

Mailed: August 5, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Colorfin, LLC

Application No. 77058163

Kyle T. Peterson of Patterson, Thuente, Skaar & Christensen
for applicant.

Karen K. Bush, Trademark Examining Attorney, Law Office 105¹
(Thomas G. Howell, Managing Attorney).

**Before Taylor, Wellington and Ritchie de Larena,
Administrative Trademark Judges.**

Opinion by Wellington, Administrative Trademark Judge:

On December 6, 2006, Colorfin, LLC filed an application
to register the mark PANPASTEL (in standard character
format) on the Principal Register for "non-aqueous colors
for use by artists and crafters" in International Class 2
and "arts and craft paint kits for use by artists and
crafters" in International Class 16.²

¹ The first two Office Actions were issued by the trademark
examining attorney, Pamela N. Hirschman. The examining attorney
identified above was subsequently assigned responsibility for
this application.

² Application Serial No. 77058163, alleging a *bona fide* intent to
use the mark in commerce for the goods in both classes.
Trademark Act § 1(b).

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark PAN ART, registered in stylized lettering as follows:

The image shows the word "Pan Art" in a highly stylized, cursive script. The letters are thick and interconnected, with a fluid, handwritten appearance. The 'P' is particularly large and loops around the 'a'. The 'n' and 'A' are also stylized, with the 'A' having a small loop at the top. The 'r' and 't' are also cursive and connected to the 'n'. The overall look is that of a signature or a brand name in a calligraphic style.

for "pencils, artists' materials, namely, pastels and pastel crayons, tempera water colors, modeling clay, [and] gouache water colors" in International Class 16,³ that, when used with its identified goods, applicant's mark is likely to cause confusion, mistake or deception.⁴

Applicant has appealed, and briefs have been filed.

Initially, we address the examining attorney's objection to applicant's reliance on four third-party registrations. Specifically, she argues that applicant did not properly make these registrations of record because it merely listed the registrations and did not attach soft copies or USPTO electronic database printouts for said registrations. Generally, to make a third-party

³ Registration No. 1553688, issued August 29, 1989, based ownership of a foreign registration. Trademark Act § 44(e). Section 8 affidavit and Section 15 declaration have been filed. The word ART is disclaimed.

⁴ In response to applicant's request for reconsideration (which was denied), the examining attorney withdrew reference to Registrations Nos. 3079036 and 3133700 as bases for refusal and maintained the refusal based solely on the registration identified in this decision.

Application No. 77058163

registration of record, a copy of the registration taken from either the paper or electronic records of the USPTO should be submitted. *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974); see also TBMP § 1208.02 (2d ed. rev. 2004). We also note that applicant first identified these four registrations in its request for reconsideration, which was filed on November 21, 2007, the same day applicant filed its appeal. Thus, even if the examining attorney immediately informed applicant that the mere listing was insufficient, there would have been no time for applicant to correct this error. See Trademark Rule 2.142(d) ("The record in the application should be complete prior to the filing of an appeal.") and TBMP § 1207.01 (2d ed. rev. 2004). Accordingly, the Board has not considered these four registrations. We add that even if applicant properly had made these registrations of record it would not change our ultimate decision herein.

We now consider the merits of the Section 2(d) refusal. In reaching our decision, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed.

Application No. 77058163

Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first consider the *du Pont* factor regarding the similarity of the goods. In this regard, we find applicant's goods in International Class 2, namely, non-aqueous colors for use by artists and crafters to be very closely related to registrant's tempera and gouache water colors. Indeed, they are identical to the extent that they are all paints or colors used by artists. We specifically take issue with applicant's characterization of registrant's goods that "they do not include paint." Brief, p. 3. We take judicial notice that the term "Gouache" is defined as "method of painting with opaque watercolors"; and "Tempera" is defined as "a process of painting in which an albuminous or colloidal medium (as egg yolk) is employed as a vehicle instead of oil; also : a painting done in tempera."⁵

⁵ The American Heritage Dictionary of the English Language: Fourth Edition (2000). It is well settled that the Board may take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v.*

Thus, the only real distinguishing factor between applicant's paints and registrant's paints is that they are employed by artists in different art media, i.e., non-aqueous (not water-based) color versus tempera or gouache water color.

As to applicant's International Class 16 goods, namely, arts and craft paint kits for use by artists and crafters, we find them also to be very closely related to nearly all of registrant's artists' materials, which include pastels and pastel crayons, tempera water colors, modeling clay, [and] gouache water colors. Indeed, registrant's tempera and gouache water colors are both used for painting and could therefore conceivably be components of arts and crafts paint kits.

In support of the refusal, the examining attorneys submitted numerous third-party registrations indicating registration under the same mark for goods including both those of applicant and the cited registrant.⁶ Specifically of record are twenty-seven third-party registrations covering the goods identified in the registration as well as

J.C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n.7 (TTAB 1981).

⁶ Attached to Office Actions dated May 23, 2007 and December 7, 2007.

Application No. 77058163

either applicant's non-aqueous colors (or paints) or applicant's arts and crafts paint kits. For example, the third-party registrations include:

Registration No. 1959855

Mark: SENNELIER

Goods: "...paint binding medium for mixture with color pigments to make oil paint, paint for artists...watercolor paints, tempera paint for artists..." in International Class 2; and "oil paint stick markers, artists' pastels, art paper, cardboard, drawing sketch books, drawing pads, drawing charcoal pencils, india ink, writing ink, erasers, easels, painting palettes, painting canvases, venetian turpentine" in International Class 16.

Registration No. 2025112

Mark: SUSAN SCHEEWE

Goods: "artists' paints, namely, water colors, acrylic paints and oil paints" in International Class 2; and "artists' supplies and materials, namely, art pads, art paper, painting palettes, paint brushes and printed instructional materials in the field of artists' supplies and material" in International Class 16.

Registration No. 2495566

Mark: POWER TO EXPRESS

Goods: "artist's paints; namely, water colors, oil colors, powder colors, poster colors, acrylic colors, tempera powder colors, printing inks, all sold individually and in sets" in International Class 2; and "writing instruments; namely, pencils..., crayons, pastels and writing chinks..., artist's brushes..., artist's palettes for painting, drawing, sketching, artist's canvases for painting, drawing, sketching, easels, sketch boxes, all sold individually and in sets" in International Class 16.

Registration No. 2661782

Mark: PRIMARY ARTIST (stylized with design)

Goods: "Paint for artists, namely, watercolor paint, tempera paint, acrylic paint and powdered paint" in International Class 2; and "Artist supplies for painting and drawing, namely, paint brushes, paint application rollers, paper containers for holding paint; brush tubs in the nature of paint trays for holding brushes; painting sets for artists; painting palettes and paper painting palettes; paint stirrers

and paddles; art supplies boxes; canvas for painting in roll, pre-stretched and board form; artist glue; artist easels; art paper, namely, printmaking and drawing paper, construction paper, oak tag, chipboard, railroad board, newsprint pads, tracing paper and sketch books; artist etching and drypoint tools, namely, scribes, etching needles, scrapers and burnishers; stationery-type portfolios for artists; stationery-type presentation cases for artists; chalk pastels, oil pastels, artist charcoal, pencils, crayons and pens; and paint sets for children and youths comprising paints, brushes, cleaners, pre-drawn paper, blank paper and canvases" in International Class 16.

Third-party registrations which individually cover a number of different items and which are based on use in commerce may serve to suggest that the listed goods are of a type that may emanate from a single source. See *In re Albert Trostel & Sons*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd* (unpublished) No. 88-1444 (Fed. Cir. Nov. 14, 1988).

We agree with the examining attorney and find that a number of the third-party registrations support the suggestion that applicant's goods (in both International Classes 2 and 16) are of a type which may come from the same source as the goods identified in the cited registration. At the very least, there appears to be a significant overlap in the market for such goods, such that use of similar marks for these respective products is likely to cause confusion.

Applicant submitted with its request for reconsideration the declarations of its Director and President, Bernadette Ward, and its vice-president, Ladd

Application No. 77058163

Forsline. The declarants make the same blanket averment that, in their opinions, the "goods associated with the cited marks are not substitutes for the goods associated with [applicant's mark] or any of the goods offered by applicant."⁷ However, when evaluating relatedness of the respective goods, the Board is constrained to compare the goods as identified in the application with the goods as identified in the cited registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). We must therefore consider the pending application to cover all types of arts and crafts paint kits, which may or may not include paints, watercolors, or other artists' supplies identified in the cited registration. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) (goods in application and registration may not be limited by extrinsic evidence), *Elbaum*, 211 USPQ at 640. Moreover, the declarants' statements regarding any distinctions between the respective goods appear to be undercut by their identical admissions that they "have no personal awareness of the products sold under [the cited registered mark]."⁸

⁷ Paragraph 10, in both declarations.

⁸ Paragraph 8, in both declarations.

Application No. 77058163

Applicant also makes much of the fact that some of its goods fall into International Class 2 whereas all of the registrant's goods fall into International Class 16 and, as a result, applicant suggests that these goods are not related. As the examining attorney correctly noted in her brief, it is well recognized that the system of dividing goods (and services) into classes is a USPTO administrative convenience and that a determination on the relatedness of the respective goods cannot be restricted by the artificial boundary created by this classification system. See *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); *Graco Inc. v. The Warner-Graham Company*, 164 USPQ 400, 402 (TTAB 1969), citing *In re Knapp-Monarch Company*, 132 USPQ 6, 7 (CCPA 1961); see also Trademark Manual of Examining Procedure (TMEP) § 1207.01 (5th Ed. rev. September, 2007).

In view thereof, we find that applicant's goods (in both International Classes 2 and 16) are closely related to those of the registrant and this factor therefore weighs strongly in favor of finding a likelihood of confusion.

As to the *du Pont* factors regarding the trade channels and classes of purchasers, we note that applicant's goods are designated as "for use by artists and crafters" and registrant's goods are identified as "artists' materials." Consequently, to the extent that the relevant purchasing

public of the respective goods are artists or painters, they are the same. Moreover, because applicant and registrant sell paints for artists, and because applicant's arts and crafts paint kits may contain paints akin to those sold by registrant, we must also presume that the channels of trade are also the same. *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Applicant again relies on identical blanket averments in the declarations of Ms. Ward and Mr. Forsline that "[t]he goods associated with the cited marks are sold in different channels of trade than the goods associated with [applicant's mark] or any goods offered by applicant."⁹ This statement has very little, if any, probative value. Again, we must consider the possible trade channels based on the goods as identified in the application and the cited registration, *Octocom*, 918 F.2d 937, and here they are specifically described, respectively, in their identifications as being "for artists and painters" and "artists' materials."

Thus, the *du Pont* factors involving trade channels and classes of purchasers also favor a finding of likelihood of confusion.

This brings us to the similarity of the marks. In articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in

⁹ Paragraph 11, in both declarations.

Application No. 77058163

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 a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, merely descriptive matter that is disclaimed may be accorded subordinate status relative to the more distinctive portions of a mark. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997).

In the present case, both applicant's and registrant's marks begin with the term or prefix PAN, followed respectively by PASTEL and ART. These latter elements of the marks, PASTEL and ART, are clearly descriptive, if not generic, for the identified goods of both applicant and registrant.¹⁰ Notably, the word ART has been disclaimed in the cited registration. Given the highly descriptive, if not generic, nature of these terms in the respective marks, we can safely conclude that each mark is dominated by the identical element, PAN. In addition, the term PAN appears first in each mark and, as such, is the part of each mark that is most likely to be impressed upon the mind of a

¹⁰ We take judicial notice that the term "pastel" is defined as "a paste made of powdered pigment ranging from pale to deep colors and used for making crayons" and "the process or art of drawing with pastels." The American Heritage Dictionary of the English Language: Fourth Edition (2000). The examining attorney also submitted a similar definition of the term with her January 12, 2007 Office Action.

purchaser. See *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). We therefore conclude that the dominant feature of both marks is the element PAN.

In arguing that the respective marks are dissimilar, applicant argues that the term or element PAN is weak or should otherwise be accorded less protection. Applicant specifically contends that "the cited mark is relatively narrow in scope in view of the facts that several other marks that incorporate PAN already exist on the Principal Register." Brief, p. 4. This argument is not supported by any evidence.¹¹ And, to the extent that applicant seeks to persuade us to resolve a separate *du Pont* factor, namely the weakness or strength of the registrant's mark, in applicant's favor, we are unconvinced; instead, we find that factor to be neutral.

Although both marks begin with and share the same dominant element, PAN, we must compare the marks as a whole.

¹¹ As we previously decided, the third-party registrations listed by applicant have not been considered. We do not hesitate to add that even if we were to consider the four listed third-party registrations, they have limited probative value and our decision would not change in this matter. Specifically, such registrations are not evidence of use of the marks and therefore do not show that consumers are familiar with the marks so as to be accustomed to the existence of similar marks in the marketplace and are thus able to distinguish between the similar marks based on slight differences. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982).

Application No. 77058163

M2 Software Inc. v. M2 Communications Inc., 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ["When comparing the similarity of marks, a disclaimed term...may be given little weight, but it may not be ignored"]. In this respect, we find that the similarity of the marks outweighs the dissimilarity. Moreover, we agree with the examining attorney that the overall commercial impressions created by the marks are similar inasmuch as they both "feature the same dominant word PAN, followed by a descriptive word in the industry in which the goods are used." Brief, (unnumbered) p. 5.

Even though neither applicant nor the examining attorney raised the issue, we would be remiss if we did not note that the stylized lettering employed in the cited registered mark has little significance in distinguishing the two marks. Because applicant's mark is presented in standard character form, it could reasonably be displayed in the same stylized lettering form as registrant's, thereby increasing the visual similarity of the two marks. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000) (typed drawings are not limited to any particular rendition of the mark). See also *Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971).

Accordingly, we find that the *du Pont* factor of the similarities of marks weighs against applicant.

Finally, we address the (identical) averments in the declarations of Ms. Ward and Mr. Forsline regarding the lack of any actual confusion.¹² The fact that an applicant in an *ex parte* case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred. See, e.g., *In re Jeep Corporation*, 222 USPQ 333 (TTAB 1984). There is no evidence in the record regarding the extent of use of either applicant's or registrant's marks; thus we are unable to determine if there has been any meaningful opportunity for confusion to occur in the marketplace. In any event, the test is likelihood of confusion, not actual confusion, and, as often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion. See e.g., *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

¹² "To my knowledge, no one has been confused over Applicant's mark and the cited marks." Paragraph 9 of both declarations.

Application No. 77058163

When we consider the record and the relevant likelihood of confusion factors, we conclude that, when potential purchasers of applicant's and registrant's goods encounter the marks PANPASTEL and PAN ART (stylized), respectively, for the goods, they are likely to believe that the sources of these goods are in some way related or associated. As a result, there is a likelihood of confusion.

DECISION: The refusal to register the mark under Section 2(d) of the Trademark Act in view of Registration No. 1553688 is affirmed.