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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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IN RE: :

Woodstream Corporation :

Serial No. 77798045 :

Mark: QUICK KILL :

Filed: August 5, 2009 :

Law Office: 111 :

Examining Attorney: Susan Leslie DuBois :

REPLY BRIEF ON EX PARTE APPEAL

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REPLY BRIEF ON EX PARTE APPEAL

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

INTRODUCTION

The Examining Attorney’s Appeal Brief (hereafter, the “EA Brief”) states that the “overriding concern” of the §2(d) refusal to register on appeal herein is “to protect the registrant from the adverse commercial impact due to use of a similar mark by a newcomer.” EA Brief, p.3.¹ This illustrates the disconnect in the Examining Attorney’s analysis, between the nature of

¹ Applicant recognizes that it cannot pursue a claim of priority vis-à-vis the mark of the cited registration in the context of this ex parte appeal. This notwithstanding, given Applicant’s long (15 years) use of the mark, which is undisputed in the record, it seems at least odd that the Examining Attorney would place such reliance on the role of Applicant as the “newcomer” improperly invading the commercial territory of the registrant, a role which is pure fiction. See also EA Brief, p. 6 (“applicant has adopted a portion of a registered mark . . .”). There is absolutely no support in the record for this assertion; following proper Board procedure is one thing, but making up facts ascribing to Applicant an ill motive which simply and patently does not exist, is quite another. Indeed, it would seem that the policy consideration more applicable here is that the Register accurately reflect what long has been occurring in the marketplace.

the mark of the cited registration – in particular the registrant’s disclaimer of any rights in “quick kill” – and the impact that this admission of descriptiveness must have in determining the proper standards, and applying those standards, with respect to the remaining pertinent factors of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). In choosing a mark including a term that, admittedly, is descriptive of the goods of the cited registration, the registrant consciously has forgone, and indeed expressly has waived, any entitlement to such protection.² See *Bass Pro Trademarks, LLC c. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1857 (TTAB 2008):

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 Applicant’s Brief on Ex Parte Appeal (“Applicant’s Brief”), pp. 4-5.

The Examining Attorney, nevertheless, remains steadfast in asserting that the disclaimer of the only common element between the mark of the cited registration and Applicant’s mark “has **no** legal effect on the likelihood of confusion,” EA Brief, p. 7 (emphasis in original), purportedly quoting *In re Nat’l Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985). The Examining Attorney misunderstands the quoted language in *Nat’l Data*. In that case, the disclaimer in question was made by the *applicant*, in its application; there was no disclaimer in the cited registration. Thus, the court rightly held that the applicant could not saddle the registrant with the applicant’s waiver of rights and admission of descriptiveness; the absence of exclusive rights as to the wording in question, with respect to the *registrant’s* mark and the goods of the cited

² The cited registration contains the following statement: “NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE ‘QUICK KILL’ APART FROM THE MARK AS SHOWN.”

registration, would have to be proven by the applicant.³ Here, by contrast, the disclaimer is contained in the cited registration, and the waiver *by the registrant* is explicit. *See* TMEP §1213 (“A disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark in a trademark application or registration.”). As the court in *Nat’l Data* expressly made clear, this is highly significant to the issue of likelihood of confusion. 753 F.2d at 1058-1059: “Without question, the descriptive or generic character of an expression which forms part of both marks under consideration is pertinent to the issue of likelihood of confusion.”

1. The Examining Attorney fails to apply, and/or inconsistently applies, the proper standards for comparison of marks and goods when the sole commonality between two marks is wording that has been disclaimed by the registrant.

The Examining Attorney does acknowledge (EA Brief, p. 4) that the descriptive status of the disclaimed portion of the mark of the cited registration means the mark/portion of the mark is entitled to a more narrow scope of protection, which in turn affects how the pertinent *du Pont* factors are assessed. *See, e.g. 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***.

See also Applicant’s Brief, pp.4-5, and cases cited therein.

³ This is why (contrary to the implication at p.4 of the EA Brief) Applicant may take the position – which has been accepted in the present application – that its mark has acquired distinctiveness as to *Applicant’s goods*, notwithstanding the disclaimer and waiver of rights in that term by registrant in the cited registration.

In terms of the comparison of goods, the Examining Attorney fluctuates from giving lip service to an analysis that requires the goods to be “closely related” (EA Brief, p. 4), to “are related” or “otherwise related in some manner” (*id.*), to merely “essentially similar [in] purpose” (*id.*, p. 7). As for the comparison of marks analysis, the Examining Attorney advocates a test that requires only that Applicant’s mark be a “similar mark” to that of the cited registration (*id.*, p. 4). This is not the law as applied to this case; rather, the marks at issue must be *substantially identical* and/or used for *substantially similar goods*. *In re Hunke & Jochheim, supra*.

2. Applicant’s goods and those of the cited registration are not “substantially similar”.

The EA Brief urges that there is sufficient evidence of record to satisfy the “otherwise related in some manner” or even the (amorphous, ambiguous and undefined) “closely related” standard for comparing the respective goods at issue. Whether the record would be sufficient, in the context of other cases, to satisfy this *du Pont* factor is immaterial to the present application, however. *See also* Applicant’s Brief, p. 6.

Applicant’s goods are mouse traps – mechanical goods for trapping and (eek!) killing mice. The goods of the cited registration are insecticides – chemicals that kill insects. *See* THE AMERICAN HERITAGE STEDMAN’S MEDICAL DICTIONARY, retrieved May 23, 2012, from Dictionary.com website: <http://dictionary.reference.com/browse/insecticide>.⁴ Contrary to the Examining Attorney’s assertion (EA Brief, p. 7), they are not “essentially similar in purpose.”⁵ That Applicant’s goods and the goods of the cited registration broadly belong to the same genus

⁴ Judicial notice may be taken of a dictionary definition. *See In re Box Solutions Corp*, 79 USPQ2d 1953, 1956 (TTAB 2006).

⁵ Thus, Applicant’s goods and the goods of the cited registration are not simply goods that perform the identical function through different technology. *Compare In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266 (TTAB 2009), relied upon by the Examining Attorney (EA Brief, p. 5) (applicant’s goods and goods of the cited registration both medical diagnostic equipment which merely used different imaging technologies).

(EA Brief, p. 5: “forms of ‘pest control’”) does not make them substantially similar goods for purposes of the likelihood of confusion analysis. *See, e.g., In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (not all alcoholic beverages are related); *Information Resources, Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1037, 1039 (TTAB 1988) (not all computer products are related); *In re August Storck KG*, 218 USPQ 823, 825 (TTAB 1983) (not all food products are related).

3. Applicant’s mark and the mark of the cited registration are not “substantially identical.”

In the Examining Attorney’s analysis (EA Brief, p. 8), Applicant’s mark and the mark of the cited registration are “virtually the same.” Patently, they are not. The mark of the cited registration is AMDRO QUICK KILL, not QUICK KILL. “The examining attorney does not dispute that the house mark ‘AMDRO’ is the most significant source-identifying element in the registered mark.” *Id.*, p. 8.⁶ Indeed, the Examining Attorney’s evidence of the registrant’s use of its house mark – AMDRO followed by a generic or descriptive term for the insecticide in question – further confirms that AMDRO will be perceived by potential purchasers as the dominant portion of the mark of the cited registration.

The only similarity between Applicant’s mark and the mark of the cited registration is the very wording in which the registrant *expressly* has disclaimed and waived any rights, *standing alone*.⁷ The registrant itself has disavowed any right, through the cited registration, to bar Applicant’s use or registration of its mark on this basis alone (at least on grounds of exclusive rights). *See* TMEP §1213 (“A disclaimer is a statement that the applicant or registrant does not

⁶ And yet later in the EA Brief (p. 8), the Examining Attorney reverts to the position that the AMDRO “house mark is more likely to add to the likelihood of confusion . . .” This is an assertion addressed, and completely refuted, in Applicant’s Brief, pp. 7-9.

⁷ *See* n. 2, *supra*.

claim the exclusive right to use a specified element or elements of the mark in a trademark application or registration.”).

Despite this, and the acknowledged dominance of the distinguishing AMDRO feature as the “most significant source-identifying element” of the cited mark, the Examining Attorney asserts this is insufficient, because the QUICK KILL terminology disclaimed in that mark comprises the wholly of Applicant’s mark. *See* EA Brief, p. 4. It is a well established principle of law, however, that “[a]dditions . . .to marks may be sufficient to avoid a likelihood of confusion if . . . the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” TMEP §1207.01(b)(iii). *See also* Applicant’s Brief, p. 7. Thus, numerous case have found no likelihood of confusion where the entirety of one mark is included within the other mark at issue, as used for related or even competitive, goods and/or services. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1351 (Fed. Cir. 2011) (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); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (CCPA 1970) (because common element in marks is a common noun or adjectival word of everyday usage in the English language and has a laudatory or suggestive indication, PEAK PERIOD for personal deodorants is not confusingly similar to PEAK for dentifrice); *In re White Rock Distilleries, Inc.*, 92 USPQ2d at 1284 (FOSSIL in standard characters does not create confusion with FOSSIL combined with other wording or design); *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); *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”).

CONCLUSION

The registrant has expressly waived and disclaimed any exclusive right to use or register **Applicant’s mark**, even as to registrant’s insecticides, let alone Applicant’s (different) mouse traps. *See* n. 2, *supra*. The registrant having expressly represented that through the cited registration, it seeks protection of QUICK KILL only as, and to the extent it is, part of the whole of the registered mark (*id.*), the initial, dominant, “source-identifying” house mark AMDRO in that mark is more than sufficient to distinguish that mark from Applicant’s mark, under the appropriate likelihood of confusion standards pertinent to the facts of this case. Accordingly, and for all of the reasons set forth in Applicant’s Brief, Applicant respectfully requests that the §2(d) refusal be reversed, and the present application remanded for publication.

Respectfully submitted,

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Dated: May 23, 2012

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