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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Univar USA Inc. (formerly known as Vopak USA Inc.)  
Serial No.: 76/159,040  
Filed: November 3, 2000  
Mark: KONTROL

Attorney Docket No. UNVL225325  
Trademark Attorney: J.S. DeFord  
Law Office: 115  
International Class: 5

Seattle, Washington 98101

April 19, 2004

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL  
APPLICANT'S APPEAL BRIEF



04-22-2004

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TABLE OF CONTENTS

|   | <u>Page</u> |
|---|-------------|
| INTRODUCTION .....  | 1           |
| FACTS .....   | 1           |
| ARGUMENT .....  | 3           |
| I.    The Determination of Likelihood of Confusion Must take into<br>Consideration the Number and Nature of Similar Marks in Use on Similar<br>Goods .....  | 4           |
| A.    Third Party Registrations are Probative to the Determination that<br>"Control" Is a Weak Portion of a Composite Mark and that the<br>Addition of Other Matter to the word "CONTROL" Creates a<br>Distinctive Mark. .... | 5           |
| II.   The Mark KONTROL is Distinctive and Source-Identifying. ....  | 9           |
| CONCLUSION .....  | 10          |

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TABLE OF AUTHORITIES

**FEDERAL CASES**

*In re E.I. Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973) .....4

*General Mills, Inc. v. Kellogg Co., Inc.*, 824 F.2d 622, 3 U.S.P.Q.2d 1442 (8th Cir. 1987).....9

*In re Majestic Distilling Co.*, 315 F.3d 1311, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003) .....4

*Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*,  
223 U.S.P.Q. 1281 (Fed. Cir. 1984).....5

*Spraying Systems Co. Inc. v. Delavan, Inc.*, 19 U.S.P.Q.2d 1121 (N.D. Ill. 1991)  
*aff'd*, 24 U.S.P.Q.2d 1181 (7th Circ. 1992).....9

*Tektronix, Inc. v. Daktronics, Inc.*, 189 U.S.P.Q. 693 (C.C.P.A. 1976) .....5

**FEDERAL STATUTES**

15 U.S.C. § 1052(d) ..... 1

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## INTRODUCTION

Applicant, Univar USA Inc. ("Univar"), appeals the Examining Attorney's refusal to register the mark KONTROL, U.S. Trademark Application Serial No. 76/159,040, on the ground that the mark, when used on or in connection with "pesticides, for domestic, industrial, and agricultural use," in International Class 5, so resembles the marks shown by U.S. Trademark Registration Nos. 2,042,589 (CONTROL and Design) and 1,693,958 (PRO-CONTROL), as to be likely to cause confusion, to cause mistake, or to deceive, under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

## FACTS

On November 3, 2000, Univar filed an application to register the subject mark KONTROL, for "pesticides" on the Principal Register.

On March 26, 2001, the Examining Attorney issued a first Office Action, wherein the mark was refused registration on the basis that Univar's mark KONTROL, when used on or in connection with the identified goods, so resembles the marks claimed by the registrations for the marks CONTROL and Design, U.S. Trademark Registration No. 2,042,589, for "insecticides for domestic use," and PRO-CONTROL, U.S. Trademark Registration No. 1,693,958, for "insecticide for domestic, commercial, agricultural, and industrial use," as to be likely to cause confusion, to cause mistake, or to deceive.<sup>1</sup>

On September 26, 2001, Univar responded to the first Office Action and argued that the co-existence on the Principal Register of the cited prior registrations for the marks CONTROL and Design and PRO-CONTROL, indicated that the addition of other identifying matter to the

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<sup>1</sup> The identification of goods was rejected as indefinite and subsequently amended in the Response to First Office Action to its present form, for which registration is sought; "pesticides, for domestic, industrial, and agricultural use," in International Class 5.

word "control" is sufficient to produce a distinguishing trademark. Therefore, Univar's mark KONTROL creates a separate and distinct commercial impression that is not confusingly similar to the commercial impression created by the cited prior registrations for the marks CONTROL and Design and PRO-CONTROL.

On May 3, 2002, the Examining Attorney sent a final refusal. He argued that despite Univar's use of the letter "K," rather than the letter "C" to spell the mark "KONTROL," Univar's mark was the phonetic equivalent of the term "control" and, therefore, Univar's mark did not create a commercial impression that was distinct from the cited registrations.

On October 31, 2002, Univar filed a Request for Reconsideration, together with a Notice of Appeal. Univar argued that the term "control" is commonly used with insecticides and pesticides, and consumers will differentiate between different sources based on other differences in the marks. In support of this argument, Univar submitted nine additional federal registrations that include the term "control," and were registered for insecticides and pesticides. Univar argued further that mere phonetic similarity of a single weak term is not sufficient to support a determination of likelihood of confusion, between its mark KONTROL and the prior cited registrations for the marks CONTROL and Design and PRO-CONTROL.

On August 25, 2003, the Examining Attorney filed his response to the Request for Reconsideration and continued the refusal.<sup>2</sup> The Examining Attorney argued that Univar's mark and the cited registrations could easily be distinguished from the nine prior registrations identified by Univar. According to the Examining Attorney, in the registrations cited by Univar,

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<sup>2</sup> The Examining Attorney stated that the "Request for Reconsideration is denied and the refusal to register the mark under Section 2(e)(1) is maintained." Because this application has never been refused pursuant to Section 2(e)(1), Univar understands this reference to be an error and that the ground for refusal is Section 2(d) (likelihood of confusion).

the term "control" was used in a descriptive manner, as part of a phrase or as part of a non-descriptive unitary phrase, whereas the cited registered marks are not weak or diluted in the relevant field of goods and are "in fact unique and, therefore, quite strong and thus, entitled to protection from registration of a confusingly similar mark for identical goods." The Examining Attorney argued that Univar's use of the letter "K," as a distinguishing feature of its mark KONTROL is not sufficient to distinguish Univar's mark from the registered marks, and all three marks create the same overall commercial impression.

This application is now before the Trademark Trial and Appeal Board on Univar's appeal of the Examining Attorney's final refusal of registration of the mark KONTROL, under Section 2(d) of the Trademark Act.

#### ARGUMENT

The issue on Appeal is whether the registration of Univar's mark KONTROL will result in the likelihood that the purchasing public will be confused, mistaken, or deceived in light of the cited prior registrations for the marks CONTROL and Design and PRO-CONTROL. Univar submits that customers will recognize the composite marks in their entirety as source identifiers. Customers will recognize the composite marks because they are each distinguished by unique different features: the Design element of the prior registered mark CONTROL and Design is unique and hence the mark in its entirety is unique; the unique spelling of KONTROL by Univar creates a unique mark; and the addition of PRO- to the word control in PRO-CONTROL creates a source identifying composite mark.

The determination of a likelihood of confusion must not be based solely upon evaluation of two of the *Du Pont* factors. It is legal error to find a likelihood of confusion based solely upon the similarity of the marks and the relatedness of the goods. A third *Du Pont* factor, the number and nature of similar marks in use on similar goods must be considered if supported by evidence

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in the record. If this third factor is properly considered, then a different conclusion will be reached -- there is no likelihood of confusion between Univar's mark KONTROL and the cited prior registrations for the marks CONTROL and Design and PRO-CONTROL.

Univar in support of its application submitted nine additional prior registrations, all of which include the term "control." The prior registrations constitute evidence that the term "control" as used in the registrations is a weak element when used in association with pesticides and insecticides, and related services.

Furthermore, this widespread use of "control" and consumers' lack of association of that term with a single source means that consumers will look to other elements to distinguish between marks using the common "control" term. Therefore, the differences between Univar's mark KONTROL, and the cited prior registrations for the marks CONTROL and Design and PRO-CONTROL are sufficient to distinguish the marks and make consumer confusion unlikely.

I. The Determination of Likelihood of Confusion Must take into Consideration the Number and Nature of Similar Marks in Use on Similar Goods

As the Board is well aware, the determination of a likelihood of confusion is made based on the 13 factors set forth in *In re E.I. Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). These factors are not listed in any particular order of merit and each may, from case to case, play a dominant role. Other factors listed in *Du Pont* may be considered, if relevant evidence is contained in the record and any one factor may control a particular case. See *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003).

The determination of a likelihood of confusion in this case must consider the *Du Pont* factor that looks to the number and nature of similar marks for similar goods and the evidence provided by Univar in support thereof.

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A. Third Party Registrations are Probative to the Determination that "Control" Is a Weak Portion of a Composite Mark and that the Addition of Other Matter to the word "CONTROL" Creates a Distinctive Mark.

Third-party registrations will be considered where they are submitted to show the meaning of a mark in the same way that dictionaries are used. *Tektronix, Inc. v. Daktronics, Inc.*, 189 U.S.P.Q. 693 (C.C.P.A. 1976). Third-party registrations are relevant to show that a mark or a portion of the mark is descriptive, or so commonly used that the public will look to other elements to distinguish the source of the goods. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 223 U.S.P.Q. 1281, 1285-1286 (Fed. Cir. 1984).

The co-existence of the cited prior registrations for the marks CONTROL and Design and PRO-CONTROL themselves are evidence that the term "control" is commonly used as a component of a composite mark and therefore that consumers will look to other elements of a mark to serve as distinguishing and identifying characteristics. Both of the marks claimed by the cited registrations include the common term "control" and both registrations are based upon use of the respective marks for similar goods yet are allowed to co-exist on the Principal Register. The Design element of the mark CONTROL and Design and the addition of PRO- to the mark PRO-CONTROL are clearly the distinguishing features of the prior cited registered marks. The refusal of registration is therefore based upon a common non-distinguishing feature of the cited registrations. The co-existence of the two prior cited registrations is sufficient to show that there would be no likelihood of confusion created by Univar's registration of the mark KONTROL. Indeed, the marks shown by the cited prior registrations are more similar to each other, based on their common use of the term "control," than are either of the prior registered marks to Univar's mark KONTROL.

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Univar has submitted nine additional registrations as evidence that the term "control" is a common component of composite marks claiming goods in the pest control field and that therefore the mark KONTROL claimed by Univar's application is distinctive. The Examining Attorney rejected this evidence by arguing that the registrations identified by Univar showed use of the term "control" in a descriptive manner and that the registrations were therefore not determinative. The fact that the term "control" is used descriptively as a portion of the prior registered composite marks and is included as a component of numerous prior registrations claiming goods in the same channel of trade in which pesticides are sold constitutes persuasive evidence that the addition of other distinguishing matter to the term "control" creates a new a distinctive mark.<sup>3</sup>

The nine additional registrations submitted by Univar showing use of the term "control" for the same or similar goods and services are as follows:

| Mark  | U.S. Reg. No./U.S. Appln. No. | Goods/Services  |
|---|-------------------------------|---|
| CAMICIDE HOME PEST CONTROL and Design (HOME PEST CONTROL disclaimed.) | 2,045,827                     | Insecticide for domestic use, in International Class 5.   |
| BIRTH CONTROL FOR ROACHES   | 1,452,885                     | Insecticide, in International Class 5.  |
| GLOBAL SOLUTIONS FOR MOSQUITO CONTROL (MOSQUITO CONTROL disclaimed.)  | 76/001,179                    | Liquid pesticides for use in aerosol spraying for mosquitoes; Larvicides in pellet, granule and briquette form for control of mosquito larvae, all for domestic and agricultural use, |

<sup>3</sup> No prior registrations for the mark KONTROL were cited by the Examining Attorney.

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| Mark   | U.S. Reg. No./U.S. Appln. No. | Goods/Services   |
|--|-------------------------------|--|
|  |                               | <p>in International Class 5;</p> <p>Power operated guns for the distribution of pesticides in granular, briquette and pellet form; Nozzles for use in aerosol spray generators for mosquitoes; Power operated liquid power guns for use in the aerosol spraying of mosquitoes; Power operated linear flow control system for use in the spraying of mosquitoes which synchronize the chemical output of the spray with the speed of the vehicle carrying the spraying equipment, in International Class 7;</p> <p>Hand operated aerosol spray units for mosquito control, in International Class 8;</p> <p>Lab equipment used in mosquito control, namely, chill tables, magnifier lamps, and olfactometers, in International Class 9;</p> <p>Insect traps and accessories therefor, namely, trap collection nets, net props, plastic killing jars with connecting sleeves, and single ring net bags, in International Class 21.</p> |
| <p>PCT PEST CONTROL TECHNOLOGY (PEST CONTROL TECHNOLOGY registered under 2(f))</p> | <p>1,955,660</p>              | <p>Magazines in the field of the pest control industry, environmental issues, scientific developments in the composition and use of pesticides and insecticides and other pest control topics, in International Class 16.</p>  |
| <p>ACTION PEST CONTROL and Design (PEST CONTROL disclaimed.)</p>                   | <p>1,861,203</p>              | <p>Application of pesticides in the field of residential and commercial pest control, in International Class 37.</p>   |
| <p>VIKING TERMITE AND PEST CONTROL and Design</p>                                  | <p>2,009,658</p>              | <p>Pest control services directed to insects, rodents, deer, pigeons, bats and the like;</p>   |

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| Mark   | U.S. Reg. No./U.S. Appln. No. | Goods/Services  |
|--|-------------------------------|---|
| (TERMITE AND PEST CONTROL disclaimed.)   |                               | control of odors from termites or pests; building-cleaning services to control pests and maintain sanitary conditions, including steam cleaning; providing repair and/or rebuilding of residential structures damaged by termites or pests, in International Class 37;<br><br>Lawn care services directed to controlling pests and weeds with pesticides and herbicides, in International Class 42.   |
| HOME SAVING TERMITE CONTROL, INC. and Design (TERMITE CONTROL, INC. disclaimed.) | 1,938,436                     | Pest control services in the nature of identifying, eliminating, exterminating, controlling and preventing infestations and infections of wood destroying pests or organisms, and in connection therewith to make inspections and inspection reports, recommendations, estimates and bids, either oral or written; to make structural repairs or replacements; and to use insecticides, pesticides, fumigants and allied chemicals and substances as required to make perform said services, in International Class 37. |
| EARTH TOUCH ORGANIC PEST CONTROL and Design (ORGANIC PEST CONTROL disclaimed.)   | 2,029,137                     | Pesticides for domestic use, in International Class 5.  |
| POLY CONTROL (CONTROL disclaimed.)   | 1,671,533                     | Chemicals, namely, stickers and drift control agents for pesticides, in International Class 1.  |

Univar submits these registrations as evidence that the term "control" is a very weak component of a composite mark. All of the prior registrations Univar cites include a disclaimer of the term "control", either alone or in combination with other terms. The presence of the weak

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term "control" in these registrations and the cited prior registrations for the marks CONTROL and Design and PRO-CONTROL evidence that the inclusion of the common element "control" is not likely to create confusion among customers. See *Spraying Systems Co. Inc. v. Delavan, Inc.*, 19 U.S.P.Q.2d 1121, 1125 (N.D. Ill. 1991) *aff'd*, 24 U.S.P.Q.2d 1181 (7th Circ. 1992). In fact the opposite is true, all of these marks have been allowed to register and co-exist on the Principal Register.

Univar's third-party registration evidence establishes that the word "control" is a "weak" term for pesticides and insecticides that are the same or related to the goods in Univar's application. The relevant purchasers will look to other elements to distinguish the sources of insecticides, pesticides and related services in the marketplace. All of the prior cited marks contain additional words and/or design elements that distinguish the marks. Consumers will look beyond the common meaning and use of "control" and not be confused between Univar's mark KONTROL, and the prior cited registrations for the marks CONTROL and Design and PRO-CONTROL.

II. The Mark KONTROL is Distinctive and Source-Identifying.

Univar's mark KONTROL is unique in its use of the initial letter "K" for insecticide and pesticide products and services in the marketplace. Generally, it is the overall impression of the mark that is important and not the individual features. See *General Mills, Inc. v. Kellogg Co., Inc.*, 824 F.2d 622, 3 U.S.P.Q.2d 1442 (8th Cir. 1987), wherein the court stated, "In analyzing the similarities of sight, sound and the meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features." The only common element with any of the cited prior marks, whether by the Examining Attorney or by Univar, is the "ontrol." All other elements whether it be additional terms or design elements are different and this serves to distinguish the marks.

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Consumers will distinguish Univar's KONTROL mark from the prior registered marks that include the term "control" for the same or similar goods and services, including the cited prior registrations for the marks CONTROL and Design and PRO-CONTROL by looking to the different distinguishing elements of each registered mark.

CONCLUSION

For the foregoing reasons, Univar respectfully requests that the Board overturn the Examining Attorney's decision to refuse registration, under Section 2(d) of the Trademark Act, of Univar's mark KONTROL for "pesticides, for domestic, industrial, and agricultural use," in International Class 5, and allow the application to be published for opposition without further delay.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that Applicant's Appeal Brief is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on the below date.

Date: April 19, 2004

Stacey K. Kalata

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