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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB NOV. 18, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sears, Roebuck and Co.
v.
George M. Bethurum

Cancellation No. 22,325

Joan Optican Herman, Frank B. Flink, Jr. and Trent Webb of Shook,
Hardy & Bacon L.L.P. for Sears, Roebuck and Co.

George M. Bethurum, pro se.¹

Before Simms, Hanak and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Sears, Roebuck and Co. has petitioned to cancel the
registration owned by George M. Bethurum for the mark
"BUSHWHACKER" and design, as reproduced below,

¹ Although formerly represented by counsel throughout the trial and briefing of this case, respondent represented himself at the oral hearing held herein.

for a "fire ant control pesticide for domestic and agricultural use".² As grounds for cancellation, petitioner (hereinafter sometimes referred to as "Sears") alleges that, with respect to pest control and other gardening accessories, it "offers for sale and sells electronic insect killers, electric hedge trimmers, weed and grass trimmers, and power-operated weed and brush-cutting tools" through "over 850 Sears retail outlets"; that since long prior to registrant's claimed date of first use of October 1987, petitioner has continuously used and is the owner of registrations for the following marks:

"BUSHWACKER," which is registered for "electric hedge trimmers";³

"WEEDWACKER," which is registered for "weed and grass trimmers";⁴

"BUGWACKER," which is registered for an "electronic insect killer";⁵ and

"BRUSHWACKER," which is registered for a "power-operated weed and brush-cutting tool";⁶

² Reg. No. 1,756,396, issued on March 9, 1993 from an application filed on April 29, 1992, which sets forth a date of first use anywhere of October 1987 and a date of first use in commerce of July 1991; affidavit §8 filed. The lining in the mark is for shading purposes only.

³ Reg. No. 1,124,862, issued on September 11, 1979 from an application filed on August 3, 1978, which sets forth dates of first use of February 28, 1974; first renewal.

⁴ Reg. No. 1,125,925, issued on October 16, 1979 from an application filed on June 1, 1978, which sets forth dates of first use of June 6, 1975; first renewal.

⁵ Reg. No. 1,263,505, issued for the mark "BUG WACKER" on January 10, 1984 from an application filed on September 24, 1982 and amended to the mark "BUGWACKER" on September 17, 1985, which sets forth dates of first use of January 31, 1980; combined affidavit §§8 and 15. The term "BUG" is disclaimed.

that the fire ant control pesticide offered by respondent under the "BUSHWHACKER" mark is "very closely related to [the] pest control and gardening accessories on which petitioner uses its famous, federally registered marks, BUSHWACKER, WEEDWACKER, BUGWACKER and BRUSHWACKER"; that long prior to respondent's date of first use of his mark, the use by petitioner of the marks "BUSHWACKER, WEEDWACKER, BUGWACKER and BRUSHWACKER to identify and distinguish its pest control and gardening accessories has created a strong recognition and association of the petitioner with its 'WACKER' family of trademarks"; that respondent's "BUSHWHACKER" mark "is the phonetic equivalent of the petitioner's famous mark BUSHWACKER, making ... [respondent's] mark a colorable imitation of the famous mark BUSHWACKER and the other marks in the 'WACKER' family of trademarks"; that the respondent's goods "are advertised and sold to the same potential purchasers as the goods sold by petitioner under the famous and federally registered mark BUSHWACKER and the other marks in the 'WACKER' family of trademarks"; and that respondent's mark, when used in connection with his goods, so resembles petitioner's marks for its goods as to be likely to cause confusion, mistake or deception.

Respondent, in his answer, has denied the salient allegations of the petition to cancel.⁷

⁶ Reg. No. 1,659,444, issued on October 8, 1991 from an application filed on August 29, 1990, which sets forth dates of first use of December 1980; affidavit §8 accepted.

⁷ Although respondent has additionally asserted, as affirmative defenses, that petitioner "is estopped by laches and/or acquiescence

The record includes the pleadings and the file of the involved registration. Petitioner, as its case-in-chief, has submitted the testimony, with exhibits, of: Robert J. Misevich, its buyer of non-powered lawn and garden equipment; Michael K. Young, an associate buyer for petitioner of powered hedge trimmers, weed and grass trimmers, bladed trimmers, and leaf shredders; and William J. Brandenburg, a buyer for petitioner of lawn mowers, tractors and snow throwers. Petitioner, in addition, has filed a notice of reliance on: certified copies of its originally pleaded registrations, as well as a certified copy of its registration for the mark "LEAFWACKER" for "lawn and garden shredding machines";⁸ its discovery deposition, with exhibits, of respondent; and certain of respondent's answers to petitioner's interrogatories.⁹ Respondent, as his case-in-chief,

from bringing or maintaining the claims of its Petition to cancel," such defenses not only have not been properly pleaded, in that the facts constituting the defenses have not been alleged, but in any event the defenses were neither proven at trial nor, except for a few conclusory statements, were they raised in respondent's brief. Accordingly, no further consideration will be given to respondent's putative affirmative defenses.

⁸ Reg. No. 1,651,346, issued on July 23, 1991 from an application filed on August 20, 1990, which sets forth dates of first use of October 5, 1987; combined affidavit §§8 and 15.

⁹ Respondent has filed a motion to strike petitioner's reliance on its registration for its "LEAFWACKER" mark, as well as to strike "reference to this registration or mark as it may appear elsewhere in the evidentiary materials proffered by Petitioner, including the testimonial depositions" of petitioner's witnesses, on the basis that the petition for cancellation "nowhere identifies or pleads Petitioner's purported LEAFWACKER mark or the alleged registration thereof" either separately or as part of petitioner's asserted family of "WACKER" marks. As a result thereof, and inasmuch as such registration issued well prior to the filing of the cancellation petition, respondent maintains that he "was not put on notice of Petitioner's attempts to rely on such registration and therefore was not in a position to seek discovery regarding same and/or to prepare for trial ... regarding this registration." However, as petitioner

has submitted notices of reliance on, inter alia: various newspaper advertisements by petitioner; copies of third-party registrations for marks which consist of or include the terms "WACKER," "WHACKER" or variants thereof, including such marks as "BUSHWACKER" and "BUSHWHACKER"; certain of petitioner's answers to respondent's interrogatories; some of respondent's answers to

notes in its opposition to the motion, petitioner's timely responses to the discovery requests served by respondent on the last day of the discovery period "specifically referred to and provided responsive information regarding the LEAFWACKER mark and registration." In light of "the notice found in Petitioner's discovery responses that this registration was a member of the 'WACKER' family of marks," petitioner "asserts that admitting evidence relating to LEAFWACKER would not unfairly prejudice the Respondent." Petitioner consequently requests that, pursuant to Fed. R. Civ. P. 15(b), the pleadings be deemed to be amended to conform to the evidence inasmuch as the mark "LEAFWACKER is merely an additional member of the 'WACKER' family of marks" and such rule provides, in pertinent part, that:

If evidence is objected to at the trial on the ground that it is not within the issues made by the pleadings, the court may allow the pleadings to be amended and shall do so freely when the presentation of the merits of the action will be subserved thereby and the objecting party fails to satisfy the court that the admission of such evidence would prejudice the party in maintaining the party's ... defense upon the merits.

Respondent, in reply, observes that, "pursuant to Board practice," he "had every right ... to serve ... discovery requests on the close of discovery" and that, in any event, such "does not change the fact that Petitioner did not satisfy its own affirmative obligation to give early notice in its pleadings [sic] of the particular marks on which it based its claims of likely confusion".

We agree with petitioner, however, that as stated in its brief, consideration of "[t]he LEAFWACKER mark does not create new issues, it merely adds more proof to the [family of marks] claim pleaded and, thus, [evidence with respect thereto] should not be stricken." We also concur with petitioner that, as stated therein, "because the mark has been the subject of discovery, there can be no prejudice to Respondent regarding that mark's involvement in this case," especially since petitioner, in its brief, appears to assert such mark only as a member of its claimed family of "WACKER" marks and not individually as is the case with its "BUSHWACKER" mark for electric hedge trimmers. Accordingly, the motion to strike is denied; the request to amend is approved; and the pleadings are hereby deemed to be amended pursuant to Fed. R. Civ. P. 15(b) to include the "LEAFWACKER" mark as part of petitioner's alleged family of "WACKER" marks.

petitioner's interrogatories; certain of petitioner's responses to respondent's requests for admission; dictionary definitions; and yellow pages listings. Petitioner, in rebuttal, has presented the testimony, with exhibits, of Andrew R. Ginger, its national retail marketing manager for the advertising activities of petitioner's home improvement division. Briefs have been filed and an oral hearing, attended by respondent and counsel for petitioner, was held.¹⁰

Priority, insofar as the parties' individual marks are concerned, is not in issue inasmuch as the certified copies of petitioner's registrations for its pleaded marks show not only that such registrations are subsisting and owned by petitioner, but that the filing dates of the applications which matured into those registrations are earlier than the filing date of the application which resulted in respondent's involved registration for his mark.¹¹ Petitioner therefore has priority vis-à-vis such marks. See, e.g., Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1428-29 (TTAB 1993) at n.

¹⁰ Inasmuch as petitioner, at the oral hearing, withdrew its contested motion to strike respondent's brief as untimely and thus, in effect, consented to the motion, which it had earlier opposed, by respondent to reopen the time for filing such brief, the motion to reopen is granted and respondent's brief is accepted. We also hasten to point out that even if petitioner were not allowed to rely upon the evidence pertaining to its "LEAFWACKER" mark, the outcome of this proceeding would be the same.

¹¹ As to the statement in respondent's brief, filed on December 19, 1996, that he "hereby renews" his motion, which was denied by the Board on April 18, 1996, to amend his answer to include a counterclaim for cancellation of petitioner's pleaded registration for the mark "BUSHWACKER" for electric hedge trimmers "on the grounds that said designation was, in fact, generic," such statement is denied as an untimely request for reconsideration, which under Trademark Rule

13; and American Standard Inc. v. AQM Corp., 208 USPQ 840, 841-42 (TTAB 1980). In any event, the record also establishes that each of petitioner's marks has been in continuous use since on or before the October 1987 date of first use in intrastate commerce by respondent of his mark (which was first used in interstate commerce in July 1991). Priority is in issue, however, with respect to whether petitioner has a family of "WACKER" marks. In addition, as characterized by petitioner in its brief, there are issues as to whether respondent's mark "BUSHWHACKER" and design mark, as used in connection with his fire ant control pesticide for domestic and agricultural use, is likely to cause confusion with petitioner's "BUSHWACKER" mark and ... one or more of Petitioner's other marks included in the ... family of marks for lawn and garden products, including the marks BUGWACKER, LEAFWACKER, WEEDWACKER, and BRUSHWACKER."¹²

According to the record, petitioner has continuously operated its "SEARS" retail stores, which are open to members of the general public,¹³ since 1925. Petitioner currently operates about 850 such stores throughout the United States along with another 100 "SEARS" paint and hardware stores. Petitioner's

2.127(b) was due no later than thirty days from the date of the Board's order denying the motion to amend.

¹² We again note that it appears from its brief that petitioner does not claim that there is a likelihood of confusion between respondent's mark and its "LEAFWACKER" mark individually, nor does it appear from such brief that petitioner is asserting a likelihood of confusion between respondent's mark and its "BUGWACKER," "WEEDWACKER" or "BRUSHWACKER" marks considered separately.

¹³ Such category, according to petitioner, includes representatives of public utilities, government agencies and agricultural customers who may have need for petitioner's products.

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"BUSHWACKER" electric hedge trimmers, nylon-string "WEEDWACKER" weed and grass trimmers, bladed "BRUSHWACKER" power-operated weed and brush-cutting tools, "BUGWACKER" electronic insect killers and "LEAFWACKER" shredders are sold and offered for sale exclusively in each of its retail locations and, until the discontinuance thereof around 1993, were marketed through petitioner's "SEARS" mail-order catalog, catalog outlets and merchandise agents. Such products are principally sold to homeowners and other ordinary consumers, although "upper-end" versions are also sold to professional landscapers. (Young dep. at 32.) Petitioner has continuously used its registered marks "on its products since at least as early as the date of first use set out in the Certificates of Registration"; specifically, since: February 28, 1974 in the case of its "BUSHWACKER" mark; June 6, 1975 as to its "WEEDWACKER" mark; January 31, 1980 with respect to its "BUGWACKER" mark; December 1980 in the case of its "BRUSHWACKER" mark; and October 5, 1987 as to its "LEAFWACKER" mark. (Answer to Respondent's Interrogatory No. 4. b.)

The goods sold under such marks "have long been and presently are advertised and sold in close proximity to each other in the SEARS lawn & garden section" of petitioner's stores, thereby "emphasizing their connection in the 'Wacker' family of products." (Answer to Respondent's Interrogatory No. 10.)

Petitioner also has distributed numerous advertisements which make reference to more than one of its "WACKER"-surnamed marks, although none of its ads includes all of such marks. Ads for such products have appeared nationwide in catalogs, direct mail

pieces, pre-print or free-standing newspaper inserts, other newspaper advertisements, and television commercials. In particular, when asked whether petitioner regularly runs advertising featuring several of its "WACKER"-surnamed products on the same page, Mr. Young answered as follows: "Yes. During peak season, which starts about in April and runs through about August or September, you will see the different segments of the WACKER family advertised on the same page." (Young dep. at 29.) Furthermore, to Mr. Young's knowledge, such advertising has taken place since at least 1990 and the record shows that various "WACKER"-surnamed products have been so advertised long prior to respondent's first use in October 1987 of his "BUSHWHACKER" and design mark.

Moreover, according to Mr. Brandenburg, who has been a buyer for Sears since 1967 and at one time was responsible for buying various power trimmers, petitioner intended to create a family of "WACKER"-based marks.¹⁴ Specifically, its "BUSHWACKER" brand of electric hedge trimmers was followed by the introduction of its "WEEDWACKER" weed and grass trimmers, which was followed in turn by the development of its "BUGWACKER" electronic insect killers, its "BRUSHWACKER" bladed trimmers and its "LEAFWACKER"

¹⁴ According to his testimony, Mr. Brandenburg personally used the phrase "a WACKER family of marks" prior to the commencement of this proceeding and is "the person at Sears that is probably most responsible for developing it" inasmuch as he "was involved with buying the [BUSHWACKER] hedge trimmer product ... and was singularly responsible for ... creating the WEEDWACKER trademark." (Brandenburg dep. at 35.) Such, in turn, "led us to look at it from a marketing opportunity to create a family of products so that we ... [had] an identity away from our competition[,] who used various trademarks." (Id.)

shredders. Mr. Brandenburg further noted, like Mr. Young did in his testimony, that advertising featuring--on the same page--at least some of the products sold by petitioner under its "WACKER"-based marks has been deliberately run so as "to tie that family together." (Brandenburg dep. at 18.)

Petitioner has also been selling various chemical products, including pesticides such as insecticides, in the lawn and garden department of its retail stores since at least as early as 1990. Such products, while displayed separately from the lawn and garden equipment offered under its various "WACKER"-surnamed marks, principally involve those marketed by the Chevron Chemical Company under the "ORTHO" brand and include products, such as "ORTHENE," "DIAZINION" and "DURABAND," for killing fire ants. Petitioner admits, however, that it does not sell any pesticides under its "BUSHWACKER," "WEEDWACKER," "BUGWACKER," "BRUSHWACKER" and "LEAFWACKER" marks, although ads for its "BUGWACKER" electronic insect killers have also featured yard and garden chemicals in particular.

While exact sales figures for petitioner's products are confidential, from 1977 until October 1994, sales of its "BUGWACKER" electronic insect killers were generally in excess of two and a half million units and totaled over \$100 million. During the period from 1990 through September 1994, sales of petitioner's "BUSHWACKER" hedge trimmers reached a level of roughly one and a half million units, representing annual sales of such items of several hundred thousand, and totaling almost \$70 million. For the same period, combined sales of its

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"WEEDWACKER" line trimmers and "BRUSHWACKER" bladed trimmers were nearly two and a half million units, reflecting yearly sales of several hundred thousand units, and totaled almost \$200 million. Sales during the same period of petitioner's "LEAFWACKER" shredding machines amounted to about 60 thousand units, or roughly 12 thousand per year, and ran just under five and one half million dollars.

Although its advertising expenditures are also confidential, in broad terms petitioner in 1993 spent over three million dollars on pre-print advertising, such as newspaper inserts, relating to the goods sold under its various "WACKER"-surnamed marks, of which approximately two million dollars was spent on ads featuring two or more of such products and their respective marks. Newspaper pre-print advertising by petitioner during a three-month period in 1994 and featuring multiple listings of its several "WACKER"-based marks, totaled over \$800,000.00, a figure which Mr. Ginger estimated "would sum up to a number similar to" that for 1993. (Ginger dep. at 40.) Such amount, Mr. Ginger stated, "represents only a portion of the advertising that would have been done in 1994 for these products." (Id.) In addition, while petitioner does not retain pre-print advertising which it ran during 1992 and the years prior thereto, and thus Mr. Ginger was unable to calculate petitioner's advertising expenditures for those years, he testified with respect thereto that "[i]t's my opinion that the level of advertising for WACKER products for previous years would be consistent with what we see ... for 1993 and '94." (Id.)

There are no significant instances of third-party use. According to Mr. Misevich, he has "never seen" the "WACKER name ... used anywhere except at Sears" as part of petitioner's marks.¹⁵ (Misevich dep. at 68.) In particular, Mr. Misevich testified that he was not aware of use of the marks "BUSHWACKER" or "BUSHWHACKER" by a third-party in connection with any product or service.¹⁶ Likewise, with the exception of the use by a third party of the mark "THE BUSHWACKER" for golf bags, Mr. Young testified that he was not aware of any such third-party usage. The sole instances of third-party use which come closest to the lawn and garden care field in which the parties' products are sold are those few, in yellow pages listings, in which the term "Bushwacker" appears as part of the trade names of a lawn maintenance firm, a nursery business and two separate tree service companies.

Respondent is in the business of developing and selling environmentally benign fire ant, roach, termite and weevil control compounds, which he markets under his registered

¹⁵ While, among other things, respondent introduced a third-party registration for the mark "WHACK" for "insecticides," as well as third-party applications to register the mark "BUSHWACKER PROFESSIONAL" for "chipper/shredder, vacuuming and blower machines for tree limbs, brush, leaves, yard debris and the like" and the mark "BUSHWACK" for an "insecticide" (respondent's exhibits 97, 114 and 124), there is no evidence that such marks either are or have ever been in use in connection with the respectively indicated goods.

¹⁶ Although the record also reflects the issuance of third-party registrations for the marks "BUSHWACKER" for "heavy-duty ground growth disintegrating machines for clearing land" and "WOODWACKER" for a "manual wood splitter" (respondent's exhibits 6 and 23), Mr. Misevich testified that he was not familiar with the registrants or any products made thereby and respondent failed to establish that such marks were in actual use for the goods set forth in the registrations.

"BUSHWHACKER" and design mark. In particular, respondent is the chairman and president of, and a principal shareholder (along with his wife Shirley and another individual) in, The Bushwhacker Associates, Inc., a Nevada corporation which manufactures and sells respondent's "BUSWHACKER" fire ant control pesticide under a license from respondent, who is the owner of the "BUSHWHACKER" and design mark. Respondent's "BUSHWHACKER" fire ant control pesticide, which he developed around 1987,¹⁷ is sold at retail through mass merchandisers, such as Wal-Mart, grocery stores, such as Randall's (a major Texas supermarket chain), and hardware stores, including Ace Hardware and Handy Wholesalers, and is also available by mail order. In particular, Wal-Mart, which is a major competitor of petitioner, sells respondent's "BUSHWHACKER" fire ant control pesticide in the lawn and garden section of its retail stores. Like petitioner's retail operations, the lawn and garden section at Wal-Mart's stores features not only pesticides and other chemical products, but also sells a full line of lawn care and gardening supplies, including power equipment and tools. Similarly, another of petitioner's competitors, the Ace Hardware chain, has a lawn and garden section in its stores. Such competitors draw the same types of customers as do petitioner's retail outlets and, since "[t]here are only so many customers to go around," they "will shop a retailer out of convenience and

¹⁷ Respondent, in addition, produces "a complete line of over-the-counter pharmaceuticals and a line of pet care products, all of ... [his] own formulas". (Bethurum disc. dep. at 9-10.)

based on sale prices" rather than loyalty to a particular retailer. (Brandenburg dep. at 29.)

Like any chemical product used for controlling insects, respondent's "BUSHWHACKER" fire ant control pesticide has been registered with the Environmental Protection Agency ("EPA"), as required by federal law,¹⁸ and has also been registered, in accordance with state laws, in each of the states in which it is currently sold.¹⁹ At present, respondent's EPA registration for his "BUSHWHACKER" fire ant control pesticide essentially permits use of the product anywhere, including household use as well as in food establishments, schools, hotels and other commercial businesses. Respondent's "BUSHWHACKER" and design mark was in lawful use in interstate commerce, as permitted by his first EPA registration for his product, as of July 1991. Respondent, whose earliest sales were in Texas and Florida, also maintains that such mark was in use (presumably in field tests or by being distributed to the public as free samples) as of October 1987. The earliest documented sale, however, relates to an October 9, 1990 sales ticket for two 25-pound canisters of "BUSHWHACKER" fire ant control pesticide sold to a country club in Galveston, Texas. Manufacturing of respondent's fire ant control pesticide,

¹⁸ Unless registered with the EPA, a pesticide may not be legally sold, although it may be given away and field tested. Respondent received his first EPA registration for his fire ant control pesticide, which had restrictions on the product's areas of use, in 1991 and received a second EPA registration therefor, which permitted broader usages, in March 1994.

¹⁹ Fire ants are principally a pest in about 18 southern states and in California and Arizona.

subject to his second EPA registration therefor, commenced in July 1994.

Following a rudimentary search conducted in May 1987, which among other things disclosed petitioner's registration for its "BUSHWACKER" mark for electric hedge trimmers, respondent elected to adopt his "BUSHWHACKER" and design mark for his fire ant control pesticide.²⁰ Respondent testified that he chose such mark because:

I saw the product as being somewhat similar to the civil war Bushwacker as I know it: It hides in the bushes and when you walk through it it gets them. And I thought the name was appropriate for an insect killer under those terms.

(Bethurum disc. dep. at 44.)

At the retail level, respondent's fire ant control pesticide is sold under his "BUSHWHACKER" and design mark chiefly in one-, five- and 25-pound canisters which are typically arranged in end-of-aisle displays. Commercial quantities of such goods, which are often applied by airplane, are available in 350 pound canisters. While, at present, agricultural users are his principal customers, respondent also offers, for such specific

²⁰ Respondent's reaction to petitioner's registration was that it did not present a problem inasmuch as "a weedcutter has nothing to do with a pesticide. I couldn't find that there would be any idiot that couldn't tell the difference between the two." (Bethurum disc. dep. at 42.) It should be pointed out, however, that even though the respective goods are specifically different in nature, the question to be determined concerning the registrability of respondent's mark is not whether such goods are likely to be confused but rather whether there is a likelihood of confusion as to the source of those goods because of the marks used in connection therewith. *See, e.g.,* In re Rexel Inc., 223 USPQ 830, 831 (TTAB 1984); MRI Systems Corp. v. Wesley-Jessen Inc., 189 USPQ 214, 218-19 (TTAB 1975); and Chemetron Corp. v. Self-Organizing Systems, Inc., 166 USPQ 495, 500 (TTAB 1970).

applications as protecting electrical equipment and connections, three-, six- and quarter-ounce containers of his "BUSHWHACKER" product, which he respectively markets under the marks "LIL WHACKER," "DADDY WHACKER" and "TINY WHACKER". According to respondent: "All of these whackers ... are used for electrical terminals, signal lights, street lights, railroad crossing lights, [and] all kinds of things that go into ... connection boxes to prevent the fire ants ... from doing damage to the wiring and circuitry." (Id. at 72.) In particular, the "LIL WHACKER" "goes into pressure switches and things of that nature"; the "DADDY WHACKER" is "made specifically for the use ... [in] huge transformers"; and the "TINY WHACKER" primarily "goes in the wellheads". (Id. at 72-74.) The sole sales figures of record, while confidential, indicate that, as of June 1, 1994, combined sales of respondent's pesticide and pharmaceutical products under his "BUSHWHACKER" and design mark have amounted to less than one million dollars, with the majority of sales having been generated in eastern and northeastern Texas.

Although none of respondent's variously packaged "BUSHWHACKER" pesticide for fire ant control is competitive or suitable for use with petitioner's "BUGWACKER" electronic insect killers, respondent admits that homeowners would want to eradicate both crawling as well as flying insects from their properties. Respondent, in fact, concedes that his fire ant control pesticide would be purchased by "just about any human being," including homeowners, and not just commercial businesses. (Id. at 133.) In particular, respondent testified as follows:

Q. Would a private home owner with a yard be within your group of potential purchasers?

A. Absolutely.

(Id. at 72.) Respondent, however, has not received any inquiry or communication which suggests, implies or otherwise infers that petitioner is associated with respondent, nor is respondent aware of any instance of actual confusion as to the source of the parties' respective goods.

Respondent, in addition to product literature given to customers through distributors of his goods and available at retail displays, advertises his "BUSHWHACKER" fire ant control pesticide at a variety of trade shows ranging from electrical equipment shows to home shows and flower shows. Respondent also advertises such goods in publications directed to owners and/or operators of golf courses, apartment complexes, hotels and motels. In addition, several of respondent's distributors do radio advertising for his goods. Respondent has done some limited television advertising thereof and plans to do radio ads directed to persons interested in gardening. Actual advertising expenditures to date, however, have been nominal.

Turning to consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists, we find that, contrary to respondent's contentions, petitioner has satisfied its burden of demonstrating that confusion as to source or sponsorship is likely to occur. Respondent, in this regard, argues among other things that

because petitioner's "hedge, weed, brush, grass and leaf trimmers and shredders" constitute "electric hand[-]held tools," such goods "are not interchangeable with, and are totally different from, fire ant control pesticide." While respondent acknowledges that petitioner's electronic insect killers are "arguably related" to respondent's goods, respondent asserts that "an electrical appliance for killing flying insects" is nevertheless "quite different" in that "it is a home use appliance, not a pesticide for agricultural use on farms, [or for] turf management, public utility and industrial uses," as is the case with respondent's product. Respondent consequently maintains that none of petitioner's goods is so similar to his fire ant control pesticide that confusion would be likely.

We agree with petitioner, however, that the parties' goods are sufficiently related that, if sold under the same or similar marks, confusion as to origin or sponsorship thereof would likely take place.²¹ As petitioner points out, all of its marks "are employed on goods commonly referred to as lawn and garden items, including items for plant tending and insect control." The record demonstrates, as petitioner accurately notes, that "the items sold in connection with Petitioner's marks

²¹ It is of course well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. *See, e.g.,* Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

are marketed alongside products which are for precisely the same application as Respondent's pesticide." Specifically, petitioner's electric hedge trimmers, weed and grass trimmers, weed and brush-cutting tools, lawn and garden shredding machines, and electronic insect killers are all sold together in the lawn and garden department of its retail stores in close proximity to such separately displayed products as pesticides and other household chemicals for weed and insect control. Petitioner, in fact, has even advertised its "BUGWACKER" electronic insect killers in conjunction with yard and garden chemicals. In a similar vein, respondent's fire ant control pesticide is sold alongside various lawn care and gardening supplies, including power equipment and tools, in the lawn and garden sections of such retailers as mass merchandisers, grocery stores and hardware stores. As a result, consumers have become so conditioned to seeing lawn and garden products of the kinds sold by the parties displayed together in the same section of retail outlets that they would regard such products, if marketed under the same or similar marks, as emanating from or being sponsored by or affiliated with a common source.

We also find, contrary to respondent's position, that petitioner has established a family of marks,²² characterized by

²² As stated in *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991):

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. Simply using a series of similar marks does not of itself establish the

the term "WACKER," which came into existence long prior to any date upon which respondent can rely in this proceeding. In particular, respondent maintains that third-party registrations of marks which consist of or include the term "WACKER" or "WHACKER," newspaper and magazine article excerpts mentioning such terms as "'bugwacker', 'weedwacker', and 'wacker'," yellow pages listings of a few landscaping and tree service firms using the term "Bushwacker" in their trade names, and dictionary definitions of the words "whack" and "whacker"²³ all serve to demonstrate that the term "WACKER" is merely descriptive, or at least highly suggestive, of petitioner's goods. Such term, according to respondent, is thus is not distinctive enough to trigger recognition thereof as a family surname, citing *Spraying Systems Co. V. Delavan Inc.*, 975 F.2d 387, 24 USPQ2d 1181, 1187 (7th Cir. 1992); *Land-O-Nod Co. v. Paulson*, 220 USPQ 61, 65-66

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.

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

²³ Among other things, dictionary excerpts show that Webster's Ninth New Collegiate Dictionary (1988) defines "whack" as a verb meaning "**1 a** : to strike with a smart or resounding blow **b** : to cut with or as with a whack : CHOP"; The Dictionary of American Slang (1975) lists such term as a verb meaning, inter alia, "[t]o chop with a knife or cleaver"; and Webster's Third New International Dictionary (1961) sets forth such term as connoting "to strike with a smart or resounding blow". Respondent specifically contends, in light thereof, that "'WACKER' is, if not merely descriptive, at best highly suggestive, of Petitioner's goods--electric implements which cut, shred, and trim hedges, bushes, weeds, and brush, and an electric appliance which 'zaps' flying insects."

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(TTAB 1983); *Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 394 (TTAB 1976); and *D. Kera*, "Tips from the TTAB," 67 Trademark Reporter 419, 420 (TTAB 1977).

The record shows, however, that even before respondent first used his mark in October 1987, petitioner has had an intent to develop a family of "WACKER"-based marks in light of the commercial success of its "BUSHWACKER" electric hedge trimmers, which it introduced in early 1974. Starting with its use of its "WEEDWACKER" mark for weed and grass trimmers a year later and continuing with its use of both its "BUGWACKER" mark for electronic insect killers and its "BRUSHWACKER" mark for bladed trimmers in 1980, along with the additional use of its "LEAFWACKER" mark for shredders by October 1987, petitioner has continuously used and promoted such marks as part of a family of "WACKER"-surnamed marks. Such products have not only been sold together, under the respective marks, in a substantial volume over the course of many years, but petitioner has expended appreciable sums and run numerous advertisements, in a wide variety of media, during that time in which more than one (although not all) of its "WACKER"-surnamed marks have regularly and prominently appeared. Given such extensive promotion, and the lack of any significant third-party use of "WACKER"-based marks on lawn and garden products, it is clear that the term "WACKER," even if it arguably could be viewed as suggestive of petitioner's products (and it plainly is not merely descriptive thereof), is in fact distinctive and is recognized by members of the purchasing public as indicative of the common ownership of

petitioner's marks. A family of such marks, characterized by the term "WACKER" as its distinguishing element, consequently exists and has so existed since prior to the earliest date upon which respondent can rely in this proceeding.

This brings us to consideration of the respective marks. Respondent argues that because the only similarity between his "BUSHWHACKER" and design mark and petitioner's "WEEDWACKER," "BUGWACKER," "BRUSHWACKER" and "LEAFWACKER" marks is the term "WACKER" (or "WHACKER"), such "is an insufficient basis for proving confusing similarity," particularly in light of the design element in his mark, which he asserts "is a prominent and dominant feature." While respondent also urges that "the highly stylized lettering" of his BUSHWHACKER and design mark "completely distinguishes" it from petitioner's "BUSHWACKER" mark, we are constrained to agree with petitioner that "the appearance, sound, connotation and commercial impression of Petitioner's BUSHWACKER mark and Respondent's BUSHWHACKER mark are, for all practical purposes, identical." Such marks are phonetically equivalent, differing only in the barely perceptible fact that respondent's spelling of the term "WHACKER" in his mark utilizes an "H" whereas petitioner's mark does not, and are virtually indistinguishable, as they are likely to be encountered in the marketplace, in appearance, connotation and overall commercial impression. The term "BUSHWHACKER" in respondent's mark is also the dominant and distinguishing element thereof, inasmuch as it is the only literal term in the mark and would thus be used by customers and prospective purchasers in asking

about or calling for respondent's goods. Moreover, as petitioner accurately observes, respondent's "BUSHWHACKER" and design mark "closely parallels Petitioner's other 'WACKER' marks for its lawn and garden products, in that consumers have come to associate marks containing the term "WACKER" with petitioner and are likely to view respondent's "BUSHWHACKER" and design mark, when used in connection with such a closely related lawn and garden item as a fire ant control pesticide for domestic use, as emanating from the same source as the lawn and garden products in petitioner's family of "WACKER"-based marks.

Thus, whether consumers are specifically familiar with petitioner's "BUSHWACKER" mark for electric hedge trimmers, or whether they are generally acquainted with such mark and others in petitioner's family of "WACKER"-surnamed marks, including its use of the "WEEDWACKER" mark for weed and grass trimmers, "BUGWACKER" for electronic insect killers, "BRUSHWACKER" for power-operated weed and brush-cutting tools and/or "LEAFWACKER" for lawn and garden shredding machines, confusion as to origin or association is likely to occur from the contemporaneous use by respondent of his virtually identical (in the former instance) or substantially similar (in the latter case) "BUSHWHACKER" and design mark for a fire ant control pesticide for domestic use. Clearly, when consumers and other purchasers encounter respondent's product in its canister packaging, and unquestionably when commercial and agricultural users encounter the product in smaller size containers bearing the "BUSHWHACKER" and design mark which are advertised under such additional marks

as "LIL WHACKER," "DADDY WHACKER" and "TINY WHACKER," confusion as to source or sponsorship thereof is likely since, even if purchasers were to notice the differences between respondent's "BUSHWHACKER" and design mark and petitioner's "BUSHWACKER" mark and/or any of its other "WACKER"-surnamed marks, they could still reasonably believe that respondent's fire ant control pesticide for domestic and agricultural use is simply another lawn and garden item emanating from petitioner.

In addition, while the record fails to establish that petitioner's marks are famous, it does show that such marks, both singularly and collectively, have achieved a significant measure of strength and recognition on the part of the purchasing public which entitles the marks to a correspondingly broader scope of protection. Petitioner's sales and advertising under its marks, as noted previously, have been substantial and its products, particularly those marketed under its "WEEDWACKER" and "BUGWACKER" marks, have received extensive publicity in newspaper and magazine articles. In view thereof, and given the absence of any significant third-party uses, in connection with the same or similar goods as those of the parties, of marks which consist of or contain the term "WACKER" (or its phonetic equivalent "WHACKER"), a finding of likelihood of confusion is warranted.

In reaching our conclusion in this regard, we have not ignored the absence of any reported incidents of actual confusion. We note, however, that such is not a meaningful factor in the circumstances of this case inasmuch as the record fails to demonstrate that, for a significant period of time,

respondent's sales and advertising of his product under his "BUSHWHACKER" and design mark have been so extensive that, if confusion as to origin or affiliation were likely to occur with petitioner's contemporaneous use of its "BUSHWACKER" and/or other "WACKER"-based marks, it could be expected to have happened. See, e.g., Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). The bulk of respondent's sales, which have been confined principally to eastern and northeastern Texas, appear to have taken place primarily during the two and a half years since he received his second and substantially less restrictive EPA registration for his product in 1994, and advertising done by respondent and his distributors under his mark has been quite modest.

Moreover, as respondent acknowledges in his brief, the absence of any reported instances of actual confusion is explained by the fact that, as a practical matter:

The primary channels of trade through which most of Bethurum's BUSHWHACKER fire ant pesticide is sold is for agricultural, public utility, and other industrial/commercial applications. The primary focus of Bethurum's market is to farmers, parks, schools, public utilities, and golf courses. In short, this is not Sears' claimed market [in its brief] of "middle to upper class suburban and urban" customers. . . . Even in the retail outlets such as grocery stores and Wal-Mart stores, where Bethurum's product is sold, it is directed to the institutional applications of the fire ant pesticide, such as for "schools" and "parks". . . .

It is well settled, however that the issue of likelihood of confusion must be determined in light of the goods set forth in the respective registrations and, in the absence of any specific

limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Here, respondent's product is broadly identified in his registration as a "fire ant control pesticide for *domestic* and agricultural use" (*emphasis added*), an identification which includes the same ordinary consumers and identical mass merchandiser and hardware store retail trade channels as those to whom and through which petitioner's household lawn and garden equipment is marketed. It is clear, therefore, that respondent's goods, as identified, may not be limited to agricultural and/or institutional users. Furthermore, and in any event, the absence of actual confusion to date is simply not dispositive inasmuch as evidence thereof is notoriously difficult to come by and the test under Section 2(d) of the Trademark Act is likelihood of confusion rather than actual confusion. See, e.g., Gillette Canada Inc. v. Ranir Corp., supra; Block Drug Co. v. Den-Mat Inc., 17 USPQ2d 1315, 1318 (TTAB 1989); and Guardian Products Co., Inc. v. Scott Paper Co., 200 USPQ 738, 742 (TTAB 1978).

As a final consideration, we observe that to the extent that, in particular, the differences in the inherent nature of the respective goods and the lack of any known incidents of actual confusion may serve to raise a degree of doubt as to our conclusion that confusion is likely, we resolve such doubt, as we

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must, against respondent and in favor of petitioner. See, e.g., Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp., 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977); and Izod, Ltd. v. Zip Hosiery Co., Inc., 405 F.2d 575, 160 USPQ 202, 204 (CCPA 1969).

Decision: The petition to cancel is granted and Reg. No. 1,756,396 will be canceled in due course.

R. L. Simms

E. W. Hanak

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board