

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing: August 13, 2020

Mailed: August 20, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

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In re Creativity IP PLLC

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Serial No. 88120181
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Manuel Cordovez of Creativity IP PLLC, pro se.

Nora Buchanan Will, Trademark Examining Attorney, Law Office 116,
Elizabeth F. Jackson, Acting Managing Attorney.

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Before Zervas, Pologeorgis, and Lebow,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Creativity IP PLLC (“Applicant”) seeks registration on the Principal Register of the standard character mark CREATIVITY IP (“IP” disclaimed) for “legal services” in International Class 45.¹

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the mark CREATIVITY LAW (in standard characters;

¹ Application Serial No. 88120181, filed on September 17, 2018, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming August 3, 2015 as the date of first and April 20, 2018 as the date of first use in commerce.

“LAW” disclaimed) registered on the Principal Register for “legal services for the enforcement, licensing, use, establishment and maintenance of intellectual property rights” in International Class 45.²

When the refusal was made final, Applicant appealed and requested reconsideration. When the request for reconsideration was denied, this appeal resumed. The appeal is fully briefed. An oral hearing was held on August 13, 2020. For the reasons explained below, we affirm the refusal to register.³

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular

² Registration No. 3562636, issued on January 13, 2009; renewed.

³ The TTABVue and Trademark Status & Document Retrieval (“TSDR”) citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

determination.”).

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity of the Services

We initially turn to the comparison of the services under the second *DuPont* factor. In making our determination regarding the relatedness of the services, we must look to the services as identified in Applicant’s application and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods [or services], the particular channels of trade or the class of

purchasers to which the sales of goods [or services] are directed.”); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Applicant’s services are identified as “legal services.” The Registrant’s services are identified as “legal services for the enforcement, licensing, use, establishment and maintenance of intellectual property rights.” Because the identification of services recited in Applicant’s involved application contains no limitations, Applicant’s “legal services” are presumed to encompass all types of legal services, including the more delineated legal services provided by Registrant under its registered mark. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the goods [or services] in an application or registration are broadly described, they are deemed to encompass all the goods [or services] of the nature and type described therein); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018) (same). As such, Registrant’s services are encompassed within Applicant’s services and they are therefore legally identical in part.

Thus, the second *DuPont* factor strongly favors a finding of likelihood of confusion.

B. Similarity of Trade Channels and Classes of Purchasers

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. Because Applicant’s and Registrant’s services are legally identical in part, we must presume that these services travel through the same channels of trade

and are offered to the same or overlapping classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

Accordingly, the third *DuPont* factor also weighs in favor of finding a likelihood of confusion.

C. Similarity of the Marks

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 369 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic, LLC*, 123 USPQ2d at 1748 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Although marks must be considered in their entireties, it is settled that one

feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re Viterra Inc.*, 101 USPQ2d at 1908; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“There is nothing improper in 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. Indeed, this type of analysis appears to be unavoidable.”). Further, where, as here, the services at issue are in-part legally identical, the degree of similarity between the marks necessary to find a likelihood of confusion declines. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Grp., Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

Applicant’s mark is CREATIVITY IP in standard characters and the cited mark is CREATIVITY LAW also in standard characters. Due to the shared term CREATIVITY, the marks are similar in appearance, sound, connotation and commercial impression. The addition of a merely descriptive or generic term in Applicant’s mark, i.e., “IP”, and Registrant’s mark, i.e., “LAW,” which have been disclaimed, does not detract from the similarity of the marks. Disclaimed matter that is descriptive of or generic for a party’s services is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TRADEMARK MANUAL OF EXAMINING

PROCEDURE (“TMEP”) §§ 1207.01(b)(viii) and (c)(ii) (October 2018).

Moreover, both marks begin with the identical term CREATIVITY. It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered when making purchasing decisions. *Palm Bay Imps., Inc.*, 73 USPQ2d at 1692; *see also Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). As such, consumers will focus more on the term CREATIVITY in both Applicant’s mark and Registrant’s mark as the source-indicator for the parties’ respective services.

In challenging the refusal, Applicant maintains that its applied-for mark is distinct from the cited mark visually, aurally and in overall commercial impression.⁴ Specifically, Applicant contends that the marks at issue differ in the number of syllables that comprise the marks, their pronunciation and cadence, and their overall sound due to the added (disclaimed) wording.⁵ Applicant further maintains that the term “IP” constitutes the dominant element of its applied-for mark and drives its commercial impression.⁶ Additionally, Applicant contends that the term “IP” is merely suggestive and not descriptive of Applicant’s identified services.⁷

Applicant also argues that the term CREATIVITY is diluted when used in connection with legal services and, as a result, consumers will look to other elements,

⁴ Applicant’s Appeal Brief, pp. 5-9, 7 TTABVUE 10-14.

⁵ *Id.* at p. 6; 7 TTABVUE 11.

⁶ *Id.* at p. 7; 7 TTABVUE 12.

⁷ *Id.* at p. 8; 7 TTABVUE 13.

such as the purported dominant term “IP” in Applicant’s mark, to distinguish the marks at issue.⁸ In support of this argument, Applicant submitted copies of the following third-party registrations:⁹

Reg. No.	Mark	Relevant Services
2417346	WE SPECIALIZE IN THE LAW OF CREATIVITY	“legal services, namely prosecution, protection, licensing, litigation, and dispute resolution of patent, trademark, copyright, trade secret, and unfair competition matters” in Class 45.
3756862	COLLABORATIONS IN CREATIVITY & THE	“Providing news, information and

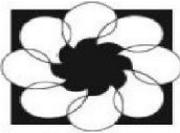
⁸ *Id.* at p. 15; 7 TTABVUE 20.

⁹ April 3, 2019 Response to Office Action, TSDR pp. 16-28; October 9, 2019 Request for Reconsideration, TSDR pp. 21-23, 25, 30-33, 38-46, 49-52, 57-64, and 73-80.

Applicant also submitted numerous third-party registrations for marks including the term CREATIVITY or variations thereof for goods and services that are unrelated to Registrant’s legal services. *See* October 9, 2019 Request for Reconsideration, TSDR pp. 24, 26-29, 33-35, 47-48, 53-56, and 65-72. Because these third-party registrations have no bearing on the determination of the scope of protection afforded the cited CREATIVITY LAW mark for the services provided thereunder, they are given no further consideration. *See Kay Chems., Inc. v. Kelite Chems. Corp.*, 464 F.2d 1040, 1042, 175 USPQ 99, 101 (CCPA 1972); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (third-party registrations found to be of limited value because goods identified in the registrations appeared to be in fields which were far removed from the involved products).

Additionally, Applicant submitted a copy of a third-party registration for the mark SYNTHETIC CREATIVITY for “Consulting in the field of intellectual property licensing; intellectual property consultation; patent and industrial property consultation; providing information about intellectual and industrial property rights; providing information in the field of intellectual property,” in Class 45. *See* October 9, 2019 Request for Reconsideration, TSDR pp. 36-37. This registration, however, has been canceled. A canceled registration has limited, if any, probative value and, in any event, is not evidence of use of a mark or that the public is familiar with its use. *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018) (a cancelled registration is not evidence of use of the mark at any time); *In re Pedersen*, 109 USPQ2d 1185, 1197 (TTAB 2013) (citing *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 1248, 178 USPQ 46, 47 (CCPA 1973) (statutory benefits of registration disappear when the registration is cancelled)). Thus, we give no further consideration to this particular third-party registration.

Reg. No.	Mark	Relevant Services
	LAW	commentary in the field of law by means of a global computer network,” in Class 45.
4581512	<p>MERAKI LAW (LAW disclaimed) (The English translation of MERAKI in the mark is used to describe doing something with soul, creativity, or love; putting something of oneself into what one is doing.)</p>	“Legal consultation services; Legal services; Legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of business law, real estate law, civil law, estates and trusts, and employment law; Providing customized legal information, counseling, and advice, and litigation services in the field of business law, real estate law, civil law, estates and trusts, and employment law,” in Class 45.
4731148	<p>CREATIVE GENUIS LAW (LAW disclaimed)</p>	“Legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of transactional, intellectual property, social media, advertising, marketing and promotions law,” in Class 45.

Reg. No.	Mark	Relevant Services
4907825	 <p>CREATIVE LAW NETWORK (LAW NETWORK disclaimed)</p>	<p>“Legal services, namely, providing customized documentation, information, counseling, advice and consultation services in all areas of business, intellectual property, and entertainment law,” in Class 45.</p>
5614549	<p>THE CREATIVE LAW SHOP (LAW SHOP disclaimed)</p>	<p>“Downloadable contract and business form templates for small business owners” in Class 9.</p>
3487819	<p>DRAWING ON OUR ... CREATIVITY</p>	<p>“Legal services,” in Class 45.</p>
3988423	<p>CREATIVITY IN BLOOM</p>	<p>“Providing an on-line database featuring information on intellectual property and annotated links to other information on intellectual property from other sources; providing news in the field of intellectual property; providing a website featuring information in the field of intellectual property,” in Class 45.</p>
4468910	<p>TECHNOLOGY PROTECTING CREATIVITY</p>	<p>“Intellectual property watch services, namely, providing electronic monitoring and tracking of intellectual property for others, and investigating use and potential misuse or abuse of intellectual property rights by third parties;</p>

Reg. No.	Mark	Relevant Services
		licensing of intellectual property for others; consultation in the field of intellectual property licensing; consultation services in the field of intellectual property monitoring and tracking services,” in Class 45.
4556793	UNEQUALED CREATIVITY, ABSOLUTE PARTNERHSIP: GAME- CHANGING ADVANTAGES	“Legal services,” in Class 45.
4528499	 <p>(LITIGATION, EXPERIENCE, METHOD, EFFICIENCY and CREATIVITY disclaimed)</p>	“Providing online educational information in the fields of litigation practice, professional development in the legal field and law firm client development,” in Class 45.
4794711	ADDING EXCLUSIVITY TO YOUR CREATIVITY	“Legal services,” in Class 45.
4927224	UNLEASH YOUR CREATIVITY	Legal services; Legal services, namely, intellectual property consulting services in the field of identification, strategy, analytics, and invention; Legal services, namely, preparation of applications for trademark registration,” in Class 45.
5125479	EMPOWERING CREATIVITY	“Legal services,” in Class 45.

Reg. No.	Mark	Relevant Services
5867190	IDENTIFYING, SECURING AND ADVANCING CREATIVITY	“Legal services in the field of intellectual property law,” in Class 45.

We find Applicant’s arguments unpersuasive. The Federal Circuit has held that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the common element has some non-source identifying significance that undermines its conceptual strength as an indicator of a single source.¹⁰ *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

We initially note that cited mark issued on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act.

¹⁰ Because Applicant did not provide evidence of any third-party use of marks consisting of or comprised of the term CREATIVITY for the same or similar services as identified in the cited registration, we have no evidence of commercial weakness. *See Palm Bay Imps.*, 73 USPQ2d at 1693 (“Evidence of third-party use of similar marks on similar goods [or services] is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059 (TTAB 2017) (“As to commercial weakness, ‘the probative value of third-party trademarks depends entirely upon their usage’”) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693).

Accordingly, we find Registrant's CREATIVITY LAW mark, when viewed in its entirety, is inherently distinctive and, therefore, is entitled to the normal scope of protection accorded an inherently distinctive mark.

With regard to Applicant's third-party registration evidence, we observe that some of the third-party registrations identify services which differ significantly from the legal services identified in the cited mark such as information services in the field of intellectual property, intellectual property watch services, providing legal forms via the Internet, and providing online educational information in the fields of litigation practice, professional development in the legal field and law firm client development. The use of the term CREATIVITY in these registered marks hence does not affect the scope of protection afforded the cited mark.

As for the remaining third-party registrations for legal services, we find that some of these registered marks are slogans which convey a commercial impression different from the cited mark. As such, these registrations also do not diminish the scope of protection afforded to the cited mark. Further, some of these third-party registrations do not even contain the term CREATIVITY but instead include the term CREATIVE, which has a different connotation.¹¹ These registrations also do not support a finding that term CREATIVITY is somehow diluted as applied to legal services.

¹¹ With regard to the third-party registration for the mark MARAKI LAW, we find that although the English translation of the term MARAKI provided in the registration may be translated to mean doing something with creativity, the mark is nonetheless dissimilar in sound and appearance as compared to the cited CREATIVITY LAW mark. We find that such dissimilarities support a finding that this particular registered mark does not diminish the scope of protection accorded the cited mark.

We also find Applicant's contention that the phrase "IP" in its applied-for mark constitutes the dominant element of the mark and is merely suggestive of Applicant's identified services unavailing. By disclaiming the letters "IP" in its mark, Applicant has conceded that these letters are merely descriptive of its identified services. *See In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2014 n.4 (TTAB 1988). Indeed, Applicant's own specimen of record demonstrates that Applicant provides legal services in the field of intellectual property:¹²



Intellectual Property Services

Intellectual Property (IP) is the general term used to refer to the legal devices that protect your ideas, creations, and brands. IP not only protects what you create, but also defines it in a legal sense so that you can gain financially from licensing and sales.

Generally, there are four types of IP: Patents, Trademarks, Copyrights, and Trade Secrets. Each is used to protect your creation in a different way. However, it is also common for businesses to use all four types to protect different aspects of the same creation.

Below is a brief overview of each type of IP and some of the services we provide.

Applicant employs the letters "IP" as an acronym for "intellectual property" in its specimen of record. As such, Applicant's own specimen supports a finding that the acronym "IP" in Applicant's applied-for mark is, at a minimum, merely descriptive of Applicant's identified services. Thus, we find that actual and potential consumers

¹² See Applicant's specimen submitted on April 3, 2019.

would view the term CREATIVITY as the dominant element of Applicant's mark.

In sum, when viewing the marks in their entirety, we find that Applicant's CREATIVITY IP mark and the cited CREATIVITY LAW mark are far more similar than dissimilar. Moreover, we find that the third-party registration evidence submitted by Applicant does not diminish the scope of protection afforded the cited mark. Given that both Applicant's mark and the cited mark begin with the identical term CREATIVITY followed by disclaimed, merely descriptive or generic wording, we find their commercial impressions are similar and sufficient to cause purchasers and prospective purchasers who then encounter the other's mark on the other's services, to mistakenly believe that these services originate from or are sponsored by the same entity, particularly since the services at issue are legally identical in part. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Accordingly, the first *DuPont* factor favors a finding of likelihood of confusion.

D. Sophistication of Consumer

Applicant argues that its purchasers are sophisticated and discriminating.¹³ Specifically, Applicant contends that its "CREATIVITY IP" mark is not likely to be confused with the cited mark CREATIVITY LAW because the average consumer of legal services is a sophisticated purchaser with a narrowly focused need, and because legal services are purchased, not through common retail channels, but through

¹³ Applicant's Appeal Brief, pp. 9-10; 7 TTABVUE 14-15.

careful consideration and by entering into individualized representation agreements.¹⁴

Applicant has not pointed us to any evidence supporting its argument that purchasers of legal services are sophisticated and make purchasing decisions through careful consideration. In addition, its argument is not plausible given the identifications of services involved in this appeal. Because there are no restrictions as to purchasers, we find that the purchasers of legal services are members of the general public, who necessarily encompass both sophisticated consumers of legal services as well as those who have limited experience seeking legal advice and may be seeking legal advice for the first time in their lives on a simple matter. Our decision must be based on the “least sophisticated purchasers,” *Stone Lion*, 110 USPQ2d at 1163, and we consider those purchasers.

For those sophisticated purchasers that Applicant identifies who use care, we point out that they may not be sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (indicating that “even sophisticated purchasers can be confused by very similar marks”); *Top Tobacco, LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011); TMEP § 1207.01(d)(vii). And in the present circumstance where the marks at issue are very similar and the services are legally identical in part, confusion is often found likely despite customer sophistication and care. “That the relevant class of buyers may exercise care does not

¹⁴ *Id.* at p. 10; 7 TTABVUE 15.

necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods [or services]. ‘Human memories even of discriminating purchasers . . . are not infallible.’” *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)); *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962) (“Being skilled in their own art does not necessarily preclude their mistaking one trademark for another when the marks are as similar as those here in issue, and cover merchandise in the same general field.”); *In re Wilson*, 57 USPQ2d 1863, 1865–66 (TTAB 2001) (where marks are very similar and goods [or services] related, confusion may be likely even among sophisticated purchasers).

Thus, this *DuPont* factor is neutral.

E. Extent of Potential Confusion

Applicant also argues that the twelfth *DuPont* factor, the extent of potential confusion, i.e., whether de minimis or substantial, is also a relevant consideration. According to Applicant, any potential confusion would be de minimis because Registrant purportedly does not use the cited mark CREATIVITY LAW as a source indicator for its legal services.¹⁵ Instead, Applicant maintains that Registrant, i.e., Springut Law PC, employs the designation “SPRINGUT LAW” as its service mark for its legal services and merely uses the phrase CREATIVITY LAW to highlight its

¹⁵ Applicant’s Appeal Brief, p. 17; 7 TTABVUE 22.

expertise in intellectual property.¹⁶ Applicant submitted screenshots from Registrant's website to support its argument.¹⁷

Applicant's argument that Registrant uses the phrase SPRINGUT LAW instead of CREATIVITY LAW as the source indicator of its legal services constitutes an impermissible collateral attack on the cited registration. For purposes of our Section 2(d) analysis, we are constrained to make our determination based on the cited mark, as registered, and not on its manner of use based on extrinsic evidence. *See e.g., Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722; *Octocom Sys., Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Because we have found that (1) the marks at issue are very similar; (2) the parties' respective services are legally identical in-part; (3) the parties' respective services are provided in the same or overlapping trade channels to the same or overlapping consumers; and (4) the evidence of record does not demonstrate that the cited CREATIVITY LAW mark is weak in relation to "legal services for the enforcement, licensing, use, establishment and maintenance of intellectual property rights," we disagree that the potential for confusion is de minimis.

Accordingly, this *DuPont* factor is also neutral.

II. Conclusion

We have considered all of the arguments and evidence of record. We find that the Applicant's services and the services identified in the cited registration are legally

¹⁶ *Id.*

¹⁷ October 9, 2019 Request for Reconsideration, 4 TTABVUE 81-88.

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identical in part, and are presumed to move in common channels of trade to the same or overlapping classes of consumers. We further find Applicant's mark and the mark in the cited registration are more similar than dissimilar, and the third-party registration evidence of record does not establish that the cited mark should be accorded a diminished scope of protection. In view thereof, we conclude that Applicant's CREATIVITY IP mark, as used in connection with "legal services" identified in its involved application, so resembles the cited mark CREATIVITY LAW for Registrant's identified services as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The refusal to register Applicant's standard character CREATIVITY IP mark under Section 2(d) of the Trademark Act is affirmed.