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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Buzz Off Insect Shield, LLC

Serial Nos. 78341612 and 76535857¹

Julie L. Dalke of Latham and Watkins LLP for Buzz Off Insect Shield, LLC in Ser. No. 78341612 and Howard A. MacCord of MacCord Mason PLLC for Buzz Off Insect Shield, LLC in Ser. No. 76535857.

James T. Griffin, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Hohein, Hairston and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On July 24, 2003, Buzz Off Insect Shield, LLC ("applicant") filed an intent-to-use application (Ser. No. 76535857) to register the mark BUZZ OFF INSECT SHIELD in standard-character form for goods now identified as "men's

¹ Buzz Off Insect Shield, LLC is the applicant in both identified applications. Because applicant has appealed from the same refusal by the same Examining Attorney in both applications and counsel for applicant has presented similar evidence and arguments in each appeal, the Board will dispose of both appeals in a single opinion.

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shirts, women's shirts, boys' shirts, girls' shirts, sweatshirts; fishing shirts, fishing vests, raincoats, hunting jackets, hunting pants, hunting vests, jackets, coats, sweaters, vests, athletic shorts, walking shorts, dresses, tank tops, bathing wraps, bathing suits, men's pants, women's pants, boys' pants, girls' pants, rain pants, coveralls, athletic socks, dress socks, hats, caps, scarves, shoes, boots, fishing waders, gloves, footwear, neckwear, slippers, robes, belts" in International Class 25 ("the BUZZ OFF INSECT SHIELD Application").²

On December 16, 2003, applicant also filed an intent-to-use application (Ser. No. 78341612) to register the mark BUZZ OFF in standard-character form for goods now identified as "garments, namely shirts, t-shirts, jackets, coats, sweatshirts, pants, sweat pants, hats, caps, socks, and bandanas treated with insect repellent" in International Class 25 ("the BUZZ OFF Application").

In each of the applications the Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the mark BUZZ-OFF BY VANDERBILT in standard-character form for goods identified as "men's and boys' knit shirts" in

² This application includes additional classes not at issue in this appeal and as to which there is no refusal pending.

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International Class 25 (Reg. No. 970833, which issued on October 16, 1973, and which has been renewed and remains active). The cited registration claims both a date of first use anywhere and first use of the mark in commerce in September of 1971.

Applicant responded to both refusals; the Examining Attorney made the refusals final in both applications, and applicant appealed in both applications. Applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing. We affirm the refusals in both applications.

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion ..." 15 U.S.C. § 1052(d). To determine whether there is a likelihood of confusion, we must consider all evidence of record bearing on the factors delineated in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977). Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In

addition to those factors, we will also address applicant's and the Examining Attorney's arguments relating to other factors.

We will consider the refusal with regard to each of the applications separately, as appropriate.

Comparison of the Goods and Channels of Trade

To find goods related for purposes of Trademark Act Section 2(d), the goods need not be identical. The goods need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from the same source. On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

In this case the goods in the cited registration are "men's and boys' knit shirts." The goods in the BUZZ OFF Application include "garments, namely shirts ... treated with insect repellent" as well as "t-shirts, jackets, coats, sweatshirts, pants, sweat pants, hats, caps, socks, and bandanas" also "treated with insect repellent." The goods in the BUZZ OFF INSECT SHIELD Application include "men's shirts" and "boys' shirts" as well as "women's shirts, girls' shirts, sweatshirts; fishing shirts, fishing vests, raincoats, hunting jackets, hunting pants, hunting vests,

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jackets, coats, sweaters, vests, athletic shorts, walking shorts, dresses, tank tops, bathing wraps, bathing suits, men's pants, women's pants, boys' pants, girls' pants, rain pants, coveralls, athletic socks, dress socks, hats, caps, scarves, shoes, boots, fishing waders, gloves, footwear, neckwear, slippers, robes, belts."

This breakdown demonstrates that the goods in both of the applications at issue are, at least in part, identical to the goods identified in the cited registration. That is, the "men's shirts" and "boys' shirts" identified in the BUZZ OFF INSECT SHIELD Application logically include the "men's and boys' knit shirts" identified in the cited registration. Likewise, the "men's and boys' knit shirts" identified in the cited registration logically include the "garments, namely shirts ... treated with insect repellent" identified in the BUZZ OFF Application.

The goods, as identified in the cited registration, in no way exclude goods treated with insect repellent. If goods are identified broadly, we must assume that the goods could include any goods of the general type identified. In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992). And of course, in this or any other proceeding we must consider the goods as identified in the application and registration. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ

198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

For completeness, we also acknowledge, as the Examining Attorney contends, that many of the remaining goods in the applications, beyond those goods which are identical to the goods in the cited registration, are related to the "men's and boys' knit shirts" identified in the cited registration. The Board has often found similar types of clothing items related to one another. See, e.g., Jockey Intl., Inc. v. Mallory & Church Corp., 25 USPQ2d 1233, 1236 (TTAB 1992); In re Pix of America, Inc., 225 USPQ 691, 692 (TTAB 1985) and cases cited therein.

Furthermore, even if the cited registration had specifically excluded goods treated with insect repellent, we would nonetheless find the goods in both applications and the cited registration closely related. There is no evidence that the presence or absence of this feature would somehow distinguish the goods and preclude confusion where it would otherwise exist.³ It is entirely reasonable to

³ In the BUZZ OFF INSECT SHIELD Application, applicant also argues that the goods in other classes included in this application are not related. The Examining Attorney did not refuse registration as to any class other than Class 25. Therefore, we need not consider whether those goods are related. Also, the presence of certain goods in an application which are not related to the goods in the cited registration cannot obviate confusion which may exist as to goods in the application which are identical or related to the goods in the cited registration.

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expect that a party offering men's and boys' knit shirts under a particular mark might also offer men's and boys' shirts treated with insect repellent under the same mark or a variant of that mark.

Applicant also argues that its trade channels differ from those of the registrant. In the BUZZ OFF Application applicant argues that, "Goods sold under Applicant's mark are highly specialized insect repellent products sold through exclusive retailers, such as L.L. Bean, Bass Pro Shops, and Ex Officio." Applicant argues that the registrant's products which are ordinary clothing would be sold through different channels. Likewise, in the BUZZ OFF INSECT SHIELD Application applicant argues, "Applicant's goods are sold in specialty stores and via the Internet on websites geared towards outdoor activities and travel (i.e., REI, Magellan's). Men's and boys knit shirts typically would be sold in mass merchandisers or department stores."

We must also evaluate the channels of trade based on the identification of goods in the applications and registration, and in the absence of any restrictions we must assume that the goods travel in all channels appropriate to the types of products identified. CBS Inc.

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v. Morrow, 218 USPQ at 199; In re Melville Corp., 18 USPQ2d at 1388.

In the BUZZ OFF INSECT SHIELD Application applicant has not specified in the identification of goods that the goods are treated with insect repellent. Accordingly, for the purposes of that application, we need not consider whether this feature would somehow impact the trade channels for the goods. Therefore, in view of the fact that the goods in the BUZZ OFF INSECT SHIELD Application are, at least in part, identical to the goods in the cited registration we conclude that the goods in the BUZZ OFF INSECT SHIELD Application and the cited registration would also travel in the same channels of trade.

The BUZZ OFF Application does specify in the identification of goods that the goods are treated with insect repellent. However, in spite of Applicant's assertions, there is no evidence that goods with this feature would be sold in trade channels distinct from goods of the same general type without this feature. In fact, applicant indicates that its goods are sold through outlets, such as L.L. Bean. We will not assume, in the absence of evidence, that L.L. Bean, and similar outlets, would not also sell shirts and other clothing which has not been treated with insect repellent. Accordingly, we

conclude that both types of goods would be sold through these outlets, and consequently that the channels of trade of applicant and registrant would be overlapping.

In addition, as we noted above, we must also assume that the goods in the cited registration could include shirts treated with insect repellent, in the absence of an explicit exclusion of such goods. On that basis, the goods could also be identical and travel in the same channels of trade.

Accordingly we conclude that the goods in both applications and the goods in the cited registration are, at least in part, identical and otherwise related and travel in the same or overlapping channels of trade.

Furthermore, we note that, "the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the goods or services are identical. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).

Comparison of the Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks. Palm Bay Imports Inc. v. Veuve Clicquot

Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant's marks are BUZZ OFF and BUZZ OFF INSECT SHIELD. The cited mark is BUZZ-OFF BY VANDERBILT. It is significant that all three marks begin with the distinctive phrase "BUZZ OFF." Presto Products, Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) (" . . . [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). Here it is of particular importance because BUZZ OFF not only is first but it stands out in projecting the connotation and commercial impression in all three marks. "BUZZ OFF" is an irreverent and memorable phrase which is sure to catch and hold one's attention when used first in a mark for clothing.

Contrary to the arguments posed by applicant "INSECT SHIELD" does little to distinguish the BUZZ OFF INSECT SHIELD mark from the cited BUZZ-OFF BY VANDERBILT mark. Applicant has disclaimed "insect" and did not seriously contest the Examining Attorney's determination that it is merely descriptive. While the Examining Attorney ultimately withdrew the requirement to disclaim "shield," it is a highly suggestive term when used immediately

following and when modified by "insect" and when applied to goods which are treated with insect repellent.

Accordingly, we conclude that "INSECT SHIELD" contributes relatively little to the distinctiveness of the mark and has no significant effect on either the connotation or commercial impression of this mark.

In concluding that "insect shield" has no significant effect on the connotation or commercial impression in applicant's mark, we agree with applicant's admonition that we must view the marks in their entireties. At the same time, it is entirely appropriate to accord greater importance to the more distinctive elements in the mark, here BUZZ OFF, than to the less distinctive elements in determining whether the marks are similar. As the Court of Appeals for the Federal Circuit observed, ". . . in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

With respect to both of its marks applicant also argues that the inclusion of "BY VANDERBILT" in the cited mark distinguishes its marks from the cited mark. On the other hand, the Examining Attorney argues that the addition of a house mark, such as BY VANDERBILT, in the manner evident here is "more likely to add to the likelihood of confusion than to distinguish the marks."

In a similar case the Board stated, "... the fact that applicant's mark includes the house mark "DIOR" does not necessarily establish that confusion as to source is unlikely herein. In cases involving the addition of a house mark to one of two otherwise confusingly similar marks, it has been held that such does not serve to avoid likelihood of confusion. Rather, such condition may actually be an aggravation of the likelihood of confusion as opposed to an aid in distinguishing the marks so as to avoid confusion." In re Christian Dior, S.A., 225 USPQ 533, 534 (TTAB 1985). See also In re Dennison Manufacturing Co., 229 USPQ 141 (TTAB 1986) and Key West Fragrance & Cosmetic Factory, Inc. v. The Mennen Co., 216 USPQ 168 (TTAB 1982). In this case we conclude that the inclusion of BY VANDERBILT would do nothing to obviate any likelihood of confusion with regard to either of applicant's marks.

In the BUZZ OFF Application, applicant argues that the connotation of its mark will differ from registrant's mark because applicant's goods are treated with insect repellent and the goods of the registrant are not. We reject this argument. As noted above, we cannot assume that the registrant's goods, which are identified broadly, would not include items treated with insect repellent. Furthermore, we have no evidence that the primary connotation, suggesting that someone or something go away, would vary significantly depending on whether the goods are treated with insect repellent or not.

Also in the BUZZ OFF Application, applicant argues that the presence of the hyphen between BUZZ and OFF in the cited mark distinguishes the marks. We reject this argument. This argument presupposes a side-by-side comparison of the marks which is not the proper test. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

In conclusion, while there are differences in appearance and sound between each of applicant's marks and the cited mark, we conclude that the position and importance, and consequent dominance of BUZZ OFF in all three marks overrides any differences due to the strong

similarity in both connotation and commercial impression BUZZ OFF projects in all three marks.

Accordingly, we conclude that both BUZZ OFF and BUZZ OFF INSECT SHIELD are similar to BUZZ-OFF BY VANDERBILT.⁴

Purchaser Sophistication

In both applications applicant argues that its goods are directed to sophisticated purchasers who will not be confused. In the BUZZ OFF INSECT SHIELD Application, applicant argues, "Consumers of garments treated with insect repellent, such as Applicant's, are sophisticated and discriminating and are not subject to impulse buying. Applicant's treated clothing falls in a higher average price range than typical men's and boys' knit shirts, as established by the declaration of Haynes G. Griffith. Many of Applicant's treated clothing items retail for between \$42 and \$84 per item, while knit shirts typically sell for much less." In the BUZZ OFF Application applicant indicates that, "Applicant's treated clothing items retail for upwards of \$100.00 per item." Applicant states

⁴ In the BUZZ OFF Application brief applicant has both cited and discussed a number of cases which originated in the district courts. These cases involve infringement and similar claims where the focus is on the actual use of marks. These cases are of limited relevance here due to our focus in this proceeding on the particulars of the applications and registration, not actual use. In re Bercut-Vandervoort & Co., 229 USPQ 763, 765 (TTAB 1986).

further, "A decision to purchase Applicant's garments is only made after careful consideration and research regarding the insect repellent protection afforded by Applicant's garments. Moreover, advertising of Applicant's goods is directed specifically to individuals having a need for such garments and clearly identifies the Applicant so that potential customers can contact Applicant or its highly respected authorized retailers."⁵ The Examining Attorney disagrees, arguing that the difference in price between the goods of applicant and registrant has not been established and that even sophisticated purchasers are subject to confusion.

We agree with the Examining Attorney. First, while we have some information about the potential price range for applicant's goods, we have no evidence regarding the price range of the registrant's goods. Indeed, registrant's goods, as identified in the application, could include goods treated with insect repellent and retail for the same price as the goods of applicant. And even if we assume that registrant's goods do not include goods treated with

⁵ We reject applicant's implied argument here that steps it takes in its advertising or otherwise will avoid confusion. We cannot consider such extrinsic matter. Cf. Vornado, Inc. v. Breuer Electric Mfg. Co., 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968).

insect repellent, nonetheless the price range may still be comparable to the price range for applicant's goods.

Furthermore, the price range applicant indicates for its goods is not so extreme that we can assume based on price that consumers will exercise maximum care. Based on the prices indicated, we can assume that the items would not be in the category of a check-out-counter impulse purchase. However, nor can we assume that all purchasers would exercise a high degree of care. It is most reasonable to assume that purchasers would exercise ordinary or moderate care in such a purchase.

Also, while applicant suggests that its goods are targeted to specialized clientele interested in outdoor activities and travel, we cannot conclude on that information that potential purchasers are highly sophisticated. Indeed, a large percentage of the general public may have an interest in outdoor activities and travel. Finally, as the Examining Attorney noted, even sophisticated purchasers are not immune from trademark confusion. In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). Accordingly, we conclude that the evidence in these applications bearing on the sophistication of the potential purchasers fails to indicate a diminished likelihood of confusion.

Other Arguments

In both applications, applicant points out that other marks, which applicant argues are somehow comparable to the marks at issue here, coexist on the register. For example, in the BUZZ OFF INSECT SHIELD Application, applicant argues that ALIVE BY VANDERBILT and MAN ALIVE coexist, and therefore, that applicant's marks should be permitted to coexist with the cited registration. Each case is unique. Ultimately we must decide each case on its own merits, and not based on actions taken on prior applications involving different facts. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). We find applicant's arguments regarding actions taken on prior applications unpersuasive.

In conclusion, after considering all of the evidence of record bearing on the du Pont factors, we conclude that there is a likelihood of confusion between both marks of applicant, BUZZ OFF and BUZZ OFF INSECT SHIELD, and the BUZZ-OFF BY VANDERBILT mark in the cited registration. We conclude so principally because the marks are similar, because the goods are, at least in part, identical or otherwise related and because the channels of trade for the goods are overlapping.

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Decision: The refusal to register BUZZ OFF (Ser. No. 78341612) under Section 2(d) is affirmed. The refusal to register BUZZ OFF INSECT SHIELD (Ser. No. 76535857) under Section 2(d) is affirmed as to International Class 25. However, because the Examining Attorney did not refuse registration with respect to the goods in International Classes 12, 18, 20, 22, 24, 27 and 28 in the BUZZ OFF INSECT SHIELD Application (Ser. No. 76535857), after this appeal is terminated the application will go forward to publication for the goods in those classes.