

UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

Welding Services, Inc. v. Forman

509 F.3d 1351 (11th Cir. 2007) · No. No. 06-13174 · Decided December 17, 2007

SUMMARY

The Eleventh Circuit affirmed summary judgment against Welding Services, Inc. on its Lanham Act service-mark infringement claim. The court held that “welding services” was generic and that Welding Services had not shown the abbreviation “WSI” had a distinct protectable meaning. Although the court did not decide whether the stylized WSI logo was protectable, it concluded that the logos were not confusingly similar and that the evidence did not establish a likelihood of confusion.

CASE DETAILS

|                       |                                                                                                                                                                                                                   |
|-----------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| COURT                 | United States Court of Appeals for the Eleventh Circuit                                                                                                                                                           |
| WRITING FOR THE COURT | John R. Gibson, Circuit Judge; Edmondson, Chief Judge; Tjoflat, Circuit Judge; Gibson, Circuit Judge                                                                                                              |
| JURISDICTION          | Federal                                                                                                                                                                                                           |
| DECIDED               | December 17, 2007                                                                                                                                                                                                 |
| DOCKET                | No. 06-13174                                                                                                                                                                                                      |
| DISPOSITION           | affirmed                                                                                                                                                                                                          |
| PROCEDURAL POSTURE    | Welding Services, Inc. appealed the district court's grant of summary judgment to Welding Technologies, Inc. and related defendants on a Lanham Act service-mark infringement claim and certain state-law claims. |
| STANDARD OF REVIEW    | De novo review of the grant of summary judgment; the evidence is viewed in the light most favorable to the nonmoving party, without weighing evidence or making credibility determinations.                       |
| PRECEDENTIAL VALUE    | precedential                                                                                                                                                                                                      |
| PARTIES               | Welding Services, Inc. v. Terry Forman, Welding Technologies, Inc., Robert Henson, Charles Jones, Rod Forman                                                                                                      |

TOPICS

- trademark infringement
- trademark law
- summary judgment
- appellate procedure

## PRACTICE AREAS

intellectual property

trademark infringement

commercial litigation

civil procedure

## QUESTIONS PRESENTED

1. Whether Welding Services had shown that the abbreviation WSI was protectable as a service mark despite the generic nature of the words 'welding services.'
2. Whether the stylized WSI logo was protectable.
3. Whether Welding Technologies' WTI logo created a likelihood of confusion under the Lanham Act.
4. Whether summary judgment was proper on the federal service-mark infringement claim.

## HOLDINGS

1. The words 'welding services' were generic as applied to the parties' welding services and therefore were not protectable as a trademark or service mark.
2. Welding Services did not show that WSI had a meaning distinct from the generic words 'Welding Services Inc.' in the minds of the public; therefore, WSI was not shown to be protectable.
3. The court declined to decide whether the stylized WSI logo was sufficiently distinctive to be protectable because the absence of a likelihood of confusion independently supported summary judgment.
4. Welding Services failed to present sufficient evidence of a likelihood of confusion between the logos, and summary judgment was therefore proper.

## KEY QUOTATIONS

*"Accordingly, we hold that Welding Services had not shown "WSI" to be protectable."* (509 F.3d at 1360)

*"Welding Services has not come forward with sufficient proof of likelihood of confusion of the logos to warrant a trial of the issue."* (509 F.3d at 1361)

## FACTUAL BACKGROUND

Welding Services had used the abbreviation WSI since 1990 and a stylized circular WSI logo since 1994 in connection with heavy-industrial equipment-maintenance services. Welding Technologies was formed in 2003, and former Welding Services employees later acquired it; Welding Technologies used the abbreviation WTI with an orange rotational-design logo. Welding Services claimed that the WTI marks were confusingly similar to its WSI marks, but the court found the logos visually dissimilar and the evidence of actual confusion weak and potentially attributable to the defendants' former association with Welding Services.

## PROCEDURAL HISTORY

Welding Services sued alleging infringement of its WSI abbreviation and stylized logo under section 1125(a)(1) (A) of the Lanham Act, along with state-law claims. The parties filed cross-motions for summary judgment on the Lanham Act claim, and Welding Technologies moved for summary judgment on the unfair-competition and deceptive-trade-practices claims. The district court granted summary judgment to Welding Technologies on

those claims and declined supplemental jurisdiction over the remaining state claims, dismissing them; the Eleventh Circuit affirmed.

## DISPOSITION

affirmed

## CASES CITED

- *Stewart v. Booker T. Washington Ins.*, 232 F.3d 844, 848 (11th Cir. 2000)
- *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986)
- *Bircoll v. Miami-Dade County*, 480 F.3d 1072, 1088 n. 21 (11th Cir. 2007)
- *Int'l Stamp Art, Inc. v. U.S. Postal Serv.*, 456 F.3d 1270, 1274 (11th Cir. 2006) (per curiam)
- *Schwartz v. Millon Air, Inc.*, 341 F.3d 1220, 1225 n. 4 (11th Cir. 2003)
- *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 381-83 (2d Cir. 2005)
- *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1992)
- *Colt Defense LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 705 (1st Cir. 2007)
- *Coach House Rest., Inc. v. Coach & Six Rests., Inc.*, 934 F.2d 1551, 1560 (11th Cir. 1991)
- *Investacorp, Inc. v. Arabian Inv. Banking Corp.*, 931 F.2d 1519, 1523, 1525 (11th Cir. 1991)
- *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1183-85 & n. 20 (5th Cir. 1980)
- *Nat'l Conference of Bar Exam'rs v. Multistate Legal Studies*, 692 F.2d 478, 487 (7th Cir. 1982)
- *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1039 (D.C. Cir. 1989)
- *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985)
- *Am. Television & Communications Corp. v. Am. Communications & Television, Inc.*, 810 F.2d 1546, 1548-49 (11th Cir. 1987)
- *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 115 & n. 11, 118 (5th Cir. 1979)
- *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513-14 (11th Cir. 1984)
- *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 993-94 (7th Cir. 1989)
- *Anheuser-Busch, Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 635-36 (8th Cir. 1984)
- *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504, 506 (C.C.P.A. 1956)
- *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 11 (5th Cir. 1974)
- *Schwan's IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 974 (8th Cir. 2006)
- *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790-91 (5th Cir. 1983)
- *Retail Servs. Inc. v. Freebies Publ'g*, 364 F.3d 535, 545 (4th Cir. 2004)
- *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 383 (2d Cir. 2005)
- *Custom Mfg. & Eng'g, Inc. v. Midway Servs., Inc.*, 508 F.3d 641, 2007 WL 4165634, at \*3 (11th Cir. Nov. 21, 2007)
- *Dippin' Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1207-08 (11th Cir. 2004)
- *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259 (5th Cir. 1980)

- Freedom Sav. & Loan Ass'n v. Way, 757 F.2d 1176, 1185 (11th Cir. 1985)
- Borinquen Biscuit Corp. v. M.V. Trading Corp., 443 F.3d 112, 117 & n. 2 (1st Cir. 2006)

---

Retrieved from lawtools.ai · <https://lawtools.ai/cases/federal/eleventh-circuit/2007/welding-services-inc-v-forman-88ldnhcj>