

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Scorpion Protective Coatings, Inc.
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Serial No. 86617791

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for Scorpion Protective Coatings, Inc.

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Before Cataldo, Greenbaum and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Scorpion Protective Coatings, Inc. (“Applicant”) seeks registration on the Principal
Register of the mark CREATE PAINT (in standard characters) for

Paints for creating dry erase surfaces; paints, in
International Class 2.¹

The word “PAINT” has been disclaimed.

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¹ Application Serial No. 86617791 was filed on May 2, 2015, based upon Applicant’s allegation of first use of the mark and first use in commerce since October 1, 2014 under Section 1(a) of the Trademark Act.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis of a registration for the mark set forth below, PAINT 'N CREATE (stylized with design)



for “paints” in International Class 2.² The Examining Attorney asserts that Applicant’s mark so resembles this registered mark that, as used in connection with Applicant’s identified goods, it is likely to cause confusion or mistake or to deceive.³

When the refusal was made final, Applicant appealed. We reverse the refusal to register.

I. Likelihood of Confusion.

Our determination of the issue of likelihood of confusion 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.

² Reg. No. 4789364, issued August 11, 2015 to ArtSkills, Inc. The registration includes the following description of the mark: “The mark consists of the words ‘PAINT 'N CREATE’ in stylized font inside a stylized design of a paint splash. The words ‘PAINT 'N’ are stacked above the word ‘CREATE.’ A stylized design of bubble appears above the words.” Color is not claimed as a feature of the mark. The registration also includes goods in Class 16, which are not relevant to our determination.

³ Registration was also refused on the basis of a likelihood of confusion with Registration No. 3959416 for the mark CRE-8 (in standard characters) for “coatings in the nature of paints for creating dry-erase writing surfaces” in International Class 2, which was cancelled on December 15, 2017 for failure to file a declaration of use. Accordingly, this refusal is dismissed as moot with regard to Registration No. 3959416.

2003). 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 Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). USPQ2d 1531 (Fed. Cir. 1997).

A. Similarity or dissimilarity and nature of the goods, class of purchasers and channels of trade.

We start by evaluating the second and third *du Pont* factors, the similarity and nature of the goods; and the channels of trade and class of purchasers. Applicant argues that the goods in the cited registration are different from Applicant's goods since they are "used for children's paint." Appeal Brief, 4 TTABUVE 17. The relationship of the goods must be determined by the identifications of the goods in the application and cited registration. *In re Total Quality Grp. Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). As identified, the goods are identical in part, and otherwise legally identical.

When determining the relationship between the goods,

the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application. This is so regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Stone Lion Capital Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014) (citations omitted).

Applicant's and Registrant's goods, both identified as "paints," are identical. In addition, Applicant's "paints for creating dry erase surfaces" are subsumed under the more broadly identified "paints" identified in the cited registration. Since the goods are identical and there is no restriction in the channels of trade, "they are presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

Therefore, the second and third *du Pont* factors favor a finding of likelihood of confusion.

B. Similarity of marks.

The marks at issue are CREATE PAINT and PAINT 'N CREATE (stylized with design), as set forth below.



To determine whether the marks are similar, we must consider the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Further, when evaluating a composite mark containing both words and designs, such as the cited mark, the verbal portion of the mark is typically the one most likely to indicate the origin of the goods to which it is affixed because it is the portion of the

mark that consumers would use to refer to or request the goods. *In re Viterra Inc.*, 101 USPQ2d at 1908. *See also In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1593-95 (TTAB 1999).

The Examining Attorney argues that the marks are similar in appearance, sound and meaning since “both marks are comprised of the same wording, CREATE PAINT and PAINT ’N CREATE, which is the dominant element of the [R]egistrant’s mark and the dominant and only element of [A]pplicant’s mark.” Examining Attorney Brief, 6 TTABVUE 5. We agree that the marks at issue contain the same words, CREATE and PAINT, with the positioning transposed, and that the dominant element of Registrant’s mark is the literal phrase, PAINT ’N CREATE, however we do not agree that the marks have the same or similar meanings.

Applicant argues that the cited mark “creates a vastly different commercial impression than that of Applicant’s mark.” Appeal Brief 4 TTABVUE 12. In particular Applicant contends that the use of the apostrophe “n” in Registrant’s mark “is very unlikely to occur outside of the context of children’s products.” *Id.* Although Applicant had not submitted evidence supporting this contention, the appearance of the mark suggests that Registrant’s products are for children, with words “PAINT ’n CREATE” in a juvenile font combining upper and lower case letters in the same word “PaiNT ’n CREATe,” on top of a stylized cloud, all of which look like they could have been drawn by children.

In addition, Applicant argues that in its mark, the word “create” is either an adjective or a verb modifying the word “paint.” We agree that in Applicant’s mark the

word “create” does modify the word “paint” and we find that it connotes the creation of paint. To the contrary, we find that the cited mark, PAINT ‘N CREATE in the stylized font within a cloud, discussed *supra*, connotes the creation of artwork by children, using paint.

“[T]he reversal in one mark of the essential elements of another mark may serve as a basis for a finding of no likelihood of confusion **only** if the transposed marks create distinctly different commercial impressions.” *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988), (emphasis added). *See also Bank of Am. Nat’l Trust and Sav. Assn. v. Am. Nat’l Bank of St. Joseph*, 201 USPQ 842, 845 (TTAB 1978), and cases cited therein. Cases on point include *In re Mavest, Inc.*, 130 USPQ 40 (TTAB 1961) (finding no likelihood of confusion between the marks TOWN SQUIRES and SQUIRETOWN because transposition of words creates distinctly different commercial impressions); and *In re Akzona Inc.*, 219 USPQ 94 (TTAB 1983) (finding no likelihood of confusion between SILKY TOUCH for synthetic yarns and TOUCH O’ SILK for men’s dress shirts, sport shirts, and pajamas because of different commercial impressions). As discussed *supra*, the commercial impressions of Applicant’s mark and the cited mark are different. Therefore, we do not find the marks to be similar when compared in their entireties.

II. Conclusion.

Having considered all the evidence and arguments on the relevant *du Pont* factors, whether discussed herein or not, we find that despite the identical nature of Applicant’s and Registrant’s goods, Applicant’s mark CREATE PAINT, in standard

characters, is not likely to cause confusion with the cited mark PAINT 'N CREATE

(stylized with design) , when used in connection with “paints.” See *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

Decision: The refusal to register Applicant's mark CREATE PAINT is reversed.