THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 30, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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United Industries Corporation

v.

OMS Investments, Inc.

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Opposition No. 91158240
to Application No. 76477706
filed December 23, 2002

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Oral Hearing: February 3, 2010

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Mark Sableman, Thompson Coburn LLP, for opposer.

Shari Mulrooney Wollman, Manatt, Phelps & Phillips, LLP, for applicant.

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Before Cataldo, Mermelstein, and Ritchie, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant OMS Investments, Inc. seeks registration of the mark ANT-STOP (in typed form) for "pesticides for domestic use," in International Class 5.[1]

Opposer United Industries Corporation, filed an opposition to registration, alleging that applicant's mark "comprises a mark which so resembles marks registered in the

[1] Based on the allegation of a *bona fide* intent to use the mark in commerce, pursuant to Trademark Act § 1(b); 15 U.S.C. § 1051(b).

United States Patent and Trademark Office by Opposer, as to be likely when applied to the goods of Applicant, to cause confusion, mistake or deception," pursuant to Trademark Act § 2(d); 15 U.S.C. § 1052(d). By its answer, applicant denied the salient allegations of the notice of opposition.[2]

We sustain the opposition.

I. Background and Issues

A. Background

Despite the very large record generated by this proceeding, we find little controversy as to the factual history of this dispute (as opposed to the interpretation of it). The parties are in the business of selling consumer household, lawn, and garden products, specifically as relevant to this case, chemicals used for the control of insects and other pests. Opp. Br. at 8-9; App. Br. at 13. On March 2, 1993, Registration No. 1756016 issued to applicant's predecessor in interest for the mark ANT-STOP (typed mark) as used on "pesticide for control and eradication of household and garden pets." On July 20, 1999, the USPTO accepted applicant's affidavit of continuing

[2] Applicant raised three "affirmative defenses" in its answer, Answer ¶¶ 8-10, none of which is actually an affirmative defense. All three are essentially denials of a likelihood of confusion, an issue for which the plaintiff bears the burden of proof. *See, e.g., H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1718, n.2 (TTAB 2008); *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). The assertion in ¶ 9 of applicant's answer is discussed more specifically below. *See* n.11, *infra*, and accompanying text.

use, pursuant to Trademark Act § 8, and acknowledged the filing of applicant's declaration of "incontestability," pursuant to Trademark Act § 15. Nonetheless, applicant did not timely file for renewal of its registration pursuant to Trademark Act § 9 (or file its 10-year Trademark Act § 8 affidavit), and on December 6, 2003, applicant's '016 Registration was deemed expired under § 9 and cancelled under § 8 (for the sake of brevity, we refer to it simply as "expired").

On December 23, 2002, prior to the cancellation of applicant's '016 Registration (but within the time permitted to file for renewal of that registration), applicant filed a new application for registration, Serial No. 76477706, the subject of this proceeding. The subject application is for the mark ANT-STOP, for use on "pesticides for domestic use," and is based on applicant's stated intent to use the mark in commerce, pursuant to Trademark Act § 1(b), 15 U.S.C. § 1051(b).

At the time applicant's now-expired '016 Registration was issued, opposer's predecessor in interest had already owned Registration No. 1196097 (WEED STOP) for nearly eleven years. That Registration issued in 1982, for the mark WEED STOP (typed mark), as used on "weed preventer." During the time applicant's ANT-STOP mark was registered, and after its expiration, opposer applied for and was granted several more

registrations, including those for BUG STOP (typed mark) for "insect repellent, insecticide and pesticide for domestic/household use," issued in 1999; MOLE STOP (and design) for "rodent repellents and rodenticides for domestic household lawn and garden use," issued in 2001; and GRUB STOP (typed mark) for "insecticide for application to household lawn and garden," issued in 2004.

There is little dispute as to the foregoing facts. On the other hand, the parties disagree sharply on the reason for applicant's failure to renew its '016 Registration and whether applicant has abandoned use of its ANT-STOP mark, as well as the consequences of the answers to those questions for this proceeding.

B. Issues

Opposer begins its reply brief with the following observation:

> It is clear from the parties' respective Briefs that the crux of the present opposition lies in whether OMS has made continuous *bona fide* use of the ANT STOP trademark for over 15 years (as OMS contends) or whether OMS *abandoned* the ANT STOP mark (as United contends). Put simply, if OMS has had continuous viable trademark use of ANT STOP from 1992 to the present, United will lose this opposition. Conversely, if OMS abandoned its prior ANT STOP rights during the period when it "discontinued" its ANT STOP products, then neither its prior registration nor its prior common law rights will bar this opposition, which will then be decided on the issue of whether OMS's proposed ANT STOP mark

> conflicts with United's STOP family of marks.

Reply Br. at 5.

On the contrary, it is apparent to us that both parties misapprehend many of the legal principles involved in this proceeding. This resulted in the unfortunate complication of this case, and the submission of a great deal of unnecessary (and irrelevant) evidence. We begin by discussing the issues at hand.

This is an opposition against an intent-to-use application, in which opposer alleges a likelihood of confusion under Trademark Act § 2(d). Not. of Opp. ¶ 5. Opposer has pleaded and proved its ownership of four valid trademark registrations. There are no counterclaims challenging the validity of opposer's registrations.[3]

Pursuant to long-standing precedent, an opposer asserting a Principal registration against an application need not prove priority of use. *E.g.*, *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974) ("Section 2(d) says an applicant can register, *unless* his mark is likely to cause confusion with a mark [1] '*registered* in the Patent [and Trademark] Office *or* ... [2] previously used...'" (numbering and emphasis

[3] Applicant attempted to amend its answer to assert counterclaims to cancel three of opposer's four pleaded registrations, but its motion was denied as untimely. Order at 7 (Mar. 26, 2008).

added)). Here, because opposer is asserting marks which are "registered in the Patent and Trademark Office," Trademark Act § 2(d), it need not prove the disjunctive condition, *i.e.*, that its registered marks were "previously used" (emphasis added).

This is true regardless of whether the opposed application is based on use or an intention to use, or even whether applicant can prove that it in fact began use of the applied-for mark prior to the opposer. In an opposition, the only way that an applicant can raise the issue of the priority of an opposer's registration is by seeking to cancel it. Trademark Rule 2.106(b)(2)(ii); *see e.g.*, *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998). As there are no pending counterclaims or petitions for cancellation of opposer's marks, priority is simply not an issue, notwithstanding any evidence of applicant's use of its mark prior to opposer's use or registration. The parties' extensive evidence and argument regarding priority and applicant's alleged abandonment are therefore largely irrelevant. For this purpose, it makes little difference whether defendant, as an intent-to-use applicant, has continuously used its mark for many years without

interruption or whether it has not yet made use of it at all.[4]

While applicant recognizes this principle, it suggests that the rule is rooted in policy considerations which are inapplicable here, and that we may thus ignore it in this case. App. Br. at 33, n.10. On the contrary, *King Candy* is a construction of the controlling statute by the predecessor to our primary reviewing court. Even if we were inclined to agree in principle with applicant's "policy" arguments, we must still follow binding precedent. *Khan v. State Oil Co.*, 93 F.3d 1358 (7th Cir. 1996).

We also note that the parties spent a great deal of effort arguing the significance of applicant's prior registration and the reason for its demise. Although applicant previously owned a registration[5] for the same mark, that registration – for whatever reason – was not

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[4] Priority of use might matter with respect to opposer's "family of marks" argument, by which opposer essentially alleges confusion with its unregistered family "surname" mark (even though in this case the members of the asserted family are registrations). In order to prevail, the proponent of a "family of marks" argument must prove that its family was established prior to the defendant's first use of the applied-for mark. But as discussed below, we need not reach the question of family priority in this case.

[5] Applicant emphasizes that its now-cancelled prior registration was "incontestable," urging that the present case is not about "a routine ITU application." App. Br. at 11, 14. Incontestability, which is the subject of Trademark Act § 15, 15 U.S.C. § 1065, refers to when and on what grounds the right to use a registered mark may be challenged. *See In re Best Software Inc.*, 63 USPQ2d 1109, 1112 (TTAB 2002). But Section 15 is inapplicable in a case before the Board because we decide only the right to register (as opposed to the right to use) a mark.

maintained, and has expired. It is well-established that an expired or cancelled registration is evidence of nothing but the fact that it once issued. *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987). In particular, such a registration is not entitled to the presumptions under Trademark Act § 7(b), that the registration was valid, that registrant was its proper owner, or that registrant had the exclusive right to use the previously-registered mark. *See Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973).

Although Trademark Act § 14, 15 U.S.C. § 1064, might have barred an attempt to cancel applicant's previous, expired registration, it cannot be raised as a defense in an opposition to a new application, as Section 14 applies only to "[a] petition to cancel a registration of a mark."[6] Trademark Act § 14 (emphasis added). The failure of applicant to renew its previous registration might have been an unfortunate error. But the filing of a new application

[6] To the extent applicant is arguing that the subject mark must be considered strong because its prior registration of it was once incontestable, the Board has rejected the theory that incontestability *per se* has any effect on an analysis of registrability. *Safer Inc. v. OMS Invs. Inc.*, 94 USPQ2d 1031, 1035-36 (TTAB 2010) ("[T]he fact that opposer's federally-registered trademark has achieved incontestable status means that it is conclusively considered to be valid, but it does not dictate that the mark is 'strong' for purposes of determining likelihood of confusion."). To that extent, Trademark Act §§ 14 and 15 are similar in this respect – they provide procedural bars to challenges (to registration and use, respectively) on certain grounds, but do not change the substantive analysis of otherwise permissible claims.

does not restore applicant to the *status quo ante*. Having allowed its original registration to expire, applicant is now in much the same position it would have been had the prior registration never issued, and it makes no difference at all whether its failure to renew the registration was intentional due to applicant's abandonment (as opposer claims) or the result of mistake or negligence (as applicant claims).[7]

For similar reasons, applicant's *Morehouse* defense, *see Morehouse Mfg. Corp. v. J. Strickland & Co.*, 150 USPQ 688 (TTAB 1966), asserted for the first time in its brief, also fails.[8] When the applicant's prior registration is no longer valid, *Morehouse* does not apply:

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[7] While it does not affect the outcome, we cannot agree with opposer's suggestion, Opp. Br. at 7-8, 13, 15, that applicant's failure to maintain its registration is evidence that applicant ceased using its mark in commerce. Federal registration is not required to acquire or maintain a trademark, and the failure to maintain a registration does not imply abandonment of use or the rights with flow from such use.

Likewise, opposer argues that applicant's current application, which was filed under the "intent-to-use" provisions of Trademark Act § 1(b), 15 U.S.C. § 1051(b), is evidence that applicant is not now (or was not at the time of filing) using its mark in commerce. Opp. Br. at 7, 17, 20-21. Again, we disagree; the declaration of an intent to use is not inconsistent with actual use. *Cf. Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007) (ITU applicant may rely on its use prior to application for purposes of priority, *citing Corporate Document Svcs. Inc. v. I.C.E.D. Mgmt. Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998)). The filing of an intent-to-use application is in no way an admission of non-use.

[8] In any event, we sustain opposer's objection, Reply Br. at 18, on the ground that *Morehouse*, which is an affirmative defense, was not pleaded, and as such, cannot be considered. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (*citing Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.,* 402 U.S. 313,

> The proposition for which the *Morehouse* case stands is that, as a matter of law, an opposer cannot be damaged, within the meaning of Section 13 of the Trademark Act, by the issuance to an applicant of a second registration when applicant already has an *existing*, unchallenged registration of the same mark for the same goods. *See O-M Bread, Inc. v. U.S. Olympic Comm'n*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995); and TBMP § 311.02(b) (2d ed. rev. 2004). The prior registration or *Morehouse* defense is an equitable defense, "to the effect that if the opposer can not be further injured because there *already exists* an injurious registration, the opposer can not object to an additional registration that does not add to the injury." *O-M Bread*, 36 USPQ2d at 1045 (emphasis added). Because the injury contemplated under the *Morehouse* doctrine is injury not from a party's prior use of a mark but rather from the party's ownership of a registration for the mark, it necessarily follows that *the registration must be in existence* in order to form the basis for the claim of damage, and that an expired registration may not form the basis of a valid *Morehouse* defense. *Cf. Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("It is well established that, pursuant to section 22 of the Lanham Act, a registration provides constructive notice for all use during the existence of the registration. However, a canceled registration does not provide constructive notice of anything.")(internal citations omitted).

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169 USPQ 513, 527-28 (1971)); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP), §§ 311.02, 314 (2d ed. rev. 2004)).

Land O' Lakes v. Hugunin, 88 USPQ2d 1957, 1958-59 (TTAB 2008) (emphasis added).[9]

Likewise, we do not find that laches is an issue in this case, because it was not pleaded. Trademark Rule 2.106(b)(1); *United States Olympic Comm. v. Bata Shoe Co., Inc.*, 225 USPQ 340, 341 (TTAB 1984). In its brief, App. Br. at 27, n.7, and at oral argument, applicant pointed to the following "defense" in its answer as support for a laches defense:

> There is no likelihood of confusion as evidenced by the fact that there was no actual confusion between any of Opposer's cited marks and Applicant's prior registration for the mark "ANT-STOP," Reg. No. 1,756,016, issued March 2, 1993 during the period of that mark's use.

Answer ¶ 9.

To prevail on a laches defense,[10] a defendant must plead and prove two elements: (1) that the plaintiff

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[9] Strangely, applicant cites *Land O' Lakes* in its brief for precisely the opposite premise. App. Br. at 26 ("Where defendant failed to object to a prior registration which, despite continued use, expired due to applicant's error, the Board has consistently excused the error and determined that the *Morehouse* defense nonetheless applies, so long as there is continuous use." (emphasis added)). As is perfectly clear from the quotation above, *Land O'Lakes* says no such thing. Nor do the other cases applicant cites in support of this proposition; they concern laches, not the *Morehouse* defense, which is clearly a different legal doctrine.

[10] Unlike the *Morehouse* defense, laches might have been properly pleaded under the circumstances of this case. Laches is not usually available as a defense in an opposition, because the delay is measured from the date the mark is published for opposition, not the date the opposer learned of applicant's use. *See Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*,

unreasonably delayed in asserting its rights and (2) that such delay resulted in material prejudice to the defendant. *Lincoln Logs Ltd. v. Lincoln Pre-cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992).

In this case, applicant's answer was not sufficient to put opposer on notice that laches was asserted because applicant did not allege facts supporting either element of the defense, nor did it even mention the elements or the term "laches."[11] Rather, Paragraph 9 appears to us to merely put forward the often-asserted (and almost as often unsuccessful) argument that the absence of evidence of actual confusion is evidence that there is no likelihood of confusion.[12] *See Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989).

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19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Given the brief period allowed for filing an opposition, *see* Trademark Rule 2.101(c), laches would be all but impossible to prove. But "under certain circumstances, a laches defense in an opposition proceeding may be based upon opposer's failure to object to an applicant's earlier registration of substantially the same mark for substantially the same goods." *Aquion Partners L.P. v. Envirogard Prod. Ltd.*, 43 USPQ2d 1371, 1373 (TTAB 1997).

[11] We do not mean to imply that a proper pleading must use the name of the asserted legal doctrine. Nonetheless, doing so might have helped to remove any doubt as to the nature of the defense, if applicant's intent was indeed to assert laches.

[12] As noted above, *see supra* n.2, unlike laches, this argument is not an affirmative defense at all. "The nature and extent of any actual confusion" is one of the factors to be considered in deciding whether confusion is likely. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (factor #7). Thus, although applicant may submit evidence or argument on the issue, the extent of actual confusion (if any) is part of opposer's case, rather than an affirmative defense for which applicant bears the burden of proof.

But laches isn't about confusion (actual or likely), or the lack of it; laches is about the plaintiff's unjustified delay and the resulting prejudice to the defendant.

Applicant urges that pleadings are to be construed liberally under the Federal Rules. App. Br. at 27. But even construed liberally, there is simply nothing in applicant's answer which can be fairly construed as raising the issue of laches. We agree with opposer, Opp. Br. at 18, 20, that applicant's answer was plainly insufficient to put opposer on notice that applicant was asserting laches,[13] and we will accordingly not further consider the defense.

To summarize, we have before us a relatively straightforward case under Trademark Act § 2(d). In opposition to registration of the subject application,

[13] Even if laches had been properly pleaded, it was not proved. Applicant does not even discuss the "material prejudice" prong of the test, barely mentioning it in passing, App. Br. at 27, 28, despite the fact that it bears the burden of proof on an affirmative defense. The "material prejudice" element of the laches defense requires more than that the defendant would have to contest a proceeding on the merits which would otherwise be barred. Where laches is successfully asserted, the defendant typically shows that it continued to invest substantial resources in the mark and built goodwill associated with the mark during the plaintiff's delay, such that it would be inequitable to allow a dilatory suit to proceed. Applicant made no such showing here. *See Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1766 (TTAB 2007) ("respondent has not demonstrated that any economic prejudice resulted from petitioner's delay"). As far as we can tell, the record does not reflect any such prejudice to applicant resulting from opposer's delay. Indeed, in connection with its misbegotten theory of abandonment, opposer cites considerable evidence that applicant's investment in and sales under the mark were less than robust for a considerable period prior to commencement of this proceeding. Opp. Br. at 41-49.

opposer has asserted that registration of applicant's mark would give rise to a likelihood of confusion with several marks, which it has registered and used. Not. of Opp. at 1-2. For the most part, we find little or no relevance in the parties' arguments and evidence regarding applicant's prior registration, whether applicant had abandoned its use of the mark at some point prior to the current application, priority, laches, or the *Morehouse* defense. We have considered and weighed the evidence on these issues accordingly.

II. Record

A. Evidence

The parties stipulated that any discovery depositions may be introduced by either party as testimonial evidence, Consent Mot. (Nov. 13, 2007), and that all documents produced in this matter are authentic and may be relied upon by either party, Consent Mot. (Nov. 16, 2007). *See* Order (Nov. 30, 2007) (approving stipulations).

Pursuant to Trademark Rule 2.122(b), the record in this case includes the pleadings and the file of the subject application. In addition, the parties have submitted the following:[14]

[14] In several instances, the parties submitted notices of reliance on the same evidence. This was not necessary. Once evidence is properly submitted by one party, it may be used by the other for any purpose. In addition, although they were submitted under notices of reliance, we have listed the parties' testimony (and

- Testimony of Jim Guard, opposer's Senior Marketing Director for Spectrum Industries:
    - December 14, 2007,
    - May 2, 2007,
    - January 22, 2008;
- Testimony of Tiffany Peoples, Director of Marketing for Grass Seed for Ortho:
    - June 14, 2007,
    - January 16, 2008;
- Testimony of Scott Hanley, Marketing Director, Scott's Miracle-Gro, October 31, 2007;
- Testimony of Richard Foster, Vice President of Marketing for Scott's Ortho division[15]:
    - January 23, 2008,
    - September 26, 2008;
- Testimony of Christine Brown, a litigation paralegal for applicant's law firm, January 24, 2008;
- Testimony of Ed Billmaier, Senior Director of Relationship and Interactive Marketing, for Scotts Miracle-Gro:
    - July 10, 2008,
    - September 23, 2008;

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discovery depositions treated as testimony) separately. It is not necessary to submit testimony under a notice of reliance, although doing so is harmless error. *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009).

[15] Opposer originally noted its intention to rely on Mr. Foster's deposition from another proceeding (Opp. No. 91162042, June 13, 2007 deposition), Opp. Supp. Not. of Reliance at 3, and filed a motion for leave to do so. Although the Board granted opposer's motion (subject to certain requirements), the requirements were not met, and opposer ultimately withdrew its reliance on this deposition. *See* Opp. Second Supp. Not. of Reliance at 5. We have given this evidence no consideration.

- Opposer's Notices of Reliance:
    - November 30, 2007. In addition to other materials, opposer submitted the following registrations:

Reg. No.	Mark	Goods	Reg. Date	Disclaimer
1196097	WEED STOP	Weed preventer	May 5, 1980	WEED
2270338	BUG STOP	Insect repellent, insecticide and pesticide for domestic/household use	Aug. 17, 1999	BUG
2432006		Rodent repellents and rodenticides for domestic household lawn and garden use	Feb. 27, 2001	MOLE
2841439	GRUB STOP	Insecticide for application to household lawn and garden	May 11, 2004	GRUB
2936701	MOSQUITO STOP	Insecticides for domestic use	Mar. 29, 2005	MOSQUITO

    - March 7, 2008,
    - October 16, 2008;
- Applicant's Notices of Reliance:
    - January 29, 2008,
    - October 16, 2008.

B. Evidentiary Objections

Both parties filed extensive objections to the testimony[16] and evidence submitted by the other (including

[16] Many objections are waived if not asserted when the evidence is proffered. *See generally*, TBMP § 707.03(a). Yet, the parties seem to have taken this principle to extremes in this case. Much of the testimony is marked by objections to virtually every question and answer. Counsel would do well to remember that our proceedings are not tried before lay juries which might be easily confused or prejudiced. And while the Federal Rules of Evidence do apply, so does common sense. "Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them...." Trademark Rule 2.123(j). Many of counsels' objections appear to fall into this category, as the parties appear to concede; with few exceptions, objections to testimony were not maintained in the parties' evidentiary objections at final briefing, and are therefore waived, rendering the original objection pointless.

objections to the objections[17]). Opp. Stmt. of Evid. Objections (Feb. 2, 2009); App. Stmt. of Evid. Objections (Mar. 9, 2009). Applicant responded to opposer's objections, App. Resp. to Opp. Stmt. of Objections (Mar. 9, 2009), but opposer did not respond to applicant's. We note that the Board previously denied opposer's motion to strike documents which were allegedly not produced during discovery. Order at 9-11 (Mar. 26, 2008).

We begin by referring to our earlier discussion of the issues in this case. As previously noted, a good deal of the evidence proffered by both parties is of little or no relevance. Thus, we will not belabor any of the objections to such evidence (which includes all of opposer's

[17] Applicant argues that opposer's objections are not in compliance with 37 C.F.R. § 11.50(e), and that they are in violation of the Board's prohibition against filing further motions in this case without prior leave. App. Stmt. of Objections at 7. Applicant is wrong on both counts. The rule cited by applicant applies specifically to the conduct of investigations and disciplinary proceedings involving those engaged in practice before the USPTO. *See* 37 C.F.R. § 11.19, *et seq.* Such proceedings are conducted by the USPTO's Office of Enrollment and Discipline and have nothing to do with the conduct of Board *inter partes* proceedings.

Moreover, we do not consider opposer's statement of objections to be a "motion" filed without prior leave. *See* Order at 7 (Apr. 25, 2008). To avoid waiver, objections must be raised either in a party's brief, or in a separate statement (which does not count toward the page limit of the brief). *Hard Rock Café Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000). The separate statements of objections filed by both parties here were not motions, but part of the briefing of the case (although not part of the briefs themselves), and were thus not subject to the Board's order.

objections).[18] We briefly consider the remaining objections:

- Applicant objects to consideration of opposer's registration of MOSQUITO STOP, because (1) the mark was not pleaded as a basis for opposition; (2) the mark is allegedly abandoned; and (3) the evidence is misleading, prejudicial, and confusing. App. Stmt. of Evid. Objections at 2 (unnumbered). Despite opposer's statement that it ceased using this mark in 2005, Opp. Br. at 11, we do not consider this registration to be abandoned; absent a counterclaim, applicant cannot attack the validity of opposer's registration. Trademark Rule 2.106(b)(2)(ii). Moreover, we are not misled, prejudiced, or confused by it.

Nonetheless, we agree that the MOSQUITO STOP registration was not pleaded as a bar to registration under Trademark Act § 2(d), *see* Notice of Opp. ¶ 2 (Oct. 10, 2003), and we accordingly give it no consideration for that purpose. *See Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1746 (TTAB 1987); *United States Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815, 817 (TTAB 1986); *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263, 266

[18] Opposer's objections are directed entirely to evidence produced in support of applicant's "'administrative error' defense," Opp. Stmt. of Evid. Objections (Feb. 2, 2009), which was itself asserted in response to opposer's charge that applicant abandoned its mark. But as explained above, abandonment is not a significant issue in this case, and the reason for applicant's failure to renew its '016 Registration is irrelevant.

(TTAB 1982).

- Applicant objects to Opposer's 2003 Spectracide Brands Awareness & Usage Tracking Study Final Report Draft, and the testimony of Jim Guard, which introduces and discusses the study, as "misleading" on the grounds that the survey question "is not a legally sufficient basis for establishing consumer recognition or strength of the marks."[19] App. Stmt. of Evid. Objections at 3 (unnumbered), *citing Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492 (TTAB 2005), *aff'd* 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007). But applicant's citation of *Carefirst* is itself somewhat misleading, because the Board did not say in that case that aided awareness studies are "not ... legally sufficient." What the Board said was that

[19] We note that the Brand Awareness Study was introduced by Jim Guard's testimony, although it was clear that Mr. Guard did not conduct, design or direct the survey, nor was he able to answer questions about it. Indeed, Mr. Guard testified that he had never seen the study before his testimony. Guard Dep. at 42 (May 2, 2007).

Arguably, opposer's study is either hearsay or a proper foundation was not laid for its admission. *Piper Aircraft Corp. v. Wag-Aero, Inc.*, 741 F.2d 925, 223 USPQ 202, 206 (7th Cir. 1984) ("We agree with the suggestion in McCarthy's treatise that the testimony of a survey director alone can establish the foundation for the admission of survey results."); *see McDonough Power Equip., Inc. v. Weed Eater, Inc.*, 208 USPQ 676, 684 (TTAB 1981) (survey held admissible where it was offered (with all supporting data) through the testimony of the expert who conducted it). Nonetheless, applicant did not object to the study on this ground, and we consider the objection waived. *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597, 1600 (TTAB 1990).

> [t]he brand awareness studies give little assistance to opposer's claim of fame. We agree with applicant that, in analyzing these studies in the context of the legal factor of fame, it is unaided awareness that is most significant. If a mark were "famous," as contemplated under the law, among the class of relevant customers and potential customers, it would, in all likelihood, garner much higher numbers on unaided brand awareness than did opposer's mark.... One should not be permitted to so heavily rely on aided awareness, that is, awareness after the brand has been prompted, to show fame (e.g., "Have you ever heard of CAREFIRST?"). *See generally*, J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 32:173 (4th ed. 2004).

Carefirst, 7 USPQ2d at 1507 (emphasis added). The Board did not find Carefirst's aided brand-awareness study to be legally flawed or misleading, and the study was apparently admitted and considered (along with other evidence), although because of its design, it was not considered to be very significant. We accordingly deny applicant's objection as to admissibility, but as was the case in *Carefirst*, we give this evidence very little weight. *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1717 (TTAB 1999)(flaws in survey go to its probative value, not its admissibility), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003)(subsequent history omitted).

- Applicant objects to "[d]eposition testimony discussing purported advertising of Opposer's insecticide,

herbicide and rodenticide products" on the ground that opposer did not show, *inter alia*, that the advertising was actually made, how much was spent on the marks at issue, where the advertising was run, and in what media.

In Mr. Guard's testimony, *e.g.* Guard Depo. 82-88 (Dec. 14, 2007), and in opposer's brief, Opp. Br. at 13-14, opposer points to an agreement with one of the large retailers which carry opposer's goods. Under the agreement, the retailer is provided an allowance which it is supposed to spend on advertising opposer's products. Based on this, Mr. Guard estimated in his testimony the amount allegedly spent by the retailer on advertising opposer's goods. But as applicant notes, opposer has no proof that this retail distributor (or any other) actually spent the required amount, Guard Depo. at 87-88 (Dec. 14, 2007); Peoples Depo. at 69 (Jan. 16, 2008) (stating that opposer does not track such advertising). No advertisements which were actually circulated by the retailer were submitted, and even if we accept opposer's estimate of what the retailer *should* have spent on advertising as the amount actually spent, the figure would apparently be an aggregate amount spent on advertising all of opposer's products, not necessarily just the ones sold under the brands at issue here. We agree with applicant that this testimony is highly speculative and lacking in foundation.

- Similarly, applicant objects to "[a]ll mention of, reference to or reliance upon the contract with the retailer which purportedly required it to advertise *all* of the United products it carried ... to establish advertising amounts for its marks relied on for this opposition." App. Stmt. of Evid. Objections at 5 (unnumbered). Again, we do not view the contract as establishing that the retailer actually spent the required amount on advertising or what percentage of any amount that was spent, was spent in advertising opposer's asserted trademarks.

But even if we assume that some unknown amount was spent by the retailer under the contract (and that a portion of that sum was spent in advertising opposer's pleaded marks), we have no evidence by which to determine the effectiveness of the advertising – *i.e.*, whether it was likely to have resulted in stronger consumer recognition of opposer's marks (or family of marks). Such evidence would include the advertisements themselves, the geographic scope of the advertisements, the media used, and the circulation data. We will not strike the contract itself (or mention of it), but it clearly does not demonstrate that any particular amount was actually spent in the advertising of opposer's marks or that such sums were effective in creating strong awareness of opposer's marks in the minds of its consumers. It thus has little or no value in proving the fame of

opposer's marks or establishing its "family of marks."

- Applicant objects to opposer's use of a "purported agreement with a vendor to prepare marketing materials," *see* Opp. Not. of Rel. at 5 (Nov. 30, 2007); Opp. Br. at 14, "for which it claims to have expended" a significant sum.[20] App. Stmt. of Evid. Objections at 6 (unnumbered). We essentially agree with applicant – there is no record evidence that these marketing materials were finally completed according to the agreement, what the marketing materials ultimately comprised (*i.e.*, what mark or marks were included in the advertising), whether they were ever publicly distributed, or to whom. As such, this evidence has virtually no relevance. It shows only a first step or attempt to engage in this type of advertising, with no indication of any results thereof.

- Lastly, applicant objects to opposer's reliance on the testimony of Jim Guard as to other advertising materials and strategies. App. Stmt. of Evid. Objections at 7 (unnumbered); see Guard Depo. at 120 (May 2, 2007); Opp. Br.

[20] We refer to this evidence in the most general terms because it, and a large amount of other evidence in this case, was submitted under seal. We are puzzled as to how the existence and contents of advertising materials which opposer uses to support its "advertising and promotion of its STOP family of marks," Opp. Br. at 13, could be considered confidential. For most purposes (including those opposer advances here), advertising materials are only relevant if, and to the extent that, they are publicly circulated.

at 14.[21] Applicant's objection is overruled as to the admissibility of this testimony, but we note that the very brief mention of this promotional activity (without testimony or other evidence of its contents and circulation) is of very little value.

II. Discussion

A. Standing

Applicant argues at length that opposer cannot prove that it has a reasonable belief in damage from the possible issuance of the subject application, essentially contending that opposer does not have superior rights, and thus cannot be "damaged." App. Br. at 51-54. Applicant's arguments rest primarily on a conflation of the requirement for standing and the grounds for opposition.

Standing is a relatively low threshold requirement, and it is generally sufficient to show that the plaintiff in a Board proceeding is not a "mere intermeddler." *E.g., Herbko Int'l Inc. v. Kappa Books Inc.*, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). It would be illogical to construe standing to require a Board plaintiff to show that it would win on the merits before we find that it has sufficient interest in the proceeding to contest the case on the merits. On the contrary,

[21] Again, this testimony and the discussion of it in opposer's brief were submitted under seal, although we cannot see any possible justification for having done so in this instance.

> [s]tanding requires only that the petitioner have a "real interest" in the cancellation proceeding. *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1092, 220 USPQ 1017, 1020 (Fed. Cir. 1984). In most settings, a direct commercial interest satisfies the "real interest" test. *Cunningham*[*v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000)].

Herbko Int'l, 64 USPQ2d at 1377 (emphasis added).

Opposer here has pleaded and proved its registration and use of several trademarks, and opposer alleges that registration of applicant's mark would cause a likelihood of confusion with its registrations. Regardless of the outcome of opposer's claims on the merits, opposer clearly has a real or direct commercial interest in this matter, and that is sufficient to establish standing.[22] *See Cunningham*, 55 USPQ2d at 1844; *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

[22] Applicant also argues that opposer cannot establish "damage" because "[a] refusal by the U.S. Patent and Trademark Office to register a mark does not preclude the owner of the mark from his right to use it." App. Br. at 53-54. Applicant is correct that this proceeding is about its right to *register* a mark, not its right to *use* it. But if applicant is correct in grafting this principle onto the requirement for standing, it would not be possible to establish standing in any Board proceeding in which the defendant is using its mark, because we could never enjoin such use. On the contrary, whether an applicant could or would continue to use its mark notwithstanding a Board judgment that it is not entitled to registration has nothing to do with whether an interested party has standing to oppose the mark in the first place. The "damage" at issue in an opposition is that arising from the prospective registration, not use, of the mark. *See Nat'l Cable Television Ass'n*, 19 USPQ2d at 1432 (Fed. Cir. 1991) ("In an opposition or cancellation proceeding the objection is to the rights which flow from registration of the mark." (citations omitted)).

B. Priority

As discussed above, because opposer's pleaded registrations are of record, priority is not an issue with respect to the goods set out therein. *King Candy Co.*, 182 USPQ at 110.

C. Likelihood of Confusion

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See du Pont*, 177 USPQ 563; *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

1. Opposer's Family of Marks Argument

We first consider what marks are at issue. In its notice of opposition, opposer set out a claim that

registration of the subject application would give rise to a likelihood of confusion with four of opposer's registered marks (for WEED STOP, BUG STOP, MOLE STOP and design, and GRUB STOP). Notice of Opp. ¶ 2. During trial, opposer submitted evidence of its ownership of these pleaded registrations, as well as its registration for an additional mark (for MOSQUITO STOP), although we have sustained applicant's objection to consideration of the unpleaded registration. Opposer's pleaded registrations[23] which have been made of record are as follows:

Reg. No.	Mark	Goods	Filing Date/ Reg. Date	Disclaimer
1196097	WEED STOP	Weed preventer	May 5, 1980 May 5, 1982	WEED
2270338	BUG STOP	Insect repellent, insecticide and pesticide for domestic/household use	Nov. 24, 1997 Aug. 17, 1999	BUG
2432006		Rodent repellents and rodenticides for domestic household lawn and garden use	Apr. 21, 1998 Feb. 27, 2001	MOLE
2841439	GRUB STOP	Insecticide for application to household lawn and garden	Jan. 29, 2001 May 11, 2004	GRUB

Although not pleaded,[24] opposer asserted in its briefs that an issue for decision in this case is "[w]hether [a]pplicant['s] ... registration of its ANT STOP mark ...

[23] In the case of each listed registration, opposer has made appropriate filings under Trademark Act §§ 8 and 9, and has filed an affidavit under Trademark Act § 15.

[24] In order to be considered, a claim of a likelihood of confusion with a "family" of marks must usually be pleaded as a ground for opposition. *Sunnen Prods. Co.*, 1 USPQ2d at 1746-47, n. 12 (TTAB 1987). Nonetheless, any potential objection to an unpleaded family of marks claim is waived where – as here – applicant fails to raise such an objection, and in fact, argues the merits of the issue in its brief. *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1719, n. 37 (TTAB 2007). Because applicant waived its objection, we consider the merits of opposer's unpleaded "family" claim.

would create a likelihood of confusion with [o]pposer's family of STOP marks." Opp. Br. at 8.

"A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner." *J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). Because opposer's family mark is not itself the subject of a registration, opposer bears the burden of proving that it owns the mark, *i.e.*, that the relevant segment of the public views the common characteristic of the family – *i.e.*, the family "surname" shared by the "members" of the family – as a source indicator. "Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods." *Id; Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1337-38 (TTAB 2006) (*citing Am. Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978)).

Upon consideration of the record evidence, we find that opposer has not established ownership of a family of STOP marks. Opposer has not presented evidence that it has advertised and promoted its four pleaded stop registrations

"in such a manner as to create public recognition coupled with an association of common origin predicated on the 'family' feature," *see Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983), or that such public perception has in fact resulted.

In its reply brief, opposer summarizes its evidence and argument regarding the establishment of its family of marks: (1) Opposer owns four[25] "STOP registrations" and offers a number of products under those brands; (2) national sales of opposer's STOP branded products have been substantial; (3) opposer's "STOP branded products are sold in the same 20 foot lawn and garden aisle of each retailer, and ... [opposer's] STOP family of marks are the only STOP branded products found in the lawn and garden aisle of large national retailers..."; (4) and opposer's STOP marks share a common construction.[26] Reply Br. at 21-22.

But mere ownership of a group of similar marks is not enough to establish the existence of a family of marks. Opposer must point to evidence demonstrating that "the purchasing public recognizes 'that the common characteristic

[25] Opposer actually stated that it owns five such marks, including its MOSQUITO STOP mark, although as discussed above, we have granted applicant's objection to consideration of that registration.

[26] "[E]ach [of opposer's] STOP brand[s] is consistently made up of two words where the first descriptively identifies the target of the control product and the second suggests that the product will put an end to the consumer's issues with the target." Reply Br. at 21-22.

is indicative of a common origin of the goods.'" *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001) (*quoting J&J Snack Foods*, 18 USPQ2d at 1891) (emphasis added). Opposer argues that its evidence is sufficient, citing *J&J Snack Foods v. McDonald's Corp.* for "finding existence of a family where Opposer had extensive usage and promotion of various marks using a common formative." But opposer is not McDonald's, which in the cited case

> showed extensive usage and promotion of various marks using the "Mc' formative, in association with the McDONALD'S mark, in advertising and at McDonald's restaurants. McDonald's showed that in 1987 it operated 7,600 outlets in the United States with sales of over $14 billion; [and] that it engaged in extensive nationwide advertising, spending $405 million in 1987....

J&J Snack Foods, 18 USPQ2d at 1892.

In this case, opposer has considerably less in sales than did McDonald's, and we have comparatively little evidence of the amount and kind of advertising that has been done in promotion of its family members. The nature of any advertisement of the family members is particularly important because it may well reveal whether the marks were promoted as a family, *i.e.*, in such a way that we can infer public recognition of the family, or whether they were

simply promoted as individual marks which happen to share a common characteristic.[27]

Opposer is correct that it is not required to take a survey in order to prevail on this issue. Reply Br. at 22. But it does bear the burden of establishing that the relevant purchasers recognize opposer's family of marks. While direct evidence of consumer perception (such as a well-conducted survey) may be particularly relevant, consumer perception can be inferred when appropriate. But an inference must rest on evidence, not conjecture. As discussed earlier, it is speculative to assume that opposer's retailers spent what they were supposed to have done in advertising opposer's marks; it is even more so to assume that any sums so expended were spent in promoting

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[27] Attention to the nature and extent of any advertisement involving the marks may be particularly important where – as here – the putative family surname appears somewhat suggestive of the goods, because a family feature must be distinctive:

> [I]f the asserted family feature is descriptive or highly laudatory or commonly used in the trade it cannot serve as the basis for a family of marks, at least in the absence of a showing of distinctiveness. However, this is not to say that a suggestive portion or term cannot function as a family feature. Such a determination would depend on whether the common feature would be recognized by the relevant public, so that the public would ascribe a common origin to marks containing the common feature, and this determination would depend on the particular fact situation.

Marion Labs. Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215, 1219 (TTAB 1988).

opposer's marks as a family, and that the advertising was effective in doing so.

We conclude that on this record, opposer has not met its burden to demonstrate that it is the proprietor of a "family" of -STOP formative marks. We therefore consider opposer's marks individually. However, for our analysis of the likelihood of confusion, we have chosen to focus on the most relevant registration pleaded by opposer, Registration No. 2270338, for BUG STOP, since it covers the most relevant mark and the most relevant goods. If we find a likelihood of confusion with applicant's goods and services vis-à-vis this mark, then the analysis will be moot as to opposer's other pleaded marks. Likewise, if we do not, then we would not find it for the others.

2. The Fame of the Prior Mark - Sales, Advertising, Length of Use

We begin our likelihood of confusion analysis with the fifth *du Pont* factor, which requires us to consider evidence of the fame of opposer's marks. Fame, when established, is entitled to great weight in a likelihood of confusion analysis. *See Bose Corp. v. QSC Audio Prod. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

> Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the DuPont factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark … casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

Bose Corp., 63 USPQ2d at 1305.

Although opposer does not use the word "fame" in its briefs, it has proffered evidence relevant to the fifth *duPont* factor, and argues that its marks are "strong."[28] *E.g.*, Opp. Br. at 29, 39-40; Reply Br. at 21. (Although opposer's arguments concern mainly the strength of its family of marks, we consider whether this evidence supports

[28] Applicant posits that "Ortho [under which Applicant's ANT-STOP mark was and is marketed] is a much stronger brand, which [sic] much higher consumer recognition than Opposer's Spectracide brand [under which products bearing the United marks were marketed]." App. Br. at 19. Applicant's point is not clear. It may be possible that a house mark (like applicant's ORTHO brand and opposer's SPECTRACIDE brand), which is itself very well-known, may pull a lesser-known product mark (like the parties' involved marks) along on its coattails, providing the product mark with some measure of renown. However, the issue here is not the fame of the parties' house marks, but the fame of opposer's pleaded product marks. But more importantly, the fame of applicant's mark is not an issue at all in this context. The relevant *duPont* factor is "The fame of the prior mark...." *duPont*, 177 USPQ at 567 (emphasis added). Fame under this *duPont* factor is not a race, with the prize going to whichever party is more well-known at the time of trial. A junior party gains no advantage over its opponent when its fame eclipses that of the prior user.

opposer's case based on its individual pleaded registrations.)

Opposer provided information on its sales under its respective marks covering the years 2000 – 2007. *See* Opp. Br. at 15 (and supporting evidence). (This evidence was submitted under seal, so we discuss it only in general terms.) We conclude that opposer's sales of goods branded with its pleaded marks were significant, particularly with respect to opposer's BUG STOP goods, although opposer provided little context for its sales figures. *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002). However, as noted above, we find opposer's reliance on advertising figures based on its retailers' obligation to spend a percentage of its total sales on advertising, Opp. Br. at 13-14, to be highly speculative, and of little worth, and we likewise give opposer's Brand Awareness Study very little weight.

"Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it." *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009). We are unable to find on this record that

any of opposer's marks are famous, although we keep in mind opposer's significant sales under the BUG STOP mark.

Although we conclude that opposer has not demonstrated that its marks are famous, its sales of BUG STOP goods favor a finding of likelihood of confusion somewhat.

3. The Similarity or Dissimilarity and Nature of the Goods

Applicant's goods are identified as "pesticides for domestic use." The goods in opposer's BUG STOP registration are identified as "insect repellent, insecticide and pesticide for domestic/household use."

Opposer argues that its goods are all included in a category of "control products," recognized by the industry, to which applicant also belongs. In response, applicant contends that opposer "continues its pattern of overreaching in its discussion of [the] goods," App. Br. at 42, stating, for instance, that "consumers are not likely to confuse MOLE STOP rodent repellant products or GRUB STOP insecticides with an ANT-STOP ant control product," App. Br. at 44, and that "[c]ustomers who are looking for a product to kill ants in their home are likely to read the product labels and purchase an ant control product rather than an all-purpose insecticide," App. Br. at 20.

But applicant's arguments compare the wrong goods:

> The issue in an opposition is the right of an applicant to register the mark depicted in the application for the

> goods identified therein. The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Sys. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Because applicant's "pesticides for domestic use" are not limited to any particular type of pesticide, we cannot construe them to be an "ant control product," as applicant argues. App. Br. at 20 ("ANT STOP is a single purpose insect control product."), 44. Rather, we consider applicant's goods to include all types of pesticides, limited only by the requirement that they be for "domestic use." The fact that in the marketplace, applicant only sells "ant control products" under its ANT-STOP mark, is not relevant when considering the scope of the goods in the subject application.[29]

We accept as reasonable applicant's proffered definition of a pesticide as "an agent used to destroy

[29] Similarly, to the extent opposer relies on its registrations as a basis for its opposition, we must consider the goods as identified in those registrations, and not as evidence may otherwise show them to be in the marketplace. *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008). Accordingly, opposer's "rodenticides" are not limited to those used for killing moles,

pests." *See* App. Br. at 43 (citing MERRIAM-WEBSTER ONLINE DICTIONARY, www.m-w.com). We take judicial notice of other definitions from the same dictionary and others[30]:

> **pest** (noun)
> * * *
> 2: something resembling a pest in destructiveness; especially: a plant or animal detrimental to humans or human concerns (as agriculture or livestock production)

MERRIAM-WEBSTER ONLINE DICTIONARY, www.merrriam-webster.com (last visited Sept. 28, 2010).

> **pes·ti·cide**
> * * *
> –noun
> a chemical preparation for destroying plant, fungal, or animal pests.

DICTIONARY.COM UNABRIDGED (based on the Random House Dictionary (2010)), www.dictionary.reference.com (last visited Sept. 28, 2010).

> **pesticide**
> * * *
> — n
> a chemical used for killing pests, esp insects and rodents

COLLINS ENGLISH DICTIONARY (online)(unabridged 10th ed. 2009), www.dictionary.reference.com (last visited Sept. 28, 2010).

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opposer's "insecticides" are not limited to those for killing "grubs," or "bugs."

[30] The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

These definitions show that a "pesticide" is understood as something used to destroy "pests," and that "pests" include insects, rodents, and even plants. Accordingly, "pesticide" is a broad term, which encompasses a variety of agents used to kill, for example, insects, rodents, and plants, *i.e.*, insecticides, rodenticides, and herbicides.

Thus construed, the goods identified in the subject application encompass (and to that extent are legally identical to) some of the goods recited in opposer's '338 Registration (BUG STOP), namely, "insecticide and pesticide for domestic/household use."

This factor strongly favors a finding of a likelihood of confusion with respect to the '338 Registration.

4. Trade Channels and Classes of Consumers

Unless explicitly limited to particular channels of trade, we construe goods identified in an application and registration to move in all normal channels of trade for such goods. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958). Further, to the extent that opposer's goods are legally identical to those in the subject application (*e.g.*, "insecticide and pesticide for domestic/household use," we must likewise assume that the purchasers and channels of trade are also identical for such goods. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB

2003); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"[31]).

To the extent the parties' goods are partially identical ('338 Registration), we find that the parties' potential customers and channels of trade are likewise identical. We note applicant's argument that its goods and those of the opposer would be segregated from each other due to their different nature. App. Br. at 20. But this argument relies at least in part on applicant's incorrect assumption that its goods (and those of the opposer) are considerably narrower than a proper reading of the application and registrations would support. Again, we do not construe applicant's pesticides to be limited to "ant control" products, and instead consider them to broadly comprise any "pesticides for domestic use," including those similar or identical to opposer's "insecticide and pesticide for domestic/household use." The evidence suggests that the identified goods are likely to be sold to the general public, in the same or similar retail outlets, and in

[31] Opposer made this same point, to which applicant takes exception, arguing that the class of goods is "immaterial." App. Br. at 44-45. Applicant is mistaken – opposer's (correct) comment was about the "class of purchasers," not the classification of goods. The former is an element of the likelihood of confusion analysis under *duPont*, while the latter

relatively close proximity to each other, even if the specific products are not sold side by side.

These factors also favor a finding of likelihood of confusion.

5. Sophistication of Consumers

Applicant argues that purchasers of its goods and those of opposer are sophisticated. For instance, applicant's witness, Richard Foster, who opined[32] that such customers are sophisticated because they read the product labels, which are "their primary information source" about the product. Foster Depo. at 17 (Jan. 23, 2008). For its part, opposer elicited testimony that purchasers of such products "are not knowledgeable about control products, and are generally confused." Opp. Br. at 9-10 (and cited evidence).

We think both parties miss the point. Very occasionally, we have found that the level of sophistication associated with purchases of the goods and those who purchase them tends to mitigate the likelihood of confusion to some extent. But as we have noted far more often, merely

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is indeed an administrative determination that has no bearing on the likelihood of confusion analysis.

[32] Opposer objected to this testimony as speculative, lacking in foundation, and calling for an opinion, but did not preserve its objection at briefing. Nonetheless, although we have considered testimony that, for instance, purchasers of pesticides read the product labels, we give little weight to Mr. Foster's opinion as to their "sophistication." Indeed, it is hard to tell what basis Mr. Foster had for his opinion, or how he defined the term "sophisticated" in this context. *See* Foster Depo. at 91-92

because the goods are expensive or purchased after careful deliberation does not mean that the purchasers are sophisticated, or that confusion would therefore be avoided. Even consumers who exercise a high degree of care are not necessarily knowledgeable regarding the trademarks at issue, and therefore immune from source confusion. *In re Wilson*, 57 USPQ2d 1863, 1865-66 (TTAB 2001); *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988)("Being knowledgeable and/or sophisticated in a particular field does not necessarily endow one with knowledge and sophistication in connection with the use of trademarks.").

Pesticides such as applicant's and opposer's goods are not impulse purchases, although they may be purchased without lengthy deliberation and at a relatively low price. *See* Opp. Br. at 12 (most of the goods sold under opposer's marks retail for less than $15.00). It seems clear that consumers do not purchase pesticides on a whim, but rather to resolve an infestation. As Mr. Hanley dryly testified:

> Q. [C]an you tell me anything about the consumers purchasing Ant Stop products from Scotts?
>
> A. Yes.
>
> Q. What can you tell me about them?
>
> A. They had ants and they wanted them dead.

(Sept. 26, 2008) (opposer's counsel attempting to explore these issues).

Q. Do you have any other information or knowledge about those consumers?

A. Yes.

Q. What information do you have?

A. They wanted to buy a product that worked.

Hanley Depo. at 54 (Oct. 31, 2007).

The evidence does not indicate (and we think it unlikely) that purchases of these products are the subject of the of the kind of prior education, in-depth research, and careful consideration that might dispel any potential confusion as to the source of the goods. These goods are sold to the general public, and there is no evidence that such group as a whole is particularly knowledgeable about pesticides or, more importantly, about the pesticide industry. And while it is quite possible that pesticide purchasers do read the label information, the testimony seems to indicate that such information is primarily about the suitability and use of the product, not its source. In Mr. Hanley's words, "[t]hey had ants and they wanted them dead." Any care taken in such purchases is likely focused on whether the product will resolve the infestation, rather than on whether the source of the product is clear.

We conclude that the identified goods are of a type which are purchased with an ordinary degree of care. Therefore, we find this factor neutral in our analysis.

6. The Similarity or Dissimilarity of the Marks in their Entireties

In a likelihood of confusion analysis, we compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "[T]he test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result." *H.D. Lee Co.*, 87 USPQ2d at 1727 (TTAB 2008). In comparing the marks, we keep in mind that "[w]hen marks would appear on virtually identical goods..., as is the case here, the degree of similarity necessary to support a conclusion of likely confusion declines." *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010), *citing Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant's mark is ANT-STOP. Opposer alleges a likelihood of confusion with its registered mark BUG STOP (and others). Applicant's mark, as well as opposer's BUG STOP mark are in "typed" form, and are therefore "not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in

commerce." *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1847. In evaluating likelihood of confusion based on a typed or standard character registration, one must consider "all reasonable manners" in which the mark could be depicted. *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992). In other words, we must construe the subject application to cover use of marks which are similar or identical to those within the scope of the registration.

While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks, and the Board often begins a comparison of compound marks by determining which (if any) element is dominant. As the Court of Appeals for the Federal Circuit observed, "in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this regard, we note that opposer has disclaimed the descriptive term "BUG" in its respective pleaded

registration. While we do not ignore disclaimed matter (which remains part of the mark), disclaimed terms are often somewhat less significant in forming a commercial impression, because they are descriptive or generic. *In re N.A.D. Inc.*, 57 USPQ2d 1872, 1973 (TTAB 2000). We conclude that the term "STOP" is the dominant portion of opposer's BUG STOP registration.

Similarly, applicant's mark – ANT-STOP – is comprised of two elements. Although applicant was not required to submit a disclaimer of the term "ANT" during *ex parte* prosecution of its application,[33] is quite apparent that the term "ANT" in applicant's mark is descriptive of the identified goods. Applicant ubiquitously describes the goods it sells under the mark as an "ant control product," and one intended for use in killing ants.[34] Similar to our analysis of opposer's marks, we give the descriptive component of applicant's mark somewhat less weight. As with opposer's pleaded marks, we conclude that "STOP" is the dominant element of applicant's mark.

[33] We presume that a disclaimer was not required because the terms form a "unitary" mark, being physically joined by a hyphen. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1213.05(a)(ii) (6th ed. rev. 2 2010)(Compound Words Formed with Hyphen or Other Punctuation).

[34] While applicant's identification of goods is more broadly worded, including pesticides for all purposes, a term need not describe all of the identified goods in order to be descriptive. *E.g.*, *In re Microsoft Corp.*, 68 USPQ2d 1195, 1200 (TTAB 2003).

Nonetheless, applicant argues that opposer's marks "are at best suggestive of their attendant goods, namely, products which stop weeds, moles, bugs, and grubs. Accordingly, Opposer's marks are at best, weak marks entitled only to a very narrow scope of protection." App. Br. at 39. Applicant does not apply the same analysis to its own mark, although the comparison is obvious. Applicant's mark shares a similar construction to that of opposer, and if opposer's marks are suggestive of "products which stop weeds, moles, bugs, and grubs," applicant's mark is likewise suggestive of products which stop ants.

We generally agree with applicant, to the extent that we find both parties' marks to be suggestive, and possibly not entitled to the widest scope of protection. But applicant considerably overstates its case in suggesting that opposer's marks are "entitled to little if any protection." App. Br. at 38. Opposer's registrations are presumed valid, Trademark Act § 7(b); 15 U.S.C. § 1057(b), and absent a counterclaim for cancellation, applicant may not be heard to argue that they afford opposer no protection at all. Trademark Rule 2.104(b)(2)(ii). And while strong marks are entitled to a broader scope of protection than weak ones, it has often been emphasized that even weak marks are entitled to protection against confusion. *King Candy*, 182 USPQ at 109 ("likelihood of confusion is to be avoided,

as much between 'weak' marks as between 'strong' marks, or as between a 'weak' and 'strong' mark.").

Applicant also argues that "the STOP feature is commonly used in the trade among third parties. ... This plethora of trademark registrations permitted registration for related goods indicates that the Trademark Office does not consider the word component STOP to be a protectable term in this field." App. Br. at 21-22, 42. We have considered applicant's evidence, but find it unconvincing of the conclusion that the term "STOP" is unprotectable. First, "third-party registrations relied upon by applicant cannot justify the registration of another confusingly similar mark." *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) (*quoting Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983)). Moreover, such

> registrations are not evidence of use of the marks shown therein. Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace, and as a result are able to distinguish between the ... marks based on slight differences between them.

In re Jump Designs LLC, 80 USPQ2d 1370, 1375 (TTAB 2006). In addition, many of the third-party "STOP" registrations cited by applicant are for significantly different marks or significantly different goods.[35] While applicant did

[35] We also note that Registration No. 2438008, for PESTOP, was cancelled under Trademark Act § 8 in 2007.

introduce some evidence of third-party use of "STOP" marks, *see* Brown Depo. (Jan. 24, 2008), the evidence did not demonstrate that the extent of such third party use was of such a high volume and extent as to render "STOP" an unprotectable term.

Comparing applicant's mark to opposer's, we recognize that the dominant portion of each of the marks is the identical – albeit suggestive – term "STOP." Moreover, this term has the same connotation in both applicant's mark and opposer's, namely, that the product will "STOP" the named pest – a bug in the case of opposer's BUG STOP mark.

Of course, as noted previously, we must consider the marks in their entireties. Even descriptive and disclaimed matter can form part of the overall impression of the mark, so it cannot be ignored. *Am. Home Prods. Corp. v. B.F. Ascher & Co., Inc.*, 473 F.2d 903, 176 USPQ 532, 533 (CCPA 1973). This may be especially the case where no element of the involved marks is highly distinctive. *Western Union Telegraph Co. v. Graphnet Sys., Inc.*, 204 USPQ 971, 976 (TTAB 1979). The marks as a whole obviously differ in that applicant's mark includes the term "ANT," while opposer's mark includes the term "BUG."

Nonetheless, in comparing ANT-STOP with opposer's BUG STOP mark, we find significant similarities. While the term "BUG" formally identifies "a hemipterous insect,"

DICTIONARY.COM UNABRIDGED (based on the Random House Dictionary (2010)), www.dictionary.reference.com (last visited Sept. 28, 2010), it is also used "loosely" to refer to "any insect or insectlike invertebrate." *Id.* (second definition). The colloquial definition of bug would include insects like ants, and the marks would thus have a very similar impression – that of something stopping an insect on the one hand (BUG STOP), and something stopping an ant (which is a kind of insect) on the other. Although the marks are clearly not identical, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

This factor weighs in favor of a finding of a likelihood of confusion as to opposer's '338 Registration for BUG STOP.

III. Conclusion

We have carefully considered all of the parties' evidence and argument, including that which we have not specifically discussed. We conclude that registration of applicant's ANT-STOP mark for the identified goods is likely to cause confusion with opposer's registered BUG STOP mark pursuant to Trademark Act § 2(d). In doing so, we note in

particular that the goods, channels of trade, and potential purchasers relevant to the subject application and opposer's '338 Registration are identical in part, and that the marks are similar in their wording, construction, and connotation. While we have also taken into account the inherent weakness of the marks, we do not find that such weakness eliminates in this case the likelihood that similar marks used on identical goods would cause confusion.

Decision: The opposition is SUSTAINED, and registration to applicant is refused.