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Subject: U.S. TRADEMARK APPLICATION NO. 77798045 - QUICK KILL -
T37983US0 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77798045

MARK: QUICK KILL

CORRESPONDENT ADDRESS:

MARSHA G GENTNER
JACOBSON HOLMAN PLLC
400 7TH ST NW SUITE 600
WASHINGTON, DC 20004-2218

APPLICANT: Woodstream Corporation

CORRESPONDENT'S REFERENCE/DOCKET NO:

T37983US0

CORRESPONDENT E-MAIL ADDRESS:

trademark@jhip.com



GENERAL TRADEMARK INFORMATION:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Woodstream Corporation : BEFORE THE
Trademark: QUICK KILL : TRADEMARK TRIAL
Serial No: 77798045 : AND
Attorney: Marsha Gentner : APPEAL BOARD
Address: Jacobsen Holman PLLC : ON APPEAL
400 7th Street NW Suite 600
Washington DC 20004-2218

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the mark QUICK KILL for “mouse traps” because it is likely to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) with Registration No. 3769150 for the mark AMDRO QUICK KILL for “insecticides.”

SUMMARY OF THE CASE

On August 5, 2009, applicant filed the instant application for the mark QUICK KILL for mouse traps. On November 9, 2009, registration was refused pursuant to Section 2(e)(1) of the Trademark Act because the mark was deemed merely descriptive of the goods. Information regarding pending Application Serial No. 77721200 was also enclosed as a potential reference under Section 2(d). On May 28, 2010, the Section 2(e)(1) refusal was continued, and a Section 2(d) refusal was issued, based on Registration No. 3769150, which matured from the cited application. On December 21, 2010, the refusals under Sections 2(d) and 2(e)(1) were continued, and the claim of acquired distinctiveness under

Section 2(f) was rejected. Applicant submitted additional evidence of acquired distinctiveness on June 21, 2011, and the Section 2(e)(1) refusal was withdrawn on July 1, 2011. The Section 2(d) refusal was made final in that same Office Action. On January 3, 2012, the applicant filed a Notice of Appeal.

ISSUE

The issue on appeal is whether the applicant's mark QUICK KILL, applied to mouse traps, is confusingly similar to AMDRO QUICK KILL, registered for insecticides.

ARGUMENT

Applicant seeks registration on the Principal Register for the mark QUICK KILL for mouse traps. The examiner refused registration because of the existence of a registration for the mark AMDRO QUICK KILL for insecticides. Registration of a prospective mark must be refused pursuant to Section 2(d) of the Trademark Act when the mark so resembles a registered mark, that it is likely, when applied to the goods in question, to cause confusion, or to cause mistake or to deceive. TMEP §1207.01.

It is well-settled that Trademark Act Section 2(d) bars registration of a mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and

any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

The present case turns on two critical inquiries: similarity of the marks, and the similarity of the goods and trade channels of the goods. See *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.* The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). Second, the goods are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

I. APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE CITED REGISTRATION

A. *Similarity of the Marks*

Applicant has submitted an application for the proposed mark QUICK KILL, which is highly similar to the registered mark AMDRO QUICK KILL. The common use of the term QUICK KILL will lead consumers to believe that the closely related goods emanate from a single source. This is true despite the fact that the registered mark includes a disclaimer of the term QUICK KILL. It is well settled that disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). However, it is equally understood that the “QUICK KILL” portion of the mark cannot be ignored, as it is not removed from the mark for the purposes of this analysis. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). Further, purchasers of the insecticides are not aware of disclaimers that reside only in the records of the Office.

This acknowledgement of disclaimed text is particularly relevant when the disclaimed portion of one mark comprises the entirety of the other mark. In essence, the applicant is

asking the Office to treat the term “QUICK KILL” as non-distinct and weak, and therefore entitled to a lesser degree of protection – except for when assessing the registrability of the term in its own application.

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for *closely related goods*. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). [emphasis added]. As such, the question at hand turns on whether the goods in this case are considered “closely related.” It is the position of the Office that mouse traps and insecticides are closely related for purposes of analysis under Section 2(d) of the Trademark Act.

B. Similarity of the Goods

Applicant seeks registration for mouse traps, and the registrant has identified insecticides. As discussed during the prosecution of this application, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead

to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

The evidence of record firmly establishes that the goods are related. Not only does the applicant itself offer both insecticides and mousetraps, but so do several other entities. In addition, industry professionals define both items as forms of "pest control." As such, applicant's and registrant's goods are considered closely related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009). In support of this assertion, the examining attorney submitted evidence to show common source, identical channels of trade and the industry perspective. The following is a brief summary of the evidence of record:

Office Action dated November 9, 2009:

1. Third Party Registrations: The examining attorney submitted copies of six different third party registrations that showed a common source for mouse traps and insecticide:
 - a. RN 2723239 SYSTEM SILVALURE: includes preparations for destroying vermin, insecticide; originally included mouse traps;
 - b. RN 2902699 ZEP COMMERCIAL: includes both insecticides and mouse traps;
 - c. RN 2907597 ZEP COMMERCIAL: includes both insecticides and mouse traps;
 - d. RN 3445201 W WOODSTREAM: includes both rodent traps and insecticides, pesticides and electric devices for attracting and killing insects and rodents (NOTE: This is applicant's registration);
 - e. RN 3365748 FUMAKILLA: includes both insecticides and mouse traps;

- f. RN 3352168 VAPE: includes both insecticides and mouse traps.

Office Action dated May 28, 2010:

1. **Internet evidence:** The examining attorney included pages from the website for Revenge, a company that makes both insecticides and mouse traps.

Final Refusal dated July 1, 2011:

1. **Third Party Registrations:** The examining attorney submitted copies of additional third party registrations that showed a common source for mouse traps, rodenticides and insecticides. *See pp.6-31*
 - a. RN 1945137 D CON: shows both insecticides and rodenticides;
 - b. RN 2289011 D CON: shows rodent traps (same owner as above);
 - c. RN 2809905 VICTOR: shows insecticides and rodent traps (NOTE: This registration is owned by the applicant);
 - d. RN 3859038 SILVALURE: shows insecticides and mouse traps;
 - e. RN 3754782 VICTOR: shows insecticides and rodent traps (NOTE: This registration is owned by the applicant);
 - f. RN 3445202 WOODSTREAM: shows insecticides and electric devices for attracting and killing insects and rodents (NOTE: This registration is owned by the applicant);
2. **Industry Specific Evidence:** The examining attorney made of record pages from the National Pest Management Association that identifies “pest control” as both the eradication of rodents and insects. As such, the different goods share a common purpose, and fall within the same industry. *See pp.4-5*
3. **Competitor Evidence:** The examining attorney also included pages from Orkin, which offers eradication of rodents and insects; and from PestMall.com, where ordinary consumers can purchase both insecticides and mouse traps from the same website. *See pp. 32-43*
4. **Registrant’s Website:** In order to show that the term is a house mark with a line of products offered under the “AMDRO” name, the examining attorney submitted pages from applicant’s website that shows the following products offered with the AMDRO house mark. *See pp.43-46*
 - a. AMDRO Fire Ant Bait
 - b. AMDRO FireStrike
 - c. AMDRO FireStrike Mound
 - d. AMDRO Ant Block
 - e. AMDRO Bug Bait

This comprehensive showing conclusively establishes that the goods are highly related because they perform the same basic function (the eradication of pests), they are offered in the same manner to ordinary consumers, they are produced by the same entities (including the applicant: see reference to RN 3445201 W WOODSTREAM, *supra*), and they are categorized together by the National Pest Management Association. In essence, the applicant has merely adopted a portion of a registered mark and applied it to highly related goods. Confusion as to the source of the goods is likely in such cases, and registration must be refused under Section 2(d) or the Trademark Act.

C. Applicant's Arguments

Applicant has advanced several arguments in favor of registration. Chief amongst them is the argument that the marks are distinguishable because of the addition of the registrant's house mark "AMDRO," and because of the registrant's proffered disclaimer of "QUICK KILL." Applicant seems to suggest that the registrant's mark is entitled to a narrow scope of protection because it includes a weak and descriptive term, disclaimed by registrant in the registration process. This argument fails to be persuasive when one acknowledges that the very term applicant claims is weak and entitled to a lower level of protection – "QUICK KILL" – is the sole element of its' own proposed mark.

Moreover, contrary to the applicant's assertion, the referenced cases *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) and *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) and *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010) do support the premise that "the technicality of a disclaimer ... has **no** legal effect on the likelihood of confusion." 224

USPQ at 751. (emphasis supplied). In fact, the Court of Appeals for the Federal Circuit in the *In re Nat'l Data Corp.* case went on to state that the “public is **unaware** of what words have been disclaimed during prosecution of the trademark application at the PTO.” *Id.* (emphasis supplied). Accordingly, “it is **inappropriate** to give the **presence** or absence of a disclaimer any legal significance.” *Id.* (emphasis supplied).

The examining attorney also does not dispute that the house mark “AMDRO” is the most significant source-identifying element in the registered mark. That acknowledgement in no way diminishes the registrant’s right to protection of the mark as the term “AMDRO QUICK KILL.” As stated *inter alia*, marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974).

The applicant focuses on the fact the goods at issue are “different” without really addressing that both goods serve an essentially similar purpose and are offered by the same purveyors in multiple instances. The applicant even goes so far to state that “[t]hese differences are enough to negate a likelihood of confusion even if the marks at issue are considered identical.” See *Applicant’s Brief*, p. 6. The examining attorney strongly disagrees.

The test is not that the goods are “different” or that they are “identical” to support a Section 2(d) refusal. Instead, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods would be encountered by the same consumers under circumstances such that offering the goods under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i). As shown above, it is clear that applicant’s mouse traps are related to the registrant’s insecticides.

When related goods are offered under marks that share a common term, particularly where there is a lack of any other distinguishable material in the applicant mark, confusion as to the source of the goods is likely, and registration must be refused.

This is applicable when the additional material is the registrant’s house mark, as in the instant case. As discussed in the prosecution phase of this case, 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; it is likely that the two products sold under such marks would be attributed to the same source. See *In re Dennison Mfg. Co.*, 229 USPQ 141, 144 (TTAB 1986) (holding GLUE STIC for general purpose adhesive in stick form likely to be confused with UHU GLU STIC for adhesives for paper and stationery). It should be noted that the *In re Dennison Mfg.* case is almost

identical to the present application. In that case, the registrant's mark was UHU GLU STIC with the wording GLU STIC disclaimed. The applicant sought registration of the mark GLUE STIC on the Supplemental Register. In this case, applicant is seeking to register its mark under Section 2(f). Nevertheless, the Board upheld the Section 2(d) refusal because it deemed that the disclaimed term and the proposed mark on the Supplemental Register were "terms which are capable of distinguishing such goods, and hence proprietary rights may be established in them." *Id.* at footnote 6. Similarly, the term QUICK KILL is capable of distinguishing the parties' goods and that proprietary rights are established in them. Therefore, the addition of the housemark AMDRO to the registrant's mark does not detract from the 2d analysis, and in fact adds to the likelihood of confusion. 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; it is likely that the two products sold under such marks would be attributed to the same source. *In re Dennison Mfg. Co.*, 229 USPQ 141, 144 (TTAB 1986) (holding GLUE STIC for general purpose adhesive in stick form likely to be confused with UHU GLU STIC for adhesives for paper and stationery); *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168, 170 (TTAB 1982) (holding SKIN SAVERS for face and throat lotion likely to be confused with MENNEN SKIN SAVER for hand and body lotion); see *Hammermill Paper Co. v. Gulf States Paper Corp.*, 337 F.2d 662, 663, 143 USPQ 237, 238 (C.C.P.A. 1964) (holding HAMMERMILL E-Z CARRY PAK and E-Z PAPER PAK for carrying cases or boxes for typewriter or duplicator paper likely to be confused with E-Z PAK and E-Z CARI for paper bags); TMEP §1207.01(b)(iii).

D. Conclusion

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Both marks share the identical wording “QUICK KILL.” The evidence of record also establishes that applicant’s goods and registrant’s goods are closely related goods. Therefore, for the reasons set forth above, confusion as to the source of the goods is likely. Consequently, it is respectfully requested that Trademark Trial and Appeal Board affirm the final refusal based upon Section 2(d) of the Trademark Act.

Respectfully submitted,

/Susan Leslie DuBois/
Trademark Attorney
Law Office 111
phone 571-272-9154
susan.dubois@uspto.gov

Robert Lorenzo
Managing Attorney
Law Office 111