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This Opinion is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Univar USA Inc.¹

Serial No. 76159040

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Kindness PLLC for Univar USA Inc.

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115 (Tomas V. Vlcek, Managing Attorney).²

Before Hairston, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Univar USA Inc. has applied to register KONTROL as a
mark on the Principal Register for goods identified as
pesticides, for domestic, industrial and agricultural use.
The application is based on applicant's allegation of its

¹ After filing the application, applicant twice recorded changes of its name in the USPTO assignment branch. By the first, its name was changed from Van Waters & Rogers Inc. to Vopak USA Inc.; by the second, its name was changed from Vopak USA Inc. to Univar USA Inc.

² Jennifer K. Elsea issued the first office action.

intention to use the mark in commerce on or in connection with the identified goods.

The examining attorney refused registration, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of the prior registration of the mark CONTROL and design (set forth below) for "insecticides for domestic use"³ and the prior registration of PRO-CONTROL (in typed form) for "insecticide for domestic, commercial, agricultural and industrial use."⁴ Each of these cited marks is registered on the Principal Register.



When the refusal of registration under Section 2(d) was made final, applicant appealed. Applicant and the examining attorney have filed briefs, but applicant did not request an opportunity to present oral arguments.

We analyze the issue of likelihood of confusion using the factors that were articulated by one of our primary reviewing court's predecessors, the Court of Customs and

³ Registration No. 2042589 issued March 11, 1997 and lists January 3, 1994 as the date of first use of the mark and first use of the mark in commerce.

⁴ Registration No. 1693958 issued June 16, 1992 and lists April 22, 1991 as the date of first use of the mark and first use of the mark in commerce.

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Patent Appeals, in the case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003).

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods and services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks").

With the initial office action refusing registration, the examining attorney included reprints of information on six registrations, retrieved from the USPTO trademark search system. Each shows a single mark registered for both pesticides (applicant's goods) and insecticides (the goods in the two cited registrations). Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993), and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

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Moreover, applicant has not, in either its main brief or its reply brief, argued that the involved goods, classes of consumers, or channels of trade are significantly different. Accordingly, we view applicant as having conceded the similarity of goods, classes of consumers and channels of trade.

The examining attorney also views applicant as having conceded these likelihood of confusion factors and his arguments in support of the refusal focus on the similarity of applicant's mark and those of the cited registrations. Applicant argues that the examining attorney erred by focusing exclusively on the involved marks and by failing to accord significant weight to evidence applicant offered about other registered marks, for the same or related goods or services, that also include the word "control." Applicant argues that this *du Pont* factor, the number and nature of similar marks in use on similar goods, is particularly significant in this case.

Our consideration of the similarity of applicant's mark and those in the cited registrations will be provided added context by first reviewing the other marks which applicant asserts must be considered. These are marks registered for insecticides or pesticides, equipment for applying such products, or various pest control services;

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one is registered for a magazine focusing on the pest control industry; and another is for "chemicals, namely stickers and drift control agents for pesticides."⁵ The marks are:

CAMICIDE HOME PEST CONTROL and design (HOME PEST CONTROL is disclaimed);

BIRTH CONTROL FOR ROACHES;

GLOBAL SOLUTIONS FOR MOSQUITO CONTROL (MOSQUITO CONTROL is disclaimed);

PCT PEST CONTROL TECHNOLOGY (claim of acquired distinctiveness under Section 2(f) of the Trademark Act, as to PEST CONTROL TECHNOLOGY);⁶

ACTION PEST CONTROL and design (PEST CONTROL is disclaimed);

VIKING TERMITE AND PEST CONTROL and design (TERMITE AND PEST CONTROL is disclaimed);

HOME SAVING TERMITE CONTROL, INC. and design (TERMITE CONTROL, INC. is disclaimed);

EARTH TOUCH ORGANIC PEST CONTROL and design (ORGANIC PEST CONTROL is disclaimed); and

POLY CONTROL (CONTROL is disclaimed).⁷

It appears clear that in six of the seven registrations that include a disclaimer, and in the one

⁵ The record does not reveal whether these chemicals are "for [manufacture of] pesticides," or "for [use during application of] pesticides," or related to pesticides in some other manner.

⁶ This is the mark registered for a magazine focusing on the pest control industry.

⁷ This is the mark registered for "chemicals... for pesticides."

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registration that includes a claim of acquired distinctiveness, the particular phrase covered by the disclaimer or the claim of acquired distinctiveness is a descriptive, or generic, indicator of the type of business in which the goods are used, or the services provided. In essence, these seven marks all contain within their words an unmistakable reference to the pest control industry (or a business focused on controlling a particular pest, e.g., mosquitoes or termites). The two exceptions to this pattern, among the nine registrations, are the marks BIRTH CONTROL FOR ROACHES and POLY CONTROL. The former mark, although registered for "insecticide" and clearly then a mark for a product used for pest control, does not utilize the word "control" to reference that field but, rather, to reference contraception; and the latter mark, is registered for chemicals, one of which is a "drift control agent" and so "control" describes an attribute of the product and is not a reference to the pest control industry.

The examining attorney essentially contends that while phrases such as "pest control" or "termite control" or "mosquito control" are clearly descriptive or generic and weak, these registered marks cannot be considered as evidence that the word "control," when used without "pest" or "termite" or "mosquito," as in the cited marks CONTROL

and design and PRO-CONTROL, is weak and entitled to only a limited scope of protection. Instead, the examining attorney asserts, when "control" is used in the manner that it is used in the two cited marks (or, for that matter, in the way that applicant has), it must be considered an element of a strong, distinctive mark. Brief, pp. 6 & 7. Thus, the examining attorney draws a bright line between, on the one hand, applicant's mark and the two cited marks ("extremely strong") and, on the other hand, the marks in the nine third-party registrations on which applicant places great reliance (term "control" used in descriptive manner).

Applicant appears to agree with the examining attorney in that applicant considers the use of "control" in the nine discussed registrations descriptive, but applicant essentially disagrees with the examining attorney's conclusion that applicant's mark and the two cited marks are clearly different and very strong. In short, applicant does not see the bright line perceived by the examining attorney and argues that its mark KONTROL, and the cited marks CONTROL and design and PRO-CONTROL, while not descriptive, are nonetheless very weak and each is entitled to a very circumscribed scope of protection.

We find applicant's view somewhat more plausible than that of the examining attorney. The cited marks, while not utilizing "control" as part of a phrase such as "pest control," "termite control" or "mosquito control," are not arbitrary or fanciful and at best can be considered very suggestive of products that allow one to control pest problems.

While we agree with applicant that the cited marks are a good deal weaker than the examining attorney believes, it does not follow as a matter of course that each of the refusals must be reversed. We consider each of the cited marks separately.

In comparing applicant's mark KONTROL and the cited mark PRO-CONTROL, we note that these are both typed marks and, because we must consider that a mark registered in typed form can be displayed in any reasonable form, we must consider that they could be displayed in the same or similar font. Even so, the two marks begin with different letters and would be pronounced somewhat differently, because of the presence of PRO- in the cited mark. In addition, the cited mark has the connotation of a professional strength product, while applicant's mark does not. On balance, we find these weak marks limited in their scope of protection and dissimilar enough that we reverse

the refusal of registration based on the prior registration of PRO-CONTROL.

On the other hand, we affirm the refusal of registration insofar as it is based on the prior registration of the CONTROL and design mark. The font employed in this mark is not particularly unusual, and would be a reasonable form of display for applicant's mark. Applicant's mark and this cited mark would be pronounced exactly the same, and would have the same suggestive connotation, i.e., both designate products that allow one to "control" a pest problem. While the target or bull's eye design element used in the cited mark is somewhat distinctive, we do not find it so distinctive that it dominates the mark; rather the word CONTROL dominates. On balance, we find applicant's mark and the cited CONTROL and design mark more similar than dissimilar. Notwithstanding that the cited mark may be highly suggestive and entitled to a narrower scope of protection than a more arbitrary or fanciful mark, it is still entitled to protection against registration of mark so similar that it would be likely to cause confusion among consumers. In re Colonial Stores, 216 USPQ 793, 795 (TTAB 1982). See also In re The Clorox Co., 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (ERASE for a laundry soil and stain remover held confusingly similar

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to STAIN ERASER, registered on the Supplemental Register, for a stain remover).

Finally, we note that applicant places great reliance on the co-existence on the register of the CONTROL and design mark and PRO-CONTROL marks. The question whether these two marks properly share space on the Principal Register is a question not before us. We must decide only whether the presence of either mark precludes adding applicant's mark to the register, because of a likelihood of confusion among consumers. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Decision: The refusal of registration under Section 2(d) is reversed as to the cited mark PRO-CONTROL but is affirmed as to the cited mark CONTROL and design.