



Trademark Trial and Appeal Board Holds that a Formerly Registered Mark is Not Automatically Entitled to Re-Registration

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In *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009), the Trademark Trial and Appeal Board affirmed the Trademark Office's refusal to re-register a trademark based on a likelihood of confusion with two registered marks that it had coexisted with on the Register.

Davey Products Pty Ltd. ("DP"), had owned a registration of DAVEY for "electric motors for machines; waterpumps with fluid flow or pressure control for domestic, industrial and commercial use; and parts and fittings therefore" (Reg. No. 2,327,761). The Trademark Office cancelled this registration because DP failed to file a declaration of continued use under Section 8 of the Trademark Act. About a month after this cancellation, DP filed a new application to register the same mark for the same goods.

This time, the Trademark Office refused registration based on a likelihood of confusion with two other DAVEY marks: DAVEY (Reg. No. 2,275,634, for "air compressors and parts therefore"); and DAVEY QUIETFLO (Reg. No. 1,491,960, for "air compressors"). Both of these registrations had been on the register when DP's original DAVEY registration issued.

DP argued that it merely sought a return to the status quo; its mark had registered once despite these prior references, and should do so again. The Board disagreed, pointing out that cancellation destroys prior presumptions and "makes the question of registrability 'a new ball game' which much be predicated on current thought." The prior Examining Attorney's decision has no effect on a subsequent application.

The Board thus performed a full likelihood of confusion analysis, considering 11 of the 13 *du Pont* factors. Most weighed against registration (e.g., similarity of the marks, similarity of the goods, similarity of trade channels). Some were neutral (e.g., fame of the prior mark, third-party use on



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similar goods). Only the miscellaneous *du Pont* factor, which requires consideration of any probative facts, weighed at all in DP's favor.

Under this factor, the Board considered DP's argument that the two cited registrations appeared, for a time, to be owned by two different entities. The Board noted, however, that at the time the application that matured into Reg. No. 2,275,634 published, it was owned by the entity that owned the DAVEY QUIETFLO registration. The record also indicated that both registrations' owners were closely related. In any event, the coexistence of two confusingly similar marks, which arguably should not have registered over each other, does not justify adding another confusingly similar mark to the Register.

[In re Davey Products Pty Ltd., Ex parte Appeal No. 77029776 \(TTAB 2009\)](#)

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