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apparel*

BOX RESPONSES - NO FEE
Trademark Law Office: 115
Serial No.: 76/159,040
Mark: KONTROL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Univar USA Inc. (formerly known as Vopak 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 International Class: 5

REQUEST FOR RECONSIDERATION

Seattle, Washington 98101

October 31, 2002

TO THE COMMISSIONER FOR TRADEMARKS:

Responsive to the Final Office Action mailed May 3, 2002, Applicant respectfully requests that the Examining Attorney reconsider his final decision to refuse registration of the above-referenced mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) on the basis that the Applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,693,958 and 2,042,589 as to be likely to cause confusion, or to cause mistake, or to deceive. Applicant's request for reconsideration is filed in accordance with T.M.E.P. § 715.

Contemporaneously with this Request, Applicant files a Notice of Appeal to the Trademark Trial and Appeal Board.

REMARKS

Applicant submits this request for reconsideration to submit additional evidence and arguments against the Examining Attorney's conclusion that there is a likelihood of confusion between the Applicant's mark and the prior cited registrations. The Examining Attorney's refusal is well intentioned, but fails to take into consideration the reality of the marketplace. Consumers are well-conditioned to seeing the term "control" in association with pesticide and insecticide products, and therefore are unlikely to associate the term with a single product or source.

1
2 **1. The Term "Control" Is Commonly Used With Insecticides and Pesticides, and Consumers**
3 **Will Differentiate Between Different Sources Based on Other Differences in Marks.**

4 Terms in common use as marks are not entitled to the same scope of protection as a strong or
5 distinctive mark. See *McCarthy on Trademarks and Unfair Competition*, § 11:86. Commonly used
6 marks are often regarded as relatively "weak" marks and given a relatively narrow scope of protection.
7 See *Simplex Electric Heating Co. v. Ramsey Co.*, 232 O.G. 1259, 1916 C.D. 1974 (Commissioner
8 Patents 1916). See *American Steel Foundries v. Robertson*, 269 U.S. 372, 70 L. Ed. 317, 46 S. Ct. 160
9 (1926); see also discussion in *Royal Petroleum Corp. v. River States Oil Co.*, 136 U.S.P.Q. 79 (T.T.A.B.
10 1962). The term "control" is a commonly used term in association with insecticides and pesticides and
11 therefore is regarded as a relatively "weak" mark and consequently given a relatively narrow scope of
12 protection against alleged infringement.

13 Applicant attaches as Exhibit A nine additional registrations which include the term "control"
14 and registered for insecticides and pesticides. Evidence of third party use of similar marks on similar
15 goods is admissible and relevant to show that the mark is relatively weak and entitled to only a narrow
16 scope of protection. *McCarthy* § 11:88 citing to *Tektronix, Inc. v. Daktronix, Inc.*, 534 F.2d 915,
17 189 U.S.P.Q. 693 (C.C.P.A. 1976) and others.

18 It is well established that marks are to be taken in their entireties. T.M.E.P. § 1207.01(c)(ii)
19 citing to *Massey Jr. College Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272
20 (C.C.P.A. 1974). The fact that the term "control" is disclaimed in many of these registrations is an
21 acknowledgement of the weakness of the mark. Consumers in the marketplace are accustomed to
22 seeing the term "control" as a mark or as a portion of a mark. The common use of the term has
23 conditioned customers such that they have "been educated to distinguish between different [such]
24 marks on the basis of minute distinctions." *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383
25 (T.T.A.B. 1976).

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2 The Examining Attorney overlooks these additional registrations and their use in the
3 marketplace. Consumers conditioned to seeing the word "control" in association with insecticide and
4 pesticide products are therefore more likely to look at other distinguishing features in distinguishing the
5 Applicant's mark from the cited registered marks and the attached registrations.

6 **2. Mere Phonetic Similarity of a Single Term Is Not Sufficient to Support Determination of**
7 **Likelihood of Confusion Between "Kontrol" and the Prior Cited Registrations.**

8 The Examining Attorney places great weight on the fact that Applicant's mark KONTROL is
9 phonetically equivalent to the "control" element in the cited registrations.

10 Phonetic similarity is merely one element in the determination of a likelihood of confusion. See
11 *McCarthy* § 23:22 and the cases cited therein including *Lebow Brothers, Inc. v. Lebole Euroconf S.p.A.*,
12 503 F. Supp. 209, 212 U.S.P.Q. 693 (E.D. Penn. 1980) (similar pronunciation does not prove likelihood
13 of confusion if other factors weigh more heavily); *Crown Radio Corp. v. Soundsciber Corp.*,
14 506 F.2d 1392, 184 U.S.P.Q. 221 (C.C.P.A. 1974) (likelihood of confusion cannot be predicated on
15 auditory response alone).

16 Even if the marks are phonetically similar, other elements of difference may lead to a final
17 finding of no likelihood of confusion. *McCarthy* at 23:22, citing to *Standard Brands, Inc. v. Eastern*
18 *Shore Canning Co.*, 172 F.2d 144, 80 U.S.P.Q. 318 (4th Cir. 1949), *cert. denied*, 337 U.S. 925,
19 93 L. Ed. 1733, 69 S. Ct. 1171, 81 U.S.P.Q. 573 (1949) (no likelihood of confusion between
20 V8 vegetable juice and VA tomato juice).

21 All of the marks discussed have additional terms or design elements or both. Applicant's mark
22 is the only mark to use the "K" in its mark "KONTROL" and this distinguishes Applicant's mark from
23 the cited registrations.

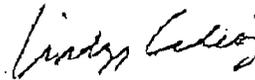
24 There is no mechanical test for determining likelihood of confusion. The issue for the
25 Examining Attorney is not whether the actual goods are likely to be confused, but instead, whether

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The Examining Attorney must go beyond a mere mechanical application of the rules in making his final determination that a likelihood of confusion exists between Applicant's mark KONTROL and the prior cited registrations for PRO-CONTROL and CONTROL & Design. A visit to his local home improvement super-store will illustrate that "control" is not and should not be associated with one product or source. Consumers who see the Applicant's goods, bearing the KONTROL mark, on the shelf surrounded by other similar products bearing marks incorporating "control" are not likely to be confused as to the source of those goods. Applicant's mark KONTROL is capable of registration and no likelihood of confusion exists in the marketplace.

Respectfully submitted,

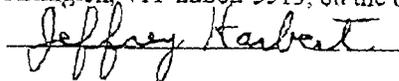
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Cindy L. Caditz
Telephone No. 206.682.5100

I hereby certify that this Request for Reconsideration and Exhibit A in U.S. Trademark Application Serial No. 76/159,040 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 Box Responses - No Fcc, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on the below date.

Date: October 31, 2002



CLC/BBF:jh

Exhibit A



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List At: OR to record: Record 1 out of 5

Check Status: (TARR contains current status, correspondence address and attorney of record for this mark.
Use the "Back" button of the Internet Browser to return to TESS)



Word Mark CAMICIDE HOME PEST CONTROL

Goods and Services IC 005. US 006 018 044 046 051 052. G & S: insecticide for domestic use. FIRST USE: 19950901. FIRST USE IN COMMERCE: 19960101

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 032302 032324 032325 050525 260302 260328 261107 261121

Serial Number 75071542

Filing Date March 12, 1996

Published for Opposition December 24, 1996

Registration Number 2045827

Registration Date March 18, 1997

Owner (REGISTRANT) Campbell Chemicals, Inc. CORPORATION MISSOURI 333 Leffingwell, Suite 127 P.O. Box 3829 St. Louis MISSOURI 63122

Attorney of Record JILL M FARMER

Prior Registrations 0624267

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOME PEST CONTROL" APART FROM THE MARK AS SHOWN

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead
Indicator LIVE

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Typed Drawing

Word Mark BIRTH CONTROL FOR ROACHES
 Goods and Services IC 005, US 006, G & S: INSECTICIDE, FIRST USE: 19850314, FIRST USE IN COMMERCE: 19850314
 Mark Drawing Code (1) TYPED DRAWING
 Serial Number 73639433
 Filing Date January 12, 1987
 Published for Opposition May 26, 1987
 Registration Number 1452885
 Registration Date August 18, 1987

Owner (REGISTRANT) SANDOZ AG (SANDOZ LTD., SANDOZ S.A.) CORPORATION
 SWITZERLAND LICHTSTRASSE 35 BASLE SWITZERLAND
 Assignment Recorded ASSIGNMENT RECORDED
 Attorney of Record HAROLD MILSTEIN
 Type of Mark TRADEMARK
 Register PRINCIPAL
 Affidavit Text SECT 15, SECT 8 (6-YR).
 Live/Dead Indicator LIVE

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- [TRADEMARK](#)
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Typed Drawing

- Word Mark GLOBAL SOLUTIONS FOR MOSQUITO CONTROL
- Goods and Services IC 005. US 006 018 044 046 051 052. G & S: 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
- IC 007. US 013 019 021 023 031 034 035. G & S: 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
- IC 008. US 023 028 044. G & S: Hand operated aerosol spray units for mosquito control
- IC 009. US 021 023 026 036 038. G & S: Lab equipment used in mosquito control, namely, chill tables, magnifier lamps, and olfactometers
- IC 021. US 002 013 023 029 030 033 040 050. G & S: Insect traps and accessories therefor, namely, trap collection nets, net props, plastic killing jars with connecting sleeves, and single ring net bags

Mark Drawing Code (1) TYPED DRAWING

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6/18/01

Serial Number 76001179

Filing Date March 16, 2000

Filed ITU FILED AS ITU

Published for December 12, 2000

Opposition

Owner (APPLICANT) CLARKE MOSQUITO CONTROL PRODUCTS, INC. CORPORATION ILLINOIS 159 Garden Avenue Roselle ILLINOIS 60172

Attorney of Record Joel H. Bock

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Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE



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6/13/01

Type of Mark SERVICE MARK
 Register PRINCIPAL
 Affidavit Text SECT 15. SECT 8 (6-YR).
 Live/Dead Indicator LIVE





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Word Mark VIKING TERMITE AND PEST CONTROL

Goods and Services IC 042. US 100 101. G & S: lawn care services directed to controlling pests and weeds with pesticides and herbicides; radon detection services. FIRST USE: 19801117. FIRST USE IN COMMERCE: 19941201

IC 037. US 100 103 106. G & S: pest control services directed to insects, rodents, deer, pigeons, bats and the like; 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. FIRST USE: 19801117. FIRST USE IN COMMERCE: 19941201

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 020113 090525

Serial Number 74676610

Filing Date May 15, 1995

Published for Opposition July 30, 1996

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6/18/01

Registration Number 2009658
Registration Date October 22, 1996

Owner (REGISTRANT) Viking Termites and Pest Control, Inc. CORPORATION NEW JERSEY 711 East Main Street Bridgewater NEW JERSEY 08807

Attorney of Record Robert S. Raymar

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TERMITE AND PEST CONTROL" APART FROM THE MARK AS SHOWN

Description of Mark The mark "VIKING TERMITE AND PEST CONTROL" is lined for the color red.

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE





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Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark HOME SAVING TERMITE CONTROL, INC.

Goods and Services IC 037. US 100 103 106. G & S: 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. FIRST USE: 19771100. FIRST USE IN COMMERCE: 19780000

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 031501 031519 031524 240907 260128

Serial Number 74600373

Filing Date November 18, 1994

Published for Opposition September 5, 1995

Registration Number 1938436
 Registration Date November 28, 1995
 Owner (REGISTRANT) Home Saving Termite Control, Inc. CORPORATION
 CALIFORNIA 8854 Elizabeth Lake Road Leona Valley CALIFORNIA 93551
 Attorney of Record Scott W. Kelley
 Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TERMITE CONTROL INC." APART FROM THE MARK AS SHOWN
 Type of Mark SERVICE MARK
 Register PRINCIPAL
 Live/Dead Indicator LIVE





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OR to record: Record 7 out of 8

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Word Mark	EARTH TOUCH ORGANIC PEST CONTROL
Goods and Services	IC 005. US 006 018 044 046 051 052. G & S: pesticides for domestic use. FIRST USE: 19960401. FIRST USE IN COMMERCE: 19960401
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	010701
Serial Number	74556397
Filing Date	August 2, 1994
Filed ITU	FILED AS ITU
Published for Opposition	December 12, 1995
Registration Number	2029137
Registration Date	January 7, 1997
Owner	(REGISTRANT) EARTH TOUCH FRANCHISE CORPORATION CORPORATION NEW MEXICO 4203 Lead SE Albuquerque NEW MEXICO 87108

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6/18/01

Attorney of Record Leo L. Miller

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Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE





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List At: OR to record: Record 8 out of 8

Quick Search (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark	POLY CONTROL
Goods and Services	IC 001, US 006. G & S: chemicals; namely, stickers and drift control agents for pesticides, FIRST USE: 19820610. FIRST USE IN COMMERCE: 19820610
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74148342
Filing Date	March 18, 1991
Published for Opposition	October 22, 1991
Registration Number	1671533
Registration Date	January 14, 1992
Owner	(REGISTRANT) J L B International Chemical, Inc. CORPORATION FLORIDA P.O. Box 6006 Vero Beach FLORIDA 32960 (LAST LISTED OWNER) BREWER INTERNATIONAL, INCORPORATED CORPORATION FLORIDA
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Carroll F. Palmer
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CONTROL" APART FROM THE MARK AS SHOWN

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6/18/01

Type of Mark TRADEMARK
 Register PRINCIPAL
 Affidavit Text: SECT 15. SECT 8 (6-YR).
 Live/Dead
 Indicator LIVE



File No.: UNVL-2-25325
Atty/Secy: CLC/EEF:jh
Applicant: Univar USA Inc.
Mark: KONTROL
Int'l Class(es): 5

Date: 10/31/02
Serial No.: 76/159,040

The following have been received in the U.S. Patent and Trademark Office on the date stamped hereon via first-class mail, with a signed Certificate of Mailing:

Request for Reconsideration (5 pages)
Exhibit A (17 pages)