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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re SunFeather Natural Soap Company, Inc.

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Serial No. 76480170

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Dana F. Bigelow of Marjama Muldoon Blasiak & Sullivan LLP  
for SunFeather Natural Soap Company, Inc.

Michael S. Levy, Trademark Examining Attorney, Law Office  
110 (Chris A.F. Pedersen, Managing Attorney).

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Before Hairston, Rogers, and Drost, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 12, 2002, applicant SunFeather Natural  
Soap Company, Inc. applied to register the mark BUG OFF (in  
typed or standard character form) on the Principal Register  
for goods ultimately identified as follows:

Cosmetics and personal care products, namely  
combination soap and insect repellent<sup>1</sup> in liquid or  
solid bar form for use on hands, face, hair and body;

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<sup>1</sup> The term "repellent" can also be spelled "repellant." For  
consistency sake, we have chosen to use the "repellent" spelling  
regardless of the way the term was spelled in the original  
source.

combination body balms and creams with insect repellent composed of oils, waxes, and essential oils for personal use in class 3.

Insect repellents in the form of face and body spray composed of essential oils in an oil or alcohol/ethanol base in class 5.<sup>2</sup>

The examining attorney<sup>3</sup> has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of two registrations for the mark BUG OFF. The first is for BUG-OFF in typed or standard character form,<sup>4</sup> and the other is for the words BUG OFF! with the design shown below.<sup>5</sup>



Both registrations are for virtually identical goods. The '898 registration's goods are "wrist bands for repelling insects" and the '024 registration's goods are identified as "insect repelling wrist bands." Both goods

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<sup>2</sup> Serial No. 76480170. The application contains allegations of dates of first use anywhere and in commerce for both classes of goods as July 20, 2001.

<sup>3</sup> The current examining attorney was not the original examining attorney in this case.

<sup>4</sup> Registration No. 2369898, issued July 25, 2000 (Section 8 accepted).

<sup>5</sup> Registration No. 3303024, issued October 2, 2007.

are classified in class 5 and the current owner of both registrations is identified as S.C. Johnson & Son, Inc.

When the refusal was made final, applicant filed this appeal.

In a case involving a refusal under Section 2(d), 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.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by looking at the "first *DuPont* factor [which] requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed.

Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The typed marks are virtually identical, BUG OFF and BUG-OFF. The only difference between the marks is the presence of a hyphen in registrant's mark. Applicant argues that the hyphen in the mark creates marks that are "substantially different" (Brief at 3) in appearance. We disagree. A "[s]ide by side comparison is not the test." *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973). This trivial difference, even if it were remembered, would have little significance. *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312, 1313 (TTAB 1987) ("Moreover, applicant's mark 'CROSS-OVER' and registrant's mark 'CROSSOVER' are identical in sound, and are also identical in appearance but for the inclusion in applicant's mark of a hyphen, which, for purposes herein, is of no legal significance") and *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2042 (TTAB 1989) ("It is also quite obvious that the marks are identical except for the division of registrant's mark by a hyphen between the syllables. We therefore, believe that confusion would be likely should these marks be applied to the same or related goods"). *Accord China Healthways Institute Inc. v. Xiaoming Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) ("And the use of a square dot

over the capital 'I' in Wang's mark, instead of the circular dot atop two arms in the Institute's mark, is unlikely to prevent customer confusion over the source of the products to which these marks pertain").

Obviously, the marks BUG OFF and BUG-OFF would be pronounced identically. In addition, both marks could mean literally "bug off" or they can also refer to the same exclamation: "Get out!" or "Go Away!" Richard A. Spears, *Slang American Style*, (NTC Publishing Group 1997).<sup>6</sup> Therefore, both marks would have the same meaning and any difference in appearance and commercial impression is slight. As a result, we conclude that the marks BUG OFF and BUG-OFF are virtually identical in sound, appearance, meaning, and commercial impression.

We add that the marks BUG OFF and BUG OFF! and bug design are also very similar. Applicant argues that the exclamation point, the lack of a space in registrant's design mark, and the different orientation of the letters in the marks are significant. Brief at 3. However, applicant's mark is in standard character form and we must assume that it could be displayed with any reasonable

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<sup>6</sup> We take judicial notice of this definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

stylization including the stylization of the letters in registrant's '024 registration (without the design). *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Tomy asserts rights in SQUIRT SQUAD regardless of type styles, proportions, or other possible variations. Thus, apart from the background design, the displays must be considered the same").

To the extent that the registered mark could be viewed as one word, we add that the absence of the space does not significantly change the impression created by the marks. *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 54 (TTAB 1983), *aff'd*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical") and *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) ("There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical"). Also, in this case, the larger letters B and O would emphasize the individual words

in the mark. Furthermore, the addition of the exclamation point in registrant's mark is hardly an important difference. "[M]inor design features do not necessarily obviate likelihood of confusion arising from consideration of the marks in their entireties. Moreover, in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed." *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983).

Also, while applicant points to the presence of the design in the cited registration, the design of the bug is hardly a distinction that purchasers would rely on to distinguish the goods. Both applicant's and registrant's goods repel bugs and the word portions of the marks would be the dominant part of both marks because it would be how the goods are referenced or ordered. The design in registrant's mark would simply reinforce the connotation of the BUG OFF words in the mark. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("Without a doubt the word portion of the two marks are identical, have the same connotation, and give the same commercial impression. The identity of the words, connotation, and commercial impression weighs heavily against the applicant"). When we compare the marks in their

entireties, the common word portion of the marks, BUG OFF, outweighs any differences and the marks are, if not virtually identical, at least very similar in sound, appearance, meaning, and commercial impression.

Next, we consider whether the goods are related. It "has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services." *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). *See also Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

The question then is whether consumers would believe that there is some relationship between the source of registrant's insect repelling wrist bands and applicant's combination soap and insect repellent in liquid or bar soap; combination body balms and creams with insect

repellent, and insect repellent sprays. Applicant argues that the "goods are not identical, competitive, or even closely related in nature." Brief at 4. Furthermore, "applicant's goods are cosmetics and ... they are designed to be rubbed, poured, sprinkled, or sprayed on to the human body... The registrant's goods are very narrowly defined as wristbands. As such, they are meant to be affixed, attached, or 'clamped' onto the body." Brief at 5.

The examining attorney has included evidence in the form of use-based, third-party registrations that show that insect repellents and cosmetics and personal care products, regardless of whether or not they contain insect repellents, are registered under a common mark. These registrations suggest that insect repellents and cosmetics and personal care products are associated with the same source.

The registrations show that entities have registered their marks for both television and radio broadcasting services. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the services listed therein, including television and radio broadcasting, are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988)".

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*In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d  
1214, 1217-18 (TTAB 2001).

The goods in these third-party registrations include:

No. 2635573 - skin care products, skin crèmes, body lotions, nasal spray preparations, and insect repellents

No. 2566086 - cosmetics, skin treatments, and insect repellents

No. 2840796 - skin creams, skin lotions, and insect repellents

No. 2694040 - soaps and insect repellents and electric devices to emanate perfume and insecticides substances

Furthermore, we agree with the examining attorney that "applicant's goods serve the same function as registrant's goods ... because both applicant and registrant provide related insect repellent products." Brief at 8. Indeed, both applicant's and registrant's products use citronella and they are both DEET-free. [www.sunfeather.com](http://www.sunfeather.com) and [www.kaz.com](http://www.kaz.com). The fact that registrant's goods are worn on the body, while applicant's repellents are applied to the body, does not mean that these goods, which perform the same function of protecting individuals from insects, are not related. We note that applicant's own website itself indicates that insect repellents come in a variety of forms such as: soap, a "bug rub," oil, liquid shampoo, and soy candles. [www.sunfeather.com](http://www.sunfeather.com). Applicant's identified

insect repellent products are likely to be viewed as additional products that are associated with registrant's wristbands with insect repellent. Therefore, we conclude that the goods of applicant and registrant are related.

In addition, we cannot find that there are any significant differences in the channels of trade for these different types of insect repellents. Purchasers looking for an insect repellent that would not require applying a lotion, cream, or soap could purchase registrant's product as an alternative or as additional protection. Also, it is likely that alternative insect repellent products would be offered for sale in the same locations in stores or on websites on the internet. While applicant argues that it sells its products through "natural/holistic and specialty trade shows" and it believes that registrant's goods are marketed "only by way of the internet," we cannot limit our analysis to only these narrow channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) ("[W]here the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade

that would be normal for such goods, and that the goods would be purchased by all potential customers"). See also *Morton-Norwich Products, Inc. v. N. Siperstein, Inc.*, 222 USPQ 735, 736 (TTAB 1984) ("Since there is no limitation in applicant's identification of goods, we must presume that applicant's paints move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers"). Under these circumstances, there is no reason to conclude that these goods would not be sold through the same channels of trade to the same purchasers seeking an insect repellent.

We add that the record indicates that applicant's BUG OFF! Products range in price from \$6.50 to \$13 and registrant's wrist bands cost \$15 or less. [www.kaz.com](http://www.kaz.com) and [www.sunfeather.com](http://www.sunfeather.com). The relatively inexpensive nature of the products is some evidence that the purchasers of these products would not be expected to exercise more than reasonable care when purchasing applicant's and registrant's goods.

Finally, applicant points to copies of twelve "registrations/applications [that] are 'live' and are shown to be used with different products and classes (i.e. 8 different classes). Accordingly, the [applicant] submit[s] that the mark is not so distinctive as to allow for the

registrant to exclude use of the mark by others in areas outside of its relatively narrow range of use." Brief at 6. We point out that even if this were true, applicant's insect repellents would be within the narrow range of use for registrant's insect repellent wrist bands. Also, even if these registrations did demonstrate that the marks in the cited registrations were weak, weak marks nonetheless "are entitled to protection against registration of similar marks, especially identical ones, for related goods and services." *In re Colonial Stores*, 216 USPQ 793, 795 (TTAB 1982); *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 to STAIN ERASER, registered on the Supplemental Register, for a stain remover).

The registrations and applications here are particularly unhelpful for applicant's position for several reasons. Applicant has included copies of the two cited registrations and an application apparently owned by the registrant (No. 78208245) among its evidence. Three attachments consist of other applications owned by applicant and the fourth is an intent-to-use application for equipment for horses. Pending applications are only evidence that the application was filed. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002)

("While applicant also submitted a copy of a third-party application ..., such has no probative value other than as evidence that the application was filed"). See also *Glamorene Products Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090, 1092, n.5 (TTAB 1979) ("The filing of a notice of reliance upon third-party applications is a futile act because copies of those applications or the publication thereof in the Official Gazette is evidence only of the filing of the applications and nothing else"). The remaining registrations for deflectors for motor vehicles, windshield cleaner solution, and pest control services and pest control distributorship services are much less relevant to the goods of applicant and registrant. Our principal reviewing court has explained that: "Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight." *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original). Similarly, applicant's evidence of a few uses for similar marks on less related products such as books, rugs, and bedding products hardly establishes that the cited

registrations are entitled to only a narrow scope of protection.

When we consider all the evidence of record in relation to the *du Pont* factors, we find that applicant's mark BUG OFF is virtually identical or very similar to the cited registrations for the marks BUG-OFF and BUG OFF! and design. The goods of applicant and registrant are related inasmuch as they are insect repellents in various forms for personal use. Also, the purchasers and channels of trade are at least overlapping. Therefore, we conclude that there is a likelihood of confusion in this case.

Decision: The examining attorney's refusal to register applicant's mark BUG OFF for the identified goods on the ground that it is likely to cause confusion with the cited registered marks used in connection with the identified goods under Section 2(d) of the Trademark Act is affirmed.