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57997-0058 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 85125792

MARK: STOP BUGGING ME!



CORRESPONDENT ADDRESS:

JAMES DAVID JOHNSON
JAMES DAVID JOHNSON PA
401 E LAS OLAS BLVD STE 130-290
FORT LAUDERDALE, FL 33301-2210

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: ConSeal International Incorporated

CORRESPONDENT'S REFERENCE/DOCKET NO:

57997-0058

CORRESPONDENT E-MAIL ADDRESS:

trademarks@prestigeip.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trademark STOP BUGGING ME! on the ground that it is likely to cause confusion with the registered mark QUIT BUGGING ME pursuant to §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

FACTS

The applicant applied to register the proposed mark STOP BUGGING ME! for "Insecticides; pesticides; pesticides for exterminating, namely, bed bugs and dust mites." Registration was refused on December 18, 2010 pursuant to Section 2(d) of the Trademark Act, because the proposed mark was likely to be confused with the registered mark QUIT BUGGING ME in Registration No. 3243838 used on "insect repellents."

The applicant responded on March 14, 2011 and argued against the refusal to register under Section 2(d). On April 7, 2011 the refusal to register under Section 2(d) was made final.

The applicant filed a Request for Reconsideration on October 6, 2011, and then on October 7, 2011 filed a Notice of Appeal. The application was remanded to the examining attorney and an action denying the request for reconsideration was issued on November 2, 2011, as no new issues or reasons were presented that were significant and compelling on that issue.

The applicant filed its brief on February 8, 2012 and the appeal was forwarded to the Examining Attorney for her brief on February 13, 2012.

OBJECTION TO APPLICANT'S UNTIMELY SUBMISSION

OF NEW EVIDENCE

As a preliminary matter, the examining attorney objects to the applicant's reference and reliance on evidence that has not been properly made of record. In its brief the applicant refers to Exhibits G and H identified as printouts from the registrant's website. The exhibits are not attached to the applicant's brief and the referenced website pages were not previously made of record. The record in an application must be complete prior to the filing of an appeal. Because the proposed evidence has not been properly made of record, this evidence should not be considered. 37 C.F.R. §2.142(d); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Trans Cont'l Records Inc.*, 62 USPQ2d 1541, 1541 n.2 (TTAB 2002); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ISSUE

The sole issue on appeal is whether the mark, when used in connection with the identified goods, so resembles the mark in Reg. No. 3243838 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

ARGUMENT

THE APPLICANT'S PROPOSED MARK IS NOT ENTITLED TO REGISTRATION BECAUSE IT SO RESEMBLES THE CITED REGISTERED MARK AS TO BE LIKELY TO CAUSE CONFUSION, MISTAKE OR DECEPTION.

Trademark Act Section 2(d) bars registration of an applied-for 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 of 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. *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.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 et seq.

A. SIMILARITY OF THE MARKS: THE RESPECTIVE MARKS ARE SIMILAR IN MEANING, CONNOTATION AND COMMERCIAL IMPRESSION.

The applicant's and registrant's marks share the wording "BUGGING ME" and the meaning of additional wording, STOP and QUIT is the same. Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); TMEP §1207.01(b)(ii)-(iii).

The dictionary definition made of record on December 18, 2010 defines "quit" as "to stop, cease, or discontinue: She quit what she was doing to help me paint the house." <http://dictionary.reference.com/browse/Quit?r=66> See pages 2-6 of 12/18/2010 Office action. In addition, the definition of "stop" made of record on April 7, 2011 shows that stop and quit are synonyms. See pages 7-10 of 4/7/2011 Office action.

The applicant's argument that "quit" in the registrant's mark does not mean the same thing as term "stop" in the applicant's mark, is not persuasive given that the common dictionary definition of the term "quit" means to stop. Stop and quit are synonyms and have the same or nearly the same meaning. The remaining portion of the marks is the same and overall the marks create the same commercial impression of stop bugging me. Consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); TMEP §1207.01(b).

It is a well known principle of a likelihood of confusion analysis that the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

In this case, the minor differences in the marks are not sufficient to distinguish the marks and applicant's and registrant's marks create the same overall commercial impression.

B. SIMILARITY OF THE GOODS: INSECTICIDES; PESTICIDES AND INSECT REPELLENTS ARE CLOSELY RELATED GOODS AND SOLD BY THE SAME SOURCE AND IN THE SAME CHANNELS OF TRADE.

Applicant's goods are related to registrant's goods because they are both insect control substances. While insecticides, pesticides, and insect repellents are not identical the evidence of record shows that they are often sold by the same source, under the same mark, and often sold through the same channels of trade.

The third party registration made of record on December 18, 2010, shows that insect repellent and insecticide and pesticides are the kind of goods that emanate from a single source. See attachments to the 12/18/2010 Office action, pp. 8-25. The evidence consists of the following registrations. Bold type is used here to show the overlap between registrant's goods and applicant's currently listed goods:

- 1) Registration No. 3297220, attachments pp., 8-11, for J.T. Chemical for goods in classes 5 and 11 including, preparations for destroying vermin; vermin repellents; **insecticides** for domestic and agricultural use; **insect repellents**.
- 2) Registration No. 3644931, attachments pp., 12-13 for Versapro for goods in class 5 including, **insect repellents, insecticides**.
- 3) Registration No. 3320206, attachments pp., 14-16 for STARPETT for Mosquito and **insect repellent** in the form of coil, mosquito and **insect repellent** in the form of incense, mosquito repellent in the form of lotion, mosquito repellent in the form of aerosol, **insecticides, pesticides, parasiticides, insect repellent** for use on dogs, fungicides, animal washes, namely, medical shampoos for animals, anti-horse-fly oils for use as a horsefly repellent, dog lotions, namely, medical lotions for use on dogs, and germicides.
- 4) Registration No. 3334589, attachments pp., 17-18 for BLOCK THE BITE for **insect repellents; anti-insect-sprays; insecticides**.
- 5) Registration No. 3326973, attachments pp., 19-20 for BIOUD for **insect repellents; anti-insect-sprays; insecticides**.

- 6) Registration No. 3503126, attachments pp., 21-22 for goods in classes 5 and 25 including, **insect repellents**; anti-insect-sprays; **insecticides**.
- 7) Registration No. 3788829, attachments pp., 23-25 for goods in classes 1, 5 and 31 including herbicides, **insecticides**, **pesticides** and fungicides for home, garden and lawn use and for professional use; animal repellents; bird repellents; granular repellent for burrowing pests; **insect repellent**.

In addition, the evidence from websites and online catalogs show that insecticides and insect repellants are often sold together in home and garden sections of stores. See attachments pp. 14-27 of the 4/7/2011 office action. The evidence consists of the following:

- 1) A printout from <http://www.epestsolutions.com/borid-boric-acid-powder-dust.html>; attachments pp. 11-13, showing that “**Borid Boric Acid Powder** is a natural insecticide - pesticide and insect repellent, that is effective with long lasting results against cockroaches, ants (excluding carpenter ants), silverfish and termites.”
- 2) Screen shots from the websites of Lowe’s, Home Depot and Target attachments pp. 14-27, showing that insect repellents and killers are sold together in home and garden sections and stores.

The applicant refers to and made of record portions of the prosecution file for the cited registration in an attempt to differentiate insecticides and pesticides from

insect repellents. The applicant argues that its goods are used to kill insects while the registrant's goods are used to deter insects to discourage them from landing on or otherwise coming in contact with human skin. 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 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).

In this case the goods are used in getting rid of insects. The evidence of record shows that goods similar to the applicant's and registrant's goods are sold by the same source and under the same trademark. The evidence also shows that insecticides, pesticides, and repellants are sold in the same sections of home improvement stores and would be encountered by the same consumer.

CONCLUSION

The applicant's mark, "STOP BUGGING ME!" when used in connection with insecticides; pesticides; pesticides for exterminating, namely, bed bugs and dust mites is likely to cause confusion with the registrant's mark "QUIT BUGGING ME" for insect repellents. For the foregoing reasons, it is respectfully submitted that the

refusal of registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

/Jennifer M. Martin/
Examining Attorney, L.O. 116
(571) 272-9193
Jennifer.Martin@uspto.gov (informal
queries only)

Michael W. Baird
Managing Attorney
Law Office 116