

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77931859
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The above referenced action finalizes the refusal of registration in Class 16 under Section 2(d) in view of the registration for THE BUG AWAY! BAG, subject of U.S. Reg. No. 3,187,827, and in Class 5 under Section 2(d) in view of the registration for BUGSAWAY, subject of U.S. Reg. No. 3,703,584. Based on the following, Applicant requests reconsideration.</p> <p>As to the refusal of registration in Class 16, the cited registration is now owned by Bugaway Holdings, LLC, the instant applicant, and the USPTO assignment recordation history reflects this (see enclosed copies from the TARR and Assignment databases listing current applicant as the owner). Given common ownership, the refusal to register should be withdrawn.</p> <p>As to the refusal of registration in Class 5, Applicant maintains that the citation of U.S. Reg. No. 3,703,584 (for the mark BUGSAWAY covering class 25 clothing items) is misplaced. Moreover, Applicant has now amended the goods description in Class 5 to make abundantly clear that the insect repellent referenced is a moisturizing liquid used on skin. Therefore the contention that underlies the refusal to register, i.e., that “applicant’s goods are used as an integral component of registrant’s goods” is refuted. Applicant’s goods are not used on clothing, or to infuse clothing, and there is no connection between Applicant’s moisturizing skin liquid repellent and the goods in the cited registration.</p> <p>Applicant also reiterates that the owner of the cited registration itself argued that its goods were unrelated to insect repellent in the course of overcoming a prior registration for BUGAWAY insect repellent, now lapsed, which was owned by Applicant’s predecessor. Indeed, the registrant stated that there was a “clear differentiation” between clothing and insect repellent product types and that there was no likelihood of confusion. With Applicant’s goods amendment, that “differentiation” is now unmistakable.</p> <p>And Applicant strongly disagrees with the Examining Attorney’s argument implying, with no support, that the holding in the <i>Albert Trostel</i> case is mere dicta. That case clearly holds that arguments submitted earlier by the owner of a currently cited mark against one of Applicant’s earlier registrations expresses registrant’s “opinion that there is no likelihood of confusion...” and “[the TTAB] is not inclined to ‘second guess the conclusions of those most familiar with the marketplace’ on the issue of</p>	

likelihood of confusion.” *In Re Albert Trostel & Sons Co.*, 29 U.S. P.Q.2d 1783, 1786 (TTAB 1993).

The evidence of record also fails to show that consumers would encounter the same mark used on clothing products and insect repellent products, let alone the type of skin moisturizing repellent that is now recited as Applicant’s goods. Moreover, the Internet evidence submitted with the Final action does not even establish that any clothing goods are infused with a repellent sold separately as a liquid under the same brand name. These website excerpts merely show clothing that incorporates some type of repellent, mainly synthetic permethrin based repellants. Permethrin is an odorless pesticide and can be toxic. In contrast, Applicant’s repellants, used on skin, use citronella oil, a natural and topically non-toxic aromatic repellent.

It is clear that the refusal to register is founded on a mere theoretical association between otherwise different and distinct goods. But the mere possibility that a consumer *could theoretically* associate the respective goods at issue does not establish relatedness sufficient to support a likelihood of confusion. *See: Steve’s Ice Cream v. Steve’s Famous Hot Dogs* , 3 U.S. P.Q.2d 1477, 1478 (TTAB 1987). Moreover, Applicant’s goods amendment distances the goods at issue even more, and thus refutes even the theoretical association advanced in the Final action. In view of this, the refusal to register should be withdrawn.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_631381729-155601914 . BUGAWAY - Arguments attachment_F0936825 .PDF
CONVERTED PDF FILE(S) (6 pages)	\\TICRS\EXPORT11\IMAGEOUT11\779\318\77931859\xml7\RFR0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\779\318\77931859\xml7\RFR0003.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\779\318\77931859\xml7\RFR0004.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\779\318\77931859\xml7\RFR0005.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\779\318\77931859\xml7\RFR0006.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\779\318\77931859\xml7\RFR0007.JPG
DESCRIPTION OF EVIDENCE FILE	THE BUG AWAY! BAG - TARR Record

GOODS AND/OR SERVICES SECTION (005)(current)

INTERNATIONAL CLASS	005
DESCRIPTION	Insect repellent
FILING BASIS	Section 1(b)

GOODS AND/OR SERVICES SECTION (005)(proposed)

INTERNATIONAL	
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CLASS	005
TRACKED TEXT DESCRIPTION	
Insect repellent ; Moisturizing insect repellent liquid for use on skin	
FINAL DESCRIPTION	Moisturizing insect repellent liquid for use on skin
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (016)(no change)	
ADDITIONAL STATEMENTS SECTION	
PRIOR REGISTRATION(S)	The applicant claims ownership of U.S. Registration Number(s) 3187827.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/ctw/
SIGNATORY'S NAME	Charles T. J. Weigell
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	01/05/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Jan 05 17:10:06 EST 2012
TEAS STAMP	USPTO/RFR-63.138.172.9-20 120105171006557179-779318 59-4908c80edb729e528c7229 6155e146be0e8-N/A-N/A-201 20105155601914996

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **77931859** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The above referenced action finalizes the refusal of registration in Class 16 under Section 2(d) in view of the registration for THE BUG AWAY! BAG, subject of U.S. Reg. No. 3,187,827, and in Class 5 under Section 2(d) in view of the registration for BUGSAWAY, subject of U.S. Reg. No. 3,703,584. Based on the following, Applicant requests reconsideration.

As to the refusal of registration in Class 16, the cited registration is now owned by Bugaway Holdings, LLC, the instant applicant, and the USPTO assignment recordation history reflects this (see enclosed copies from the TARR and Assignment databases listing current applicant as the owner). Given common ownership, the refusal to register should be withdrawn.

As to the refusal of registration in Class 5, Applicant maintains that the citation of U.S. Reg. No. 3,703,584 (for the mark BUGSAWAY covering class 25 clothing items) is misplaced. Moreover, Applicant has now amended the goods description in Class 5 to make abundantly clear that the insect repellent referenced is a moisturizing liquid used on skin. Therefore the contention that underlies the refusal to register, i.e., that “applicant’s goods are used as an integral component of registrant’s goods” is refuted. Applicant’s goods are not used on clothing, or to infuse clothing, and there is no connection between Applicant’s moisturizing skin liquid repellent and the goods in the cited registration.

Applicant also reiterates that the owner of the cited registration itself argued that its goods were unrelated to insect repellent in the course of overcoming a prior registration for BUGAWAY insect repellent, now lapsed, which was owned by Applicant’s predecessor. Indeed, the registrant stated that there was a “clear differentiation” between clothing and insect repellent product types and that there was no likelihood of confusion. With Applicant’s goods amendment, that “differentiation” is now unmistakable.

And Applicant strongly disagrees with the Examining Attorney’s argument implying, with no support, that the holding in the *Albert Trostel* case is mere dicta. That case clearly holds that arguments submitted earlier by the owner of a currently cited mark against one of Applicant’s earlier registrations expresses registrant’s “opinion that there is no likelihood of confusion...” and “[the TTAB] is not inclined to ‘second guess the conclusions of those most familiar with the marketplace’ on the issue of likelihood of confusion.” *In Re Albert Trostel & Sons Co.*, 29 U.S. P.Q.2d 1783, 1786 (TTAB 1993).

The evidence of record also fails to show that consumers would encounter the same mark used on clothing products and insect repellent products, let alone the type of skin moisturizing repellent that is now recited as Applicant’s goods. Moreover, the Internet evidence submitted with the Final action does not even establish that any clothing goods are infused with a repellent sold separately as a liquid under the same brand name. These website excerpts merely show clothing that incorporates some type of repellent, mainly synthetic permethrin based repellants. Permethrin is an odorless pesticide and can be toxic. In contrast, Applicant’s repellants, used on skin, use citronella oil, a natural and topically non-toxic aromatic repellent.

It is clear that the refusal to register is founded on a mere theoretical association between otherwise different and distinct goods. But the mere possibility that a consumer *could theoretically* associate the respective goods at issue does not establish relatedness sufficient to support a likelihood of confusion. *See: Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 U.S. P.Q.2d 1477, 1478 (TTAB 1987). Moreover, Applicant’s goods amendment distances the goods at issue even more, and thus refutes even the theoretical association advanced in the Final action. In view of this, the refusal to register should be withdrawn.

EVIDENCE

Evidence in the nature of THE BUG AWAY! BAG - TARR Record has been attached.

Original PDF file:

[evi_631381729-155601914_.BUGAWAY_-_Arguments_attachment_F0936825_.PDF](#)

Converted PDF file(s) (6 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 005 for Insect repellent

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Insect repellent~~; [Moisturizing insect repellent liquid for use on skin](#)

Class 005 for Moisturizing insect repellent liquid for use on skin

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

ADDITIONAL STATEMENTS

Claim of Prior Registration(s)

The applicant claims ownership of U.S. Registration Number(s) 3187827.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /ctw/ Date: 01/05/2012

Signatory's Name: Charles T. J. Weigell

Signatory's Position: Attorney of record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the

applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77931859

Internet Transmission Date: Thu Jan 05 17:10:06 EST 2012

TEAS Stamp: USPTO/RFR-63.138.172.9-20120105171006557

179-77931859-4908c80edb729e528c72296155e

146be0e8-N/A-N/A-20120105155601914996

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-01-05 14:39:54 ET

Serial Number: 78029973 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3187827

Mark

THE BUG AWAY! BAG

(words only): THE BUG AWAY! BAG

Standard Character claim: Yes

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2006-12-19

Filing Date: 2000-10-10

Transformed into a National Application: No

Registration Date: 2006-12-19

Register: Principal

Law Office Assigned: LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-11-13

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. BUGAWAY HOLDINGS, LLC

Address:

BUGAWAY HOLDINGS, LLC
3199 ALBANY POST RD., SUITE 236
BUCHANAN, NY 10511
United States

Legal Entity Type: Limited Liability Company
State or Country Where Organized: New York

GOODS AND/OR SERVICES

International Class: 016
Class Status: Active
Disposable plastic garbage bags
Basis: 1(a)
First Use Date: 2001-06-00
First Use in Commerce Date: 2001-06-00

ADDITIONAL INFORMATION

Disclaimer: "BUG" and "BAG"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

- 2012-01-04 - Automatic Update Of Assignment Of Ownership
- 2006-12-19 - Registered - Principal Register
- 2006-11-09 - Law Office Registration Review Completed
- 2006-10-27 - Assigned To LIE
- 2006-10-23 - Allowed for Registration - Principal Register (SOU accepted)
- 2006-10-20 - Teas/Email Correspondence Entered
- 2006-09-28 - Communication received from applicant
- 2006-09-28 - TEAS Response to Office Action Received

2006-08-15 - Attorney Revoked And/Or Appointed
2006-08-15 - TEAS Revoke/Appoint Attorney Received
2006-08-09 - Withdrawal Of Attorney Granted
2006-08-09 - TEAS Withdrawal Of Attorney Received
2006-07-06 - Non-final action mailed
2006-07-06 - SU - Non-Final Action - Written
2006-06-24 - Teas/Email Correspondence Entered
2006-06-19 - Communication received from applicant
2006-06-21 - Automatic Update Of Assignment Of Ownership
2006-06-19 - TEAS Response to Office Action Received
2006-05-10 - Non-final action mailed
2006-05-10 - SU - Non-Final Action - Written
2006-04-18 - Statement Of Use Processing Complete
2006-04-18 - Use Amendment Filed
2006-04-18 - TEAS Statement of Use Received
2005-12-06 - Extension 1 granted
2005-12-06 - Extension 1 filed
2005-12-06 - TEAS Extension Received
2005-06-07 - NOA Mailed - SOU Required From Applicant
2005-03-15 - Published for opposition
2005-02-23 - Notice of publication
2004-11-13 - Law Office Publication Review Completed
2004-11-10 - Assigned To LIE
2004-11-08 - Assigned To LIE

- 2004-10-04 - Assigned To LIE
- 2004-09-28 - Approved For Pub - Principal Register
- 2004-09-10 - Teas/Email Correspondence Entered
- 2004-08-16 - Communication received from applicant
- 2004-08-16 - TEAS Response to Office Action Received
- 2004-03-15 - Case File In TICRS
- 2004-02-26 - Continuation of final refusal mailed
- 2002-10-31 - PAPER RECEIVED
- 2002-10-15 - Final refusal mailed
- 2002-10-09 - Assigned To Examiner
- 2001-11-12 - Communication received from applicant
- 2002-07-31 - Petition To Revive-Granted
- 2001-11-11 - Petition To Revive-Received
- 2002-01-15 - Assigned To Examiner
- 2001-10-26 - Communication received from applicant
- 2001-03-20 - Non-final action mailed
- 2001-03-16 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

James N. Dawe

Correspondent

James N. Dawe

Dawe & Christopherson LLP

Ste 484

550 Montgomery Street

San Francisco CA 94111

Phone Number: (415) 986-0340

Fax Number: (415) 986-0381



United States Patent and Trademark Office

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Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 5

Serial #: 78029973

Filing Dt: 10/10/2000

Reg #: 3187827

Reg. Dt: 12/19/2006

Registrant: MJC FORMULA LLC

Mark: THE BUG AWAY! BAG

Assignment: 1

Reel/Frame: 2834/0380

Received: 04/26/2004

Recorded: 04/26/2004

Pages: 6

Conveyance: NUNC PRO TUNC ASSIGNMENT

Assignor: 54 GROUP LTD., THE

Exec Dt: 03/02/2004

Entity Type: CORPORATION

Citizenship: NEW YORK

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: DELAWARE

Assignee: BUGAWAY BRANDS, LLC

20841 PRAIRIE STREET
CHATSWORTH, CALIFORNIA 91311

Correspondent: JACQUELINE ZION

PO BOX 560
GOLDENS BRIDGE, NY 10526

Assignment: 2

Reel/Frame: 3330/0867

Received: 04/26/2006

Recorded: 04/13/2006

Pages: 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: BUGAWAY BRANDS, LLC

Exec Dt: 03/28/2006

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: NONE

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: NONE

Assignee: MJC FORMULA LLC

2725 OAKDALE AVENUE, 2ND FL
SAN FRANCISCO, CALIFORNIA 94124

Correspondent: ADAM P. STEGMAN

GREENE RADOVSKY MALONEY, ET AL.
FOUR EMBARCEDERO, CA 94111

Assignment: 3

Reel/Frame: 4689/0089

Received: 12/29/2011

Recorded: 12/29/2011

Pages: 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: BUGAWAY LLC (F/K/A MJC FORMULA LLC)

Exec Dt: 02/12/2007

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: CALIFORNIA

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: DELAWARE

Assignee: BUGAWAY BRANDS, LLC

4104 PLEASANT RANCH ROAD
PLACERVILLE, CALIFORNIA 95667

Correspondent: CHARLES T.J. WEIGELL

FROSS ZELNICK LEHRMAN & ZISSU, P.C.
866 UNITED NATIONS PLAZA
NEW YORK, NY 10017

Assignment: 4

Reel/Frame: 4689/0096

Received: 12/29/2011

Recorded: 12/29/2011

Pages: 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: BUGAWAY BRANDS, LLC

Exec Dt: 07/24/2008

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: DELAWARE

Assignee: WESTBROOK MARKETING, LLC
3199 ALBANY POST RD., SUITE 236
BUCHANAN, NEW YORK 10511

Entity Type: LIMITED LIABILITY COMPANY
Citizenship: NEW YORK

Correspondent: CHARLES T.J. WEIGELL
FROSS ZELNICK LEHRMAN & ZISSU, P.C.
866 UNITED NATIONS PLAZA
NEW YORK, NY 10017

Assignment: 5

Reel/Frame: 4689/0094 **Received:** 12/29/2011

Recorded: 12/29/2011

Pages: 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: WESTBROOK MARKETING, LLC

Exec Dt: 12/28/2011

Entity Type: LIMITED LIABILITY COMPANY
Citizenship: NEW YORK

Entity Type: LIMITED LIABILITY COMPANY
Citizenship: NEW YORK

Assignee: BUGAWAY HOLDINGS, LLC
3199 ALBANY POST RD., SUITE 236
BUCHANAN, NEW YORK 10511

Correspondent: CHARLES T.J. WEIGELL
FROSS ZELNICK LEHRMAN & ZISSU, P.C.
866 UNITED NATIONS PLAZA
NEW YORK, NY 10017

Search Results as of: 01/05/2012 02:40 PM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.3
Web interface last modified: Dec 1, 2011 v.2.3

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