrete Products, Inc. v. Contech Arch Technologies, Inc.*, 97 USPQ2d 1912, 1918 (TTAB 2011).

We note that applicant, in its answer, asserted as a defense that opposer did not have standing to bring this opposition. According to applicant, opposer is not the owner of the pleaded registrations because its predecessor-in-interest, Ruud Lighting, Inc., did not “fully” own the registrations at the time the registrations were assigned to opposer. It appears that applicant is relying on information contained in the USPTO abstracts of title for opposer’s two pleaded registrations, and that the descriptions of the recorded documents in the abstracts may have led to some confusion. Because we have found that opposer did not properly make these registrations of record, we are not relying on these registrations to show opposer’s standing. As such, we will not discuss the information on the abstracts in detail. Suffice it to say that based on the brief descriptions of the instruments in the abstracts we cannot conclude that opposer is not the owner of the registrations.

- Priority

Since Opposer has not made its pleaded registrations of record, to establish priority it must rely on its common law rights. Opposer’s parent,

Ruud Lighting, Inc. (Ruud), acquired the business of Luma Lighting Industries, Inc. in 1993, at which time it started manufacturing and selling electrical lighting fixtures under the LUMA trademark. Such use has been continuous. Sokoly Declaration, par. 3. Ruud started using the mark LUMA in connection with electric lamps in or about October 2005 and the mark has been used continuously in connection with these products ever since. Sokoly Declaration, par. 4.³

Applicant has not submitted any evidence of use of the mark LUMAN (in stylized form) in the United States. Therefore, for the purpose of establishing priority in this proceeding, applicant is considered to have constructive use of the mark as of September 9, 2009, the filing date of its application. *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991).

Accordingly, Opposer has established prior common law rights in the mark LUMA for electrical lighting fixtures and electric lamps.

- Likelihood of confusion.

The only ground for opposition is likelihood of confusion. Our determination of this issue 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 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We find that there is a likelihood of confusion.

³ In March 2010 opposer was formed and Ruud assigned all of its rights in the LUMA trademark to it. Sokoly Declaration, par. 5

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See: Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The marks at issue are: **LUMA** and **LUMAN**.

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed.Cir. 2005).

The marks LUMA and LUMAN (stylized) are very similar in appearance, both beginning with the letters LUMA. Although applicant's mark also has the additional final letter "N," and the "A" is somewhat stylized, this is not sufficient to distinguish the marks. *See: In re Mighty Leaf Tea*, 94 USPQ2d 1257, 1258 (Fed. Cir. 2010) (likelihood of confusion found between the use of the mark ML in standard character form for skin care products and ML Mark LEES (stylized ML) for skin care products). The stylized "A" will still be recognized as an "A." As for pronunciation of the mark, the stylized "A" will be pronounced as an "A", and the terminal letter "N" does not significantly change the way the marks sound. Both marks also are suggestive of "lumen," which, as the definition submitted by applicant shows, is a unit of light measurement defined as "a unit of luminous flux equal to the light emitted in a unit solid

angle by a uniform point source of one candle intensity.”⁴ Therefore, the marks are similar in connotation and commercial impression.

As noted, opposer’s mark is suggestive of “lumen,” and therefore is not entitled to as broad a scope of protection as a more arbitrary mark.⁵ However, suggestive marks are still entitled to protection against the registration of very similar marks for identical goods, as is the case here. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (C.C.P.A. 1974).

Next, we look at the similarities between the goods at issue. The declarations submitted by opposer show that it uses the mark LUMA in connection with electrical lighting fixtures and what it describes as “electric lamps.” Sokoly Declaration, pars. 3 and 4. The catalog submitted as an exhibit to the Sokoly Declaration shows the latter goods as light bulbs, and in this connection, we take judicial notice of the definition of “light bulb” from the Merriam-Webster On-Line Dictionary (m-w.com), which is: “an electric lamp: as *a*: one in which a filament gives off light when heated to incandescence by an electric current — called also *incandescent*, *incandescent lamp*, *b*: fluorescent lamp.” The goods in the opposed application include light bulbs, incandescent

⁴ Merriam-Webster On-Line Dictionary (m-w.com).

⁵ Applicant has submitted some third-party registrations for LUMA formative marks, three of which are for light-related goods. Although these registrations are not evidence that the marks are in use, and certainly do not show that LUMA is generic or descriptive as applicant asserted in its answer, they indicate that LUMA has a suggestive significance.

lamps, electric light bulbs, electric lamps, fluorescent lamps, electric lighting fixtures and fittings for incandescent lamps. Opposer's electric lamps and electrical lighting fixtures are legally identical to, at the very least, applicant's identified light bulbs, electric light bulbs, electric lamps and electric lighting fixtures. It has long been held that, if there is likely to be confusion with respect to any item in the identification of goods for a particular class of goods, likelihood of confusion must be found as to the entire class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Opposer has testified that its primary customers are electrical contractors, particularly small and medium-size contractor businesses, and that it aggressively markets its products to them through its websites (www.e-conolight.com and www.lumalamps.com) and by publishing and mailing catalogs every six or seven weeks to approximately 165,000 such businesses. Sokoly Declaration, pars. 11-12. Because applicant's goods are legally identical, in part, to the goods of opposer, and applicant's identification of goods includes no limitations as to channels of trade, the parties' goods must be deemed to be sold in the same channels of trade, i.e., to electrical contractors.

We acknowledge that electrical contractors are professionals, and we have often found that professionals are sophisticated purchasers, or exercise greater care in making their purchases than the general public. However, in the case of electric lamps, i.e., light bulbs, these are such ordinary items that it

is not clear that electrical contractors will exercise particular care when purchasing them. In any event, even if we were to find that this factor favors applicant, we find that it does not obviate the likelihood of confusion. That is, because the marks are so similar and the goods are identical, even sophisticated consumers are likely to be confused. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (“even sophisticated purchasers can be confused by very similar marks”).

In addition, opposer testified that it uses its mark on its products to establish a reputation with the general public (i.e., the end users of its products) and that it provides contact information to assist the end users in obtaining replacement products themselves, rather than through contractors.⁶ Thus, the general public is exposed to opposer’s mark, and may purchase replacement bulbs for the originals supplied by contractors. Such purchasers could, on a visit to a hardware store to purchase replacement bulbs, encounter applicant’s light bulbs and, because of the similarity of the marks, assume that they come from the same source.

After considering all of the evidence of record and balancing all of the applicable *du Pont* factors, whether specifically discussed herein or not, we conclude that use of applicant’s mark for its goods is likely to cause confusion with opposer’s mark for its goods.

⁶ Sokoly Declaration, par. 17.

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Decision: The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act.