

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Univar USA Inc.

Attorney Docket No. UNVL225325

Serial No.: 76/159,040

Trademark Attorney: J.S. DeFord

Filed: November 3, 2000

Law Office: 115

Mark: KONTROL

Seattle, Washington

July 19, 2004

APPLICANT'S REPLY BRIEF



07-22-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #77

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION.....	1
II. APPLICANT'S MARK IS NOT WITHIN THE SCOPE OF PROTECTION ENCOMPASSED BY THE CITED REGISTRATIONS	1
III. THIRD PARTY REGISTRATIONS SHOW THAT A MARK OR A PORTION OF A MARK IS SO COMMONLY USED THAT THE PUBLIC WILL LOOK TO OTHER ELEMENTS TO DISTINGUISH THE SOURCE OF THE GOODS	2
IV. CONCLUSION	3

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

TABLE OF AUTHORITIES

Page

FEDERAL CASES

American Hospital Supply Corp. v. Air Products and Chemicals, Inc.,
194 U.S.P.Q. 340 (TTAB 1977)..... 1

In re Central Soya Company, Inc.,
220 U.S.P.Q. 914 (TTAB 1984)..... 2

In re Hunke & Jochheim,
185 U.S.P.Q. 188 (TTAB 1975)..... 2

FEDERAL STATUTES

37 C.F.R. § 2.142(b)(1) 1

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

I. INTRODUCTION

The Examining Attorney's Appeal Brief was filed on June 28, 2004. In accordance with 37 C.F.R. § 2.142(b)(1), Applicant's Reply brief is to be submitted twenty (20) days thereafter.

II. APPLICANT'S MARK IS NOT WITHIN THE SCOPE OF PROTECTION ENCOMPASSED BY THE CITED REGISTRATIONS

The two registrations cited as bars to registration of KONTROL as requested by Application Serial No. 76/159,040 claim the word control with other elements. The scope of protection represented by these registrations does not include the exclusive right to the word "control" as an element of a mark and therefore does not bar this application. The importance and relevance of the third party registrations that include the word "control" identified by Applicant is to demonstrate that the public has become accustomed to looking to other elements of the cited registered marks to distinguish the source of the goods sold in association with such marks.

Therefore, the Examining Attorney must evaluate whether the differences in the other elements added to the word "control" are sufficient to distinguish the marks as a whole and make confusion unlikely.

The use of the letter "K" in the mark KONTROL mark creates a mark that is distinguishable from the cited registrations for the CONTROL and Design mark, and the PRO-CONTROL mark, and consumers are not likely to be confused.

The Board has noted in *American Hospital Supply Corp. v. Air Products and Chemicals, Inc.*, 194 U.S.P.Q. 340, 343 (TTAB 1977), third party registrations are "competent to establish that a portion common to the marks involved in a proceeding has a normally understood and well-known meaning; that this has been recognized by the U.S. Patent and Trademark Office by

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

registering marks containing such a common feature for the same or closely related goods, where the remaining portions of the marks are sufficient to distinguish the marks as a whole, and that therefore, the inclusion of [the common element] in each mark may be an insufficient basis upon which to predicate a holding of confusing similarity."

The relative strength of the marks must be taken into consideration in determining a likelihood of confusion. A "weak" mark is entitled to protection, but the scope of that protection will be narrow. *In re Central Soya Company, Inc.*, 220 U.S.P.Q. 914 (TTAB 1984). However, because of this narrow scope, the marks must be substantially identical, in order to find a likelihood of confusion. *In re Hunke & Jochheim*, 185 U.S.P.Q. 188 (TTAB 1975).

Applicant's mark is simply not within the scope of exclusive rights represented by the cited registrations.

III. THIRD PARTY REGISTRATIONS SHOW THAT A MARK OR A PORTION OF A MARK IS SO COMMONLY USED THAT THE PUBLIC WILL LOOK TO OTHER ELEMENTS TO DISTINGUISH THE SOURCE OF THE GOODS

Applicant has not submitted any evidence of third party usage and therefore the cases cited at pages 8-9 of the Examining Attorney's brief are not relevant to any issue on appeal. The evidence of third party registrations submitted by Applicant does establish that CONTROL is a weak component of a composite mark. None of the prior cited registrations claim the word "control" alone as a mark in a standard character or typed format. The word "control" as a portion of a composite mark has been shown to be so commonly used that the public is looking to other elements of the composite marks previously registered to identify the source of the goods with which the prior registered marks are used.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

IV. CONCLUSION

Applicant's KONTROL mark is not within the scope of protection of the cited registrations. The common element between the marks is "control," which Applicant has demonstrated through third party registrations to be extremely weak in the relevant pesticide industry, and related goods and services field. Therefore, consumers will look to other elements and Applicant's mark KONTROL (with a "K") is not likely to be confused with the registrants' respective marks, CONTROL and Design (a lined background with concentric circles in the second letter "o"), and PRO-CONTROL.

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Cindy L. Caditz
Direct Dial No. 206.695.1715
Everett E. Fruehling
Direct Dial No. 206.695.1743

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

CERTIFICATE OF MAILING

I hereby certify that this Applicant's Reply 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: July 19, 2004 Stacey K. Kalata

EEF:skk/gm

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100