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

Proceeding	77798045
Applicant	Woodstream Corporation
Applied for Mark	QUICK KILL
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE:	:
Woodstream Corporation	:
Serial No. 77798045	:
Mark: Miscellaneous Design	:
Filed: August 5, 2009	:
Law Office: 111	:
Examining Attorney: Susan Leslie DuBois	:

BRIEF ON EX PARTE APPEAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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IN RE:	:
Woodstream Corporation	:
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BRIEF ON EX PARTE APPEAL

Applicant, Woodstream Corporation, hereby submits the following brief in support of its appeal of the final refusal to register in the above application.

I. STATEMENT OF ISSUES

Whether the record establishes a likelihood of confusion between Applicant's mark, QUICK KILL for "mouse traps" in International Class 21, with the mark of Registration No. 3769150 (the "Cited registration"), AMDRO QUICK KILL, as applied to the goods set forth in that registration, "insecticides" in International Class 5, taking into account the disclaimer of "quick kill" in the cited registration.

II. DESCRIPTION OF THE RECORD

The record herein consists of the following:

- Application serial no. 77798045

- Office Action dated November 9, 2009, with particulars of the cited registration (then pending as an application) and certain third party registrations, attached[1]
- May 10, 2010 Response to Office Action
- Office Action dated May 28, 2010, with particulars of the cited registration attached[2]
- November 29, 2010 Response to Office Action[3]
- Office Action dated December 21, 2010[4]
- June 21, 2011 response to Office Action with attached Declaration of Harry E. Whaley, President of Applicant, and Exhibits A through F, thereto
- July 1, 2011 Office Action, withdrawing refusal to register under 2(e)(1), and making final refusal to register under 2(d), with particulars of third-party registrations and print outs from certain Internet web sites, attached.

III. RECITATION OF FACTS

This is an application under §§1(a) and 2(f) of the Trademark Act, as amended. As set froth in the present application and supported by the Declaration of Harry E. Whaley made of record herein, Applicant has been using its QUICK KILL mark for mouse traps for over thirteen (13) years.

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[1] There were additional attachments to the November 9, 2009 Office Action related to an initial refusal to register Applicant's mark under §2(e)(1) of the Trademark Act. Following Applicant's amendment of the present application to one seeking registration under §2(f), the refusal to register under §2(e)(1) was withdrawn.

[2] There were additional attachments to the May 28, 2010 Office Action pertaining solely to the refusal to register under §2(e)(1). *See* n. 1, *supra*.

[3] Certain registrations of Applicant Woodstream, pertaining to the §2(e)(1) refusal were attached to the November 29, 2010 Response.

[4] Again, attachments pertinent to the §2(e)(1) refusal were included.

Registration on this application has been refused under §2(d) of the Trademark Act on the grounds of an asserted likelihood of confusion with registration no. 3769150, the mark and goods of which are set forth above. The cited registration contains the following: "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE 'QUICK KILL', APART FROM THE MARK AS SHOWN."

IV. ARGUMENT

In the July 1, 2011 Office Action, the Examining Attorney states:

> The refusal is made final in the action because the goods are related and the presence of the term "AMDRO" is insufficient to distinguish the marks. The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect registrant from adverse commercial impact due to use of a similar mark by a newcomer.

Thus, the Examining Attorney determined that the disclaimer of "quick kill" in the cited registration, essentially, should be ignored. Further, finding "AMDRO" to be a "house mark" of the registrant of the cited registration, the Examining Attorney asserted as a matter of law that it, too, should be ignored, concluding that, "Applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark."

In so doing, the Examining Attorney failed to apply controlling principles of law applicable to the facts of, and record in, this application. When the proper analysis is made, the record does not support the finding of a likelihood of confusion between the mark of the cited registration, as applied to the goods set forth therein, and Applicant's mark, as applied to its goods.

A. The Disclaimer in the Cited Registration Must Be Given Due Consideration.

The cited registration completely disclaims *any* exclusive right to use QUICK KILL ***apart from the mark as shown*** in the cited registration. Thus, the owner of the cited registration expressly has disclaimed any right to exclude Applicant from using its mark as set forth in the present application.

The Examining Attorney has stated, however, that "[p]urchasers are not aware of disclaimers that reside only in the records of the Office." This completely misses the point. The disclaimer is not noted as evidence of consumer awareness of the U.S. Patent and Trademark Office records. Rather, it is persuasive evidence that the disclaimed term, as used by the registrant on its goods, is non-distinctive and weak. The status of a cited mark or portion of a cited mark, as weak, in turn, circumscribes the parameters of the scope of protection afforded such mark/portion of the mark and the cited registration. *See In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975) (emphasis added):

> This is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as "weak" marks, and the scope of protection extended to these marks has been ***limited to the substantially identical notation and/or*** to the subsequent use and registration thereof for ***substantially similar goods***.

Accord Bass Pro Trademarks, LLC v. Sportsman's Warehouse, Inc., 89 U.S.P.Q. 2d 1844, 1857-1858 (TTAB 2008):

> Moreover, it is well settled that when a mark, or a portion of a mark, is inherently weak, it is entitled to a narrow scope of protection. In other words, when a business adopts a mark incorporating a descriptive term, it assumes the risk that competitors may also use that descriptive term. *Milwaukee Nut Co. v. Brewster Food Service*, 277 F.2d 190, 47 C.C.P.A. 914, 1960 Dec. Comm'r Pat. 252, 125 USPQ 399, 401 (CCPA 1960) (opposer acted at its peril in choosing a highly

> suggestive mark). *See also Sure-Fit Products Co. v. Saltzon Drapery Co.*, 254 F.2d 158, 45 C.C.P.A. 856, 1958 Dec. Comm'r Pat. 236, 117 USPQ 295, 296 (CCPA 1958) (competitors may come closer to the senior mark without creating a likelihood of confusion than would be the case with a strong mark).

See also King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 1401, 182 USPQ 108 (C.C.P.A. 1974) ("[B]ecause the [cited] marks are of such non-arbitrary natures . . . the public can easily distinguish slight differences in the marks under consideration as well as the differences in the goods to which they are applied, even though the goods of the parties may be considered "related."); *General Mills v. Kellogg Company*, 824 F.2d 622, 626, 3 USPQ2d 1442 (6th Cir. 1987) ("Determining that a mark is weak means that consumer confusion had been found unlikely because the mark's components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related."); TMEP §1207.01(b)(viii)("If the common element of two marks is 'weak' in that it is generic, descriptive, or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality.").

Instead of applying this clear and well established principle of law, the Examining Attorney states that the disclaimed portion of a mark "cannot be ignored," – in effect ignoring, in turn, the disclaimer. The cases cited by the Examining Attorney, however, do not stand for the proposition that a finding of confusing similarity can be based solely on the common presence of disclaimed matter in the cited registration. In the case, *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060 (Fed. Cir. 1985), the Board, and the Court, expressly noted that the wording at issue was ***NOT*** disclaimed in the cited registration, "and that the absence of a disclaimer in the registration 'must be presumed' to support the conclusion that it is not" descriptive. 753 F.2d at 1057-1058. Similarly, in neither *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669 (Fed. Cir. 1984) nor *In re Iolo Techs., LLC*, 95 USPQ2d 1498 (TTAB 2010), was the finding of confusing

similarity based solely and completely on the common presence of wording disclaimed in the cited registration.

B. Applicant's Goods are Not Substantially Similar to the Goods of the Cited Registration.

Applicant's goods, as set forth in its application, are mouse traps, in International Class 21. These are not "substantially identical" to the goods of the cited registration, which are insecticides, in Class 5.

While as a ***general*** proposition it may be true that goods of parties need not be directly competitive to find a likelihood of confusion, where, as here, the only similarity between the marks is a disclaimed term, different legal standards apply. Given the nature of the marks at issue, the Examining Attorney erred, as a matter of law, in concluding that the mere fact that the goods are "related" is sufficient to weigh this factor in favor of a likelihood of confusion in the context of this case.

Unquestionably, Applicant's goods (mouse traps, in Class 21) and the goods of the cited registration (insecticides, in Class 5) are different, regardless of whether they arguably are "related". These differences are enough to negate a likelihood of confusion even if the marks at issue are considered identical. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, *supra* (MISS KING's for cakes vs. KING's for candy); *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252 (5th Cir. 1980) (DOMINO for sugar vs. DOMINO'S for pizza).

C. Applicant's Mark is Distinguishable from, and Is Not Confusingly Similar to, the Mark of the Cited Registration.

As stated, the Examining Attorney concluded that other than the common presence of the wording "QUICK KILL", there is no wording to distinguish the mark of the cited registration from Applicant's mark. In reaching this conclusion, the Examining Attorney essentially excises

the wording "AMDRO" from the mark of the cited registration. The Examining Attorney asserts that such an approach is appropriate, as a matter of law, because "[i]t is well settled that when marks are otherwise virtually the same, the addition of a house mark is more likely to add to the likelihood of confusion than to distinguish the marks . . ."[5]

In support of this legal premise, the Examining Attorney cites, *inter alia*, TMEP §1207.01(b)(iii), but that provision sets forth the exact opposition proposition, in the context of this case:

> Determining whether there is a likelihood of confusion requires careful consideration of the nature of the common elements of the marks at issue, as well as the overall commercial impression created by each mark. . . . Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; **or** (2) ***the matter common to the marks*** is not likely to be perceived by purchasers as distinguishing source because it ***is merely descriptive or diluted.*** (emphasis added)

Thus, "AMDRO" is not, as the Examining Attorney treats it, a virtually non-existent element of the mark of the cited registration. To the contrary, as the first word in the mark, with all other wording disclaimed, AMDRO is the dominant, critical feature of the mark of the cited registration. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1351 (Fed. Cir. 2011); *In re Times Mirror Magazines, Inc.*, 4 U.S.P.Q. 2d 1474 (TTAB 2000). *See also* n. 5, *supra.*

Accordingly, even if Applicant's goods and the goods of the cited registration are considered to be closely related, the marks at issue are not confusingly similar. Because of the descriptive nature of "quick kill" – having been disclaimed in the cited registration and the

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[5] The Examining Attorney relies solely on a page "from registrant's website (*at Amdro*)" to show that "the company makes several products under the AMDRO house mark." It is submitted that the web page in the record shows only a single product type – insecticides. Indeed, the web site demonstrates that the registrant relies on the AMDRO name as the dominant, source identifying designation for its insecticides.

subject of a §2(f) requirement for registerability in the present application – the addition of the AMDRO house mark to QUICK KILL in registrant's mark is sufficient to preclude likelihood of confusion. *In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55-56 (TTAB 1984) (holding DESIGNERS/FABRIC (stylized) for retail fabric store services, and DAN RIVER DESIGNER FABRICS and design for textile fabrics, not likely to cause confusion, noting that, because of the descriptive nature of "DESIGNERS/FABRIC" and "DESIGNER FABRICS," the addition of "DAN RIVER" is sufficient to avoid a likelihood of confusion): "Although it has often been said that the addition of a trade name, house mark, or surname to one of two otherwise confusingly similar marks will not generally serve to avoid a likelihood of confusion between them, exceptions to this general rule are made . . . when the alleged product marks are highly suggestive or merely descriptive or play upon commonly used registered terms. *See also e.g.*, *Citigroup Inc. v. Capital City Bank Group, Inc.*, *supra* (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, *supra* (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design [with "GOLD'N CRUST" disclaimed] for coating and seasoning for food items, not likely to cause confusion, noting that, because "GOLDEN CRUST" and "GOLD'N CRUST" are

highly suggestive as applied to the respective goods, the addition of "ADOLPH'S" is sufficient to distinguish the marks).

V. CONCLUSION

In view of the foregoing, Applicant respectfully submits that the cited registration must be viewed and analyzed, for purposes of the likelihood of confusion analysis, in the context of the disclaimer contained therein, and the fact that the only portion of such mark which is common to Applicant's mark, is the disclaimed portion of the mark of the cited registration. Viewed in this light, both the respective goods and marks of the cited registration and those of the pending application are sufficiently distinguishable to avoid a likelihood of confusion.

Accordingly, the refusal to register under §2(d) should be withdrawn and the present application approved for publication.

Respectfully submitted,

WOODSTREAM CORPORATION

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By: /Marsha G. Gentner/

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