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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Woodstream Corporation

Serial No. 77798045

Marsha G. Gentner of Jacobson Holman PLLC for Woodstream Corporation.

Susan Leslie DuBois, Trademark Examining Attorney, Law Office 111 (Robert Lorenzo, Managing Attorney).

Before Zervas, Kuhlke and Wellington, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Woodstream Corporation, seeks registration on the Principal Register of the standard character mark QUICK KILL based on allegations of first use and use in commerce since 1998 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051, and a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), for goods identified as “mouse traps” in International Class 21.¹

¹ Applicant originally filed its application under Section 1(a) only. In response to the examining attorney’s refusal based on mere descriptiveness under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052, applicant amended to seek registration based on a claim of acquired distinctiveness, which was ultimately accepted by the examining attorney.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when used with its identified goods, so resembles the registered standard character mark AMDRO QUICK KILL with "QUICK KILL" disclaimed for "insecticides" in International Class 5,² as to be likely to cause confusion, mistake or deception.

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We begin with the du Pont factor of the similarities and dissimilarities between applicant's mark QUICK KILL and registrant's mark AMDRO QUICK KILL. We analyze "the marks in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) quoting *du Pont*, 177 USPQ at 567.

Applicant's mark QUICK KILL comprises the second disclaimed portion of registrant's mark. Without question, AMDRO is the dominant portion of registrant's mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons,

² Registration No. 3769150, issued on March 30, 2010.

more or less weight has been given to a particular feature of a mark ... [and] [t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark”). See also *Palm Bay*, 73 USPQ2d at 1692 (first part of mark more prominent); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1998) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

The examining attorney submitted evidence to demonstrate that AMDRO is a house mark and argued that the addition of a house mark is more likely to add to the likelihood of confusion. While it is true that the addition of a house mark may “only serve to aggravate the likelihood of confusion” where a house mark is added to an arbitrary mark as in the case of *In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985) (LE CACHET DE DIOR confusingly similar to CACHET), that may not be the case where the house mark is added to matter that is descriptive or diluted. As stated in the TMEP § 1207.01(b)(iii) “[a]dditions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive of diluted.”

Applicant argues that the common matter, QUICK KILL, is sufficiently weak to allow for registration of its mark based on the difference occasioned by the addition of the house mark to registrant’s mark and the differences in the goods.

Applicant places great significance on the disclaimer in the registration going so far as to state that “the owner of the cited registration expressly has disclaimed any right to exclude Applicant from using its mark as set forth in the present application.” App. Br. p. 4. The examining attorney responds that “it is inappropriate to give the presence or absence of a disclaimer any legal significance.”

E. A. Br. p. 9, quoting National Data, 224 USPQ at 751.

In National Data, the court stated:

The technicality of a disclaimer in National’s application to register its mark has no legal effect on the issue of likelihood of confusion. ... The power of the PTO to accept or require disclaimers is discretionary under the statute ... and its practice over the years has been far from consistent. Thus, it is inappropriate to give the presence or absence of a disclaimer any legal significance.

Id.

Applicant distinguishes National Data by explaining that in that case it was the applicant seeking to disclaim matter whereas here it is registrant that has disclaimed the common matter QUICK KILL. Applicant essentially argues that registrant has limited its rights to the term QUICK KILL and thus any use of that term without something that impacts the AMDRO portion of registrant’s mark cannot be barred from registration. To the extent applicant is arguing that registrant’s rights in the disclaimed matter are affected by the disclaimer, this position is in conflict with Section 6 of the Trademark Act, 15 U.S.C. § 1056 which reads in pertinent part:

(b) No disclaimer, including those made under subsection (e) of section 1057 of this title, shall prejudice or affect the applicant’s or registrant’s rights then existing or thereafter arising in the disclaimed matter, or

his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.

Nonetheless, as acknowledged by the examining attorney (E.A. Br. p. 4) a disclaimer is often considered in a likelihood of confusion analysis to the extent that it indicates the mere descriptiveness of a term or phrase at the time of registration. Disclaimed matter is often “less significant in creating the mark’s commercial impression.” *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). “Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *National Data*, 224 USPQ at 752. However, while “a disclaimed term ... may be given little weight ... it may not be ignored.” *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006). Thus, the disclaimer in the registration does not preclude analysis of the registered mark in its entirety. If the applied-for mark is confusingly similar to registrant’s mark in its entirety “as shown,” then it is confusingly similar regardless of the presence of a disclaimer in the registration. We consider the strength of the common matter which affects the scope of protection to be given that element and the disclaimer adds to the evidence of weakness; however, it does not allow per se for registration of all other marks that contain in whole or in part QUICK KILL absent the house mark AMDRO.

In this case, the examining attorney has taken the position that the term QUICK KILL is highly descriptive and she then required significant evidence to

accept applicant's claim of acquired distinctiveness. We agree that the phrase QUICK KILL is merely descriptive of both applicant's³ and registrant's goods, and we further find that "the public [would] easily distinguish slight differences in the marks under consideration as well as differences in the goods to which they are applied, even though the goods of the parties may be considered 'related.'" *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Inasmuch as the term QUICK KILL is highly descriptive, we find that the dissimilarities outweigh the similarities, in particular given the differences in the goods discussed *infra*.

We next consider the *du Pont* factor of the relatedness of the goods, keeping in mind the very narrow scope of protection to be given the phrase QUICK KILL in relation to insecticides and mouse traps. We base our evaluation on the goods as they are identified in the registration and application. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). As a general proposition, it is settled that it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. See *In re Rexel Inc.*,

³ The fact that applicant has now established acquired distinctiveness does not affect our comparison of the marks or the scope of protection to be given that portion of registrant's mark. While this may present the issue of reverse confusion, we have taken that into consideration in our analysis.

223 USPQ 830 (TTAB 1984). However, the narrower the scope of protection, the closer the goods must be to find likely confusion. *King Candy*, 182 USPQ at 110. See also *In re Hunke & Joheim*, 185 USPQ 188 (TTAB 1975) ([I]t is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as ‘weak’ marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.”)

The examining attorney argues that the goods are related and has submitted several third-party use-based registrations that include both insecticides and rodent traps in support of her position. See Office Actions (November 9, 2009 and July 1, 2011) Reg. No. 2902699 for the mark ZEP COMMERCIAL for, inter alia, insecticides for the killing of ants, roaches, wasps, hornets etc. and rat and mouse traps; Reg. No. 3445201 (owned by applicant) for the mark W WOODSTREAM for, inter alia, insecticides and mouse traps; Reg. Nos. 1945137 and 2289011 for the mark D-CON for respectively insecticides and rodent traps; and Reg. No. 2809905 (owned by applicant) for the mark VICTOR for, inter alia, insecticides and rodent traps. In addition, she submitted a few printouts from third-party websites offering both mouse traps and insecticides for sale. See Office Action (May 28, 2010) www.get-revenge.us; and Office Action (July 1, 2011) www.pestmall.com.

While the goods are clearly related to the extent that both fall under the general category of pest control (see Office Action (July 1, 2011) pestworld.org) and there is some evidence of such goods being offered by a single source (including applicant), at least, under a house mark, if not the same product mark, the goods are different, one being a chemical the other being a mechanical trap, and serve different purposes, one kills insects the other mice. Thus, these goods are not legally identical.

With regard to the channels of trade, there are no limitations in the identifications of the application and cited registration, and the examining attorney has demonstrated that these goods are offered in the same channels of trade to the same classes of customers.

As we balance the du Pont factors we must consider the scope of protection to be accorded registrant's mark. Given the extreme weakness of the phrase QUICK KILL, that portion of the registrant's mark, which is disclaimed apart from the mark, is not entitled to a broad scope of protection and this weighs heavily in our determination. It is well established that even weak marks are entitled to protection. *King Candy*, 182 USPQ 108, 109 (CCPA 1974). However, where the common element is very weak, even small differences in the marks and/or the goods may suffice to dispel likely confusion. *Id.* We find that the addition of the registrant's house mark AMDRO coupled with the differences in the goods is sufficient to permit potential purchasers to distinguish source. Compare *King Candy*, 182 USPQ 108 (KING'S for candy not likely to cause confusion with MISS

Serial No. 77798045

KING'S for cakes) and In re Shawnee Milling Co., 225 USPQ 747, 749 (TTAB 1985) (GOLDEN CRUST for flour not likely to cause confusion with ADOLPH'S GOLD'N CRUST and design (with GOLD'N CRUST disclaimed) for coating and seasoning for food items) with In re Dennison Manufacturing Company, 229 USPQ 141, (GLUE STIC likely to cause confusion with UHU GLU STIC where goods are legally identical because registrant's "adhesives for paper and stationery" encompass applicant's "general purpose adhesive in stick form"). In view thereof, we determine that confusion is not likely between applicant's mark QUICK KILL and the mark AMDRO QUICK KILL in the cited registration.

Decision: The refusal to register based on a likelihood of confusion under Section 2(d) of the Trademark Act is reversed.