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Paper No. 15

RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Burlington Coat Factory Warehouse Corp.

Serial No. 76086468

Karl S. Sawyer, Jr. of Kennedy Covington Lodell & Hickman,
LLP for Burlington Coat Factory Warehouse Corp.

Katherine Stoides, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Cissel, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 11, 2000, applicant, a corporation of
Delaware, filed the above-referenced application to
register the mark shown below



on the Principal Register for "clothing," in Class 25 and "retail department store services," in Class 42. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with those goods and services. In her first Office Action, the Examining Attorney required amendment to the identification-of-goods clause to eliminate the indefinite term "clothing"; advised applicant that if it owned Registration No. 2,157,059, the instant application should be amended to claim ownership of that registration; and required that the geographically descriptive term "BURLINGTON" and the descriptive term "COAT FACTORY" be disclaimed apart from the mark as shown. Subsequently, an Examiner's amendment was made amending the identification of goods and recitation of services to read as follows: "clothing, namely sweatshirts, sweatpants, t-shirts, baseball caps and shorts in Class 25; retail department store services in Class 35." Applicant claimed

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ownership of Registration No. 2,157,059¹ and claimed distinctiveness under Section 2(f) of the Act with respect to the words "BURLINGTON COAT FACTORY." Additionally, applicant disclaimed the exclusive right to use the term "COAT FACTORY" apart from the mark as shown.

Following receipt of a Letter of Protest, the Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that if applicant's mark were used in connection with the goods and services set forth in the amended application, it would so resemble the mark "BURLINGTON" and the mark shown below



BURLINGTON

which are registered² for "men's, women's and children's clothing, namely, suits, sport coats, blazers, coats, jackets, slacks, shorts, shirts, blouses, skirts, dresses,

¹ Issued on the Principal Register on May 12, 1998 for the mark "B.C.F. CLUB" for "men's apparel, namely, shirts," in Class 25.

² Reg. Nos. 2,147,243 and 138,483 issued on the Principal Register to Burlington Industries, Inc. and Marshall Field & Co. on March 31, 1998 and December 28, 1920, respectively. Applicant subsequently submitted evidence establishing that the current owners of the two cited registrations are related companies.

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uniforms, sweaters, overalls, vests, jeans, jumpers, ties, rainwear, parkas, headwear, scarves, mufflers, activewear, sweatshirts, sweatpants, warmup suits, cloth bibs, gloves, swimwear, ski apparel, lingerie, boxer shorts, pajamas, sleepwear, robes [and] underwear," in Class 25, and for "hosiery," also in Class 25, respectively, that confusion would be likely.

Applicant responded to the refusal to register with argument that confusion would not be likely. Applicant claimed ownership of Reg. No. 1,850,094 for the mark "BURLINGTON COAT FACTORY," which issued on August 16, 1994. Applicant explained that this registration is simply the re-registration of the mark in Registration No. 1,263,835, which was canceled in 1990 because of applicant's inadvertent failure to file the affidavit required under Section 8 of the Act. Applicant argued that the addition of the letters "BCF" to applicant's existing registered mark "BURLINGTON COAT FACTORY" serves to distinguish applicant's mark further from the cited two registered "BURLINGTON" marks. Applicant contended that its registered mark "BURLINGTON COAT FACTORY" would not have been registered if it were likely to cause confusion with the cited "BURLINGTON" marks, and that the addition of the distinctive letters "BCF" and the design features in the

mark it is seeking to register makes confusion with the registered "BURLINGTON" marks even less likely.

Additionally, applicant submitted a copy of a settlement agreement between applicant and Burlington Industries, Inc., which owns one of the cited registrations and is the parent company of the owner of the other cited registration. The agreement, apparently reached in settlement of legal action between the parties in 1981, states, in pertinent part, that applicant is allowed to use the name "BURLINGTON" "as part of the designation 'BURLINGTON COAT FACTORY' or some other designation which includes 'BURLINGTON COAT FACTORY' with the words 'COAT FACTORY' sufficiently prominent to be clearly visible..." Citing *Amalgamated Bank of New York v. Amalgamated Trust & Savings bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1888), for the proposition that the Office should not substitute its own judgment concerning likelihood of confusion for the judgment of the real parties in interest, applicant argued that this agreement should be given great weight, and that the refusal to register under Section 2(d) the Act should therefore be withdrawn.

The Examining Attorney, however, continued and made final the refusal to register based on her conclusions that the mark applicant seeks to register is "highly similar to

the registrant's BURLINGTON marks in sight, sound and commercial impression," and that the goods and services specified in the application and the cited registrations are closely related. She stated that the settlement agreement "fails to overcome the refusal because the registrant does not specifically consent to the registration of this mark for these goods and services."

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed appeal briefs, but applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal based on the written record and arguments of applicant and the Examining Attorney.

Based on careful consideration of these arguments and the record presented in this appeal, we hold that the refusal to register under Section 2(d) of the Act is not well taken. When the marks are considered in their entireties, the commercial impression created by applicant's mark is sufficiently different from those created by the cited registered marks that confusion is unlikely.

Additionally, the owner of the cited registration, in the settlement agreement submitted by applicant, while not specifically consenting to the registration of the mark

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shown in the drawing in the instant application for the specific goods and services listed in this application, did agree that confusion was not likely between its "BUTRLINGTON" mark and applicant's "BURLINGRTON COAT FACTORY" mark. This bolsters our conclusion that confusion is not likely between the mark in this application and the registered "BURLINGTON" marks, because if the registrant agreed that confusion is not likely between "BURLINGTON" and "BURLINGTON COAT FACTORY," surely confusion would not be likely between "BURLINGTON" and the mark which applicant seeks to register with this application, given the additional differences between these marks discussed below.

Although the goods and services appear to be closely related, applicant's mark, when considered in its entirety, simply does not resemble either of the cited registrations closely enough to make confusion likely. Although applicant's mark does include the registered mark "BURLINGTON," the dominant element in applicant's mark is "BCF," which is presented in large black letters within an elliptical design which is itself contained within a larger black rectangular design. The words "Burlington Coat Factory," which, as noted above, are already registered by applicant, are displayed in much smaller letters inside the elliptical design. Because of all its additional words,

letters and design elements, applicant's mark creates a different commercial impression from the commercial impressions created by the cited registered marks.

Notwithstanding the Examining Attorney's conclusion to the contrary, the above-referenced language in the agreement submitted by applicant does support the conclusion that registrant agrees that confusion would not be likely in the case at hand. As applicant points out, by agreeing to permit applicant's use of a "designation which includes BURLINGTON COAT FACTORY, with the words COAT FACTORY sufficiently prominent to be clearly visible," (agreement, page 3, numbered paragraph 1), registrant appears to have agreed to applicant's use of the mark is seeking to register. Furthermore, the first page of the agreement specifically identifies applicant's business as operating "retail stores marketing clothing and other merchandise," so applicant's use in connection with the goods and services set forth in this application was clearly contemplated. Plainly, if this is not the case, or if, for some reason unknown to us, registrant is no longer bound by its agreement with applicant, registrant, or for that matter, anyone else who believes he will be damaged by registration of applicant's mark, will have the option of bringing an opposition proceeding against this application.

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Decision: The refusal to register based on Section 2(d) the Lanham Act is reversed. Applicant's mark will be published for opposition in due course.