

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/159040

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CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Van Waters & Rodgers, Inc. : BEFORE THE
Trademark: KONTROL : TRADEMARK TRIAL
Serial No: 76/159040 : AND
Attorney: Christensen, O'Connor,
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EXAMINING ATTORNEY'S APPEAL BRIEF

I. STATEMENT OF THE CASE

Applicant appeals the Trademark Examining Attorney's final refusal to register the proposed trademark KONTROL for "pesticides." The Examining Attorney refused registration on the Principal Register under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the mark, when applied to the goods of the applicant, is likely to be confused with United States Registration No. 2042589 for CONTROL & design for "insecticides for domestic use" and United States Registration No. 1693958 for PRO-CONTROL for "insecticides for domestic, commercial, agricultural and industrial use."

II. FACTS

On November 30, 2000, applicant, Van Waters & Rodgers, applied for registration of the trademark KONTROL on the Principal Register for "pesticides."

On March 26, 2001, the initial Examining Attorney refused registration under Section 2(d) of the Trademark Act based on prior Registration Nos. 2042589 for the mark CONTROL and design for insecticides for domestic use and 1693958 for the mark PRO-CONTROL for "insecticides for domestic, commercial, agricultural and industrial use."

On September 26, 2001, the applicant filed a response satisfying the outstanding procedural issue and argued that the existence of the two cited similar registered marks indicated that the addition of other matter to the word "control" was sufficient to create a distinguishing trademark. Specifically, the applicant argued that the word element "CONTROL" was weak and therefore entitled to a narrow scope of protection. The applicant also argued that the applicant's mark created a distinct commercial impression and could not be confused with the cited registrations. See Applicant's response of September 26, 2001.

On May 3, 2002, the newly assigned Examining Attorney accepted the applicant's procedural

amendments. However, the Examining Attorney continued the refusal on the grounds of likelihood of confusion and issued a Final Refusal based on Registration Nos. 2042589 and 1693958.

On October 31, 2002, in response to the Examining Attorney's Final Action, applicant filed a Request for Reconsideration and Notice of Intent to Appeal. On August 25, 2003 the Examining Attorney denied the Request for Reconsideration and on April 22, 2004, after abandonment and reinstatement for failure to file its Appeal Brief the applicant submitted its Appeal Brief.

The single issue to be decided on appeal is whether KONTROL is confusingly similar to the two registered marks CONTROL and design and PRO-CONTROL.

III. ARGUMENT

THE APPLICANT'S PROPOSED MARK IS NOT ENTITLED TO REGISTRATION BECAUSE IT SO RESEMBLES THE CITED REGISTERED MARKS AND THE GOODS ARE IDENTICAL OR NEARLY IDENTICAL SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

The court in *In re du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563(CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be compelling in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks and similarity of the goods.

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *See in re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

A. THE GOODS ARE NEARLY IDENTICAL

The applicant's goods are identified in the application as "pesticides for domestic, agricultural and

industrial use." The registrant's goods are "insecticides for domestic use and "insecticides for domestic, commercial, agricultural and industrial use."

It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); Furthermore, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source, *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

The goods in the instant case are identical or at the very least overlapping. The applicant's "pesticides" wholly encompass the registrant's more specific "insecticides". The examining attorney asks that the Trademark Trial & Appeal Board take judicial notice of the dictionary definition of the word pesticide as provided herein. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.* 703 F.2d 1372, 215 USPQ 505 (Fed. Cir. 1983).

pes·ti·cide

pes-ti-cide (pēs'tī-sīd') *noun* A chemical used to kill pests, especially insects. - **pes'ti-cid'al** (-sīd'l) *adjective*[1]

Moreover, it is common for a single manufacturer to produce, market and sell pesticides and insecticides under the same trade or service mark as illustrated by the several registrations provided in the initial Office Action. As such the goods are likely to be encountered and purchased by the same consumers who will be exposed to the advertisements and other marketing strategies for the goods of the parties.

Finally, the applicant has not contested the similarity of the goods in its response to the Final

Action, Request for Reconsideration or Appeal Brief. Therefore, there is no issue with respect to the similarity of the goods and therefore the applicant has conceded that the goods are identical and/or overlapping .

B. THE MARKS ARE CONFUSINGLY SIMILAR

The marks must be compared for similarities in sound, appearance, meaning or connotation. *In re E.I. du Pont de Nemours*, 1476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977).

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison but whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries, Inc.*, 209 USPQ 179 (TTAB 1980). The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974). Additionally, the focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *affd.*, No. 92-1086 (Fed. Cir. June 5, 1992).

The applicant is seeking to register the mark KONTROL. The Registered marks are CONTROL and design and PRO-CONTROL. The applicant argues that the word element "control" is weak and therefore entitled to little or no protection for the goods identified. In support of this argument the applicant cites seven (7) registrations for insecticides, pesticides and related services, one (1) registration for magazines in the field of pest control and one (1) registration for chemicals, namely

stickers and drift control agents for use with pesticides, which all contain the word element “control”.

The nine registrations cited by the applicant can all be distinguished from the marks at issue in this application. The “POLY CONTROL” mark with “control” disclaimed is for “chemicals, namely, stickers and *drift control agents* (emphasis added) for use with pesticides” and has no relevance, as the goods are entirely different. The remaining marks cited by the applicant all use the word “control” as part of a descriptive unitary phrase as in “Camicide home pest control” with *home pest control* disclaimed, “*birth control* for roaches”, “Global solutions for mosquito control” with *mosquito control* disclaimed, “PCT pest control technology” with *pest control technology* 2(f), “Action pest control and design” with *pest control* disclaimed; “Viking termite and pest control” with *termite and pest control* disclaimed; “Home savings termite control, Inc” and design with *termite control, Inc.* disclaimed; “Earth touch organic pest control” and design with *organic pest control* disclaimed. The use of the word element “control” in each of these registrations can be easily distinguished from the applicant’s mark and the cited 2(d) registrations in that the term “control” as used in the eight relevant registrations cited is used in a descriptive manner as part of a larger unitary descriptive phrase or in the case of one registration, as part of a non-descriptive unitary phrase. The word element “control” has been consistently treated as descriptive and a disclaimer required **only** when combined with additional descriptive matter, or when used in relationship with other descriptive words in a unitary phrase . See *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985).

Here the applicant dissects the nine registrations and asks that the word element “control” be considered in the abstract. When viewed as a whole the overall commercial impression of the eight relevant marks cited by the applicant and specifically the unitary phrases incorporating the word element “control” are sufficiently different from the marks at issue in this application. The use of the single word element “CONTROL” or “KONTROL” in the applicant’s and the registrant’s marks is wholly different and bears no relationship to the use as shown in the eight relevant registrations cited by applicant.

Applicant also argues that the co-existence of the two cited registrations illustrates that the word “control” is diluted and weak when used in connection with the identified goods and therefore is

entitled to limited protection. While the strength or weakness of a given mark bears on the issue of whether a likelihood of confusion exists in any 2(d) analysis, “[c]onfusion is confusion. The likelihood thereof is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and a ‘strong’ mark.” *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 205 USPQ 981,985 (9th Cir. 1980); *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 182 USPQ 108, 109 (CCPA 1974). The cited registrations exist and are valid, and are entitled to protection whether “weak” or “strong”.

As the Board is aware, “third party registrations are of extremely limited evidentiary value.” Sams, “Third Party Registrations in T.T.A.B. Proceedings,” 72 Trademark Rep. 297 (1982). Moreover, a mark may be weak in one field, and strong in another. See, e.g., *Castle Oil Corp. v. Castle Energy Corp.*, 26 USPQ2d 1481, 1488 (E.D. Pa. 1992); *ConAgra, Inc. v. Geo. A. Hormel & Co.*, 784 F. Supp. 700, 714 (D. Neb. 1992), *aff’d*, 990 F. 2d 368, 26 USPQ2d 1316 (8th Cir. 1993).

Additionally, each case must be decided on its own merits. *In re National Novice Hockey League, Inc.* 222 USPQ 628, 639 (TTAB 1984).

Contrary to applicant’s assertions, the term CONTROL or KONTROL is not weak in the field at issue in this appeal. In fact, the registered marks are extremely strong as indicated by the third party registration information attached by the applicant and confirmed by the examining attorney where the word element “control” or its phonetic equivalent “kontrol” do not stand alone but are combined with one or more other non-descriptive word elements and create a descriptive unitary phrase. As stated previously in the Final Office Action, out of 311 registrations in class 5 for insecticides or pesticides only three contain the word “kontrol” or “control” as a single non-descriptive word element and not part of a unitary descriptive phrase. The three registrations consist of the cited marks and one companion mark owned by the second cited registrant. (see examining attorney’s Final Office Action of May 3, 2002). While evidence of third party usage of **similar** marks on similar goods is admissible and relevant to show that the mark is relatively weak and entitled to a narrow scope of protection, *see*,

e.g., *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 662, 3 USPQ2d 1442 (8th Cir. 1987), the probative value of evidence of third party usage of one word element dissected from a unitary phrase is small. See, e.g., *American Sunbathing Ass'n. v. American Health Alliance*, 157 USPQ 586 (TTAB 1968); *Leatherwood Mfg. Co. v. Wheeler Mobile Ltd.*, 168 USPQ 248 (TTAB 1970). Indeed, the TTAB has labeled such evidence "irrelevant." *Charette Corp. v. Bowater Communication Papers, Inc.*, 13 USPQ2d 2040 (TTAB 1989); accord, *Eclipse Ass'n. Ltd. v. Data General Corp.*, 894 F.2d 1114, 13 USPQ2d 1885 (9th Cir. 1990).

Moreover, the mere citation of third party registrations is not *proof* of third party uses for the purpose of showing the relative weakness of a mark. Applicant has introduced no evidence that these trademarks were actually *used* by third parties, that they were *well-promoted*, or that they were *recognized by consumers*. Therefore, this "evidence" submitted by applicant in the form of third party registration information is not only irrelevant but valueless. See, e.g., *American Hospital Supply Corp. v. Air Products & Chemicals, Inc.*, 194 USPQ 340 (TTAB 1977); *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977); *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978) (Markey, C.J., specially concurring).

Thus, even if it is true that "CONTROL" is weak for certain goods or services, it clearly is very strong when used as a single word or when combined with one other non-descriptive word element in connection with pesticides and insecticides. As such, the registrant's marks consisting of "Control" and design and "PRO-CONTROL" are not weak or diluted in this particular 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 closely related or as in this case identical goods.

Lastly, the applicant argues that the use of the initial letter "K" in the proposed mark is unique and creates a distinctive mark from those cited. In comparing the marks, similarity in any one of the elements of sound, appearance or meaning is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). TMEP §§1207.01 *et seq.* The applicant's mark is "KONTROL". The

registered marks are "CONTROL" and "PRO-CONTROL". The marks are phonetic equivalents. The Examining Attorney must look at the marks in their entireties under Section 2(d). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985). When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). It has long been held that the literal portions are the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *In re Drug Research Reports, Inc.*, 200 USPQ 554 (TTAB 1978). For this reason, the examining attorney must give greater weight to the literal portions of the marks in determining whether there is a likelihood of confusion.

The dominant element of all marks is the word "CONTROL" or its phonetic equivalent "KONTROL". The applicant's mark and dominant element of the registrants are identical save for the initial letter "K" being used by the applicant and the initial letter "C" being used by the registrants. The marks are identical in meaning and connotation and identical or highly similar in sound. More importantly the applicant's mark creates the same overall commercial impression as the marks of the registrants. The use of the initial letter "K" is a slight difference but such a difference does not affect the meaning or connotation or indeed the overall commercial impression of the mark in relationship to the registered marks. It has long been held that slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecommunications & Electrical Association*, 222 USPQ 350 (TTAB 1983). Clearly the marks can be pronounced the same as there is no correct pronunciation of a trademark. *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461 (TTAB 1985).

IV. CONCLUSION

The marks are highly similar and the goods identical or highly related. Consumers encountering applicant's mark and the cited registered marks in the marketplace are likely to mistakenly believe that the goods derive from a common source. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should be affirmed.

Respectfully Submitted,

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