

**THIS DISPOSITION
IS NOT CITABLE AS
PRECEDENT OF
THE TTAB**

Mailed: July 10, 2002
Paper No. 10
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Sherwin-Williams Company

Serial No. 75/833,536

Vivien Y. Tsang, Esq. for The Sherwin-Williams Company.

Marlene D. Bell, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

The Sherwin-Williams Company has filed an
application to register the mark PAINTING IMAGES for
"computer software for use in creating, displaying,
visualizing and mapping the effects of paint colors."¹

¹ Serial No. 75/833,536, in International Class 9, filed October 28,
1999, based on an allegation of a bona fide intention to use the mark in
commerce.

The Trademark Examining Attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that applicant's software "enables consumers to obtain an electronically simulated representation of the effects of paint colors on images"; and that "by using this software, consumers can 'paint images' different colors and/or various color schemes, thus allowing the consumer to create, display, visualize and map electronically simulated representations of the effects of paint colors." The Examining Attorney submitted the following definitions from the Internet web site www.dictionary.com (May 24, 2000), quoting from *The American Heritage Dictionary of the English Language*, 3rd ed., 1996:

Painting - *v.tr.* 1. To make (a picture) with paints. 6. *Computer Science*. To display (graphic data) on a video terminal.

Image - *n.* 1. A reproduction of the form of a person or object, especially a sculptured likeness. 9. *Computer Science*. An exact replica of the contents of a storage device,

such as a hard disk, stored on a second storage device, such as a network server.

Images - v. tr. 1. To make or produce a likeness of... 6. *Computer Science*. b. To transmit (an exact replica of the contents of a storage device) to another storage device...

Additionally, we take judicial notice of the definition of "painting" as "noun, an instance of covering a surface with paint" in *The Random House Dictionary of the English Language*, 2nd ed., unabridged, 1987.

The Examining Attorney also relies on applicant's statements in its product brochure, submitted in response to the Examining Attorney's request for additional information. The following is an excerpt:

Exclusively from Sherwin-Williams ... a professional software program that lets you show customers or clients how different colors will look on their homes and buildings. This easy-to-use point and click software allows you to apply any Sherwin-Williams Exterior Color to a digital image. These "painted" images can then be saved or printed out as photo quality.

Applicant contends that PAINTING IMAGES is an incongruous combination of two terms and it is at most suggestive of its color simulator software; that the term "painting is much more likely to be used and recognized as a picture of a design produced with paint"; that "several different interpretations" of the term "painting" are possible; that its product "does not mean

'painting images,' does not allow 'images to be painted,' is not 'images of paintings,' and does not allow a user to 'paint images'"; and that the term "painting images" is more likely to refer "to images of paintings that have been reproduced in some manner."²

With its brief, applicant submitted copies of several third-party registrations for marks that include the term "painter" or "painting" and for marks that include the term "images" for a variety of software products or video products. The Examining Attorney neither discussed this evidence nor objected to it. Evidence submitted with a brief is untimely and, therefore, we have not considered it. However, even if we had considered these registrations to be part of the record, this evidence would be of limited probative value as each case must be decided on its merits. *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Further, several of the marks are registered on the Supplemental Register.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function,

² Applicant, in its brief, makes reference to searches it conducted on the Internet and through TrademarkScan. Because none of this information is of record in this case, we can give it no consideration.

Serial No. 75/833,536

ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We agree with the Examining Attorney that PAINTING IMAGES is merely descriptive of applicant's product, which is computer software for use in creating, displaying, visualizing and mapping the effects of paint colors on a digital image. It is clear that the ordinary meaning of "image" describes the digital picture that appears on the computer screen when using applicant's

software. Considered in connection with applicant's goods, the term "painting" is merely descriptive, regardless of whether it is construed, as defined herein, either as a noun, describing the computer screen image once the virtual paint has been applied, or as a verb, describing the act of applying the virtual paint to the image on the screen.

Applicant argues that the mark as a whole is incongruous, but provides no explanation as to what may be the perceived incongruity. Similarly, applicant provides no basis for its conjecture as to how the mark is likely to be perceived. We find no incongruity in the combination of the two descriptive terms into PAINTING IMAGES. Further, applicant's own product information refers to the digital image with the virtual paint applied to it as a "painted image." This is not significantly different from the term PAINTING IMAGES and conveys almost the same connotation.

If, when applied to applicant's goods, the term PAINTING IMAGES would immediately describe, without conjecture or speculation, a significant feature or function of applicant's goods, namely, that applicant's software allows for the virtual "painting" of digital "images" of homes or rooms so that potential paint

Serial No. 75/833,536

purchasers can see what the home or room looks like painted in a particular color. Nothing would require the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term PAINTING IMAGES as it pertains to applicant's goods.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.