

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

APRIL 29, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Burlington Coat Factory Warehouse Corp.

Serial No. 74/695,068

Dalbert U. Shefte of Shefte, Pinckney & Sawyer, L.L.P for
Burlington Coat Factory Warehouse Corp.

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(David E. Shallant, Managing Attorney)

Before Seeherman, Hanak and Walters, Administrative
Trademark Judges.

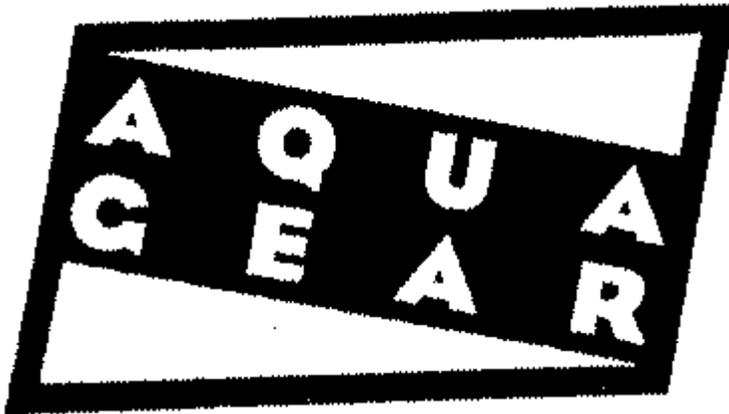
Opinion by Seeherman, Administrative Trademark Judge:

Burlington Coat Factory Warehouse Corp. has appealed
from the Examining Attorney's refusal to register AQUA TOGS,
with the word TOGS disclaimed, as a trademark for "rainwear
and outerwear, namely, jackets, coats, overcoats, top coats,
car coats, parkas, ski jackets, and wind breakers."¹

Registration has been finally refused pursuant to Section

¹ Application Serial No. 74/695,068, filed June 29, 1995, based
on an asserted bona fide intention to use the mark in commerce.

2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, if used on the identified goods, is likely to cause confusion with the mark AQUA GEAR and design, as shown below, registered for, inter alia, "footwear and clothing; namely jackets, t-shirts, shorts, and wet suits."²



The Examining Attorney also made final a requirement to amend the identification to delete the term "wind breakers" because WINDBREAKER is a registered trademark. In its appeal brief applicant stipulated that, "upon approval of the application, the term 'windbreakers' will be changed to 'wind resistant jackets.'" Accordingly, the issue of the identification will not be discussed in this decision.³

² Registration No. 1,721,015, issued September 29, 1992 to Nike, Inc. The word GEAR has been disclaimed. The registration also includes "all-purpose sports bags, and beach bags" in Class 18, but the likelihood of confusion refusal pertains only to the clothing items in Class 25.

³ Applicant is advised that any requirements which it does not wish to be the subject of the appeal should be complied with prior to filing the notice of appeal. If, after the filing of an

Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

We affirm the refusal of registration.

Applicant's identified goods include "jackets," which are also listed in the cited registration. Thus, we must consider the goods to be, in part, legally identical. The jackets identified in the registration are also closely related to applicant's coats and wind-resistant jackets.

Applicant has attempted to distinguish the goods and channels of trade in which they are sold, pointing to the fact that registrant's registration includes sport bags and beach bags, and claiming that registrant is a sporting goods company, in support of its argument that registrant's goods are "warm weather sporting goods and sold through channels of trade associated with warm weather sporting goods," brief, pp. 4-5, while applicant's goods are used during foul weather and are sold through applicant's own stores.

This argument is not persuasive. It is a well-established principle that the question of likelihood of confusion in an ex parte proceeding must be determined on the basis of the identification of goods set forth in the subject application and cited registration. **In re William Hodges & Co., Inc.**, 190 USPQ 47 (TTAB 1976). Because neither applicant's nor registrant's identifications of

appeal, an applicant decides to comply with an outstanding

goods contain limitations on the channels of trade, we must presume that they are sold in all channels of trade appropriate for those goods. Thus, applicant's and registrant's identified jackets must be presumed to be sold through the same channels of trade and must be presumed to be legally identical goods.

"When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Turning to the marks, both applicant's mark AQUA TOGS and the registered mark AQUA GEAR create similar commercial impressions. Both begin with the word AQUA, followed by a word which means "clothing."⁴ Thus, they have a similar construction, are identical in meaning, and are similar in appearance and sound with respect to the first word AQUA. While the second word in each mark differs, the presence of different generic terms in the marks is not sufficient to distinguish them. AQUA is clearly the dominant part of both marks, and the portion to which consumers will regard as the source identifier. Similarly, the design in the cited mark

requirement, it should do so by filing a request for remand.

⁴ We take judicial notice of the dictionary definitions of "togs" and "gear" submitted with the Examining Attorney's brief. See **University of Notre Dame du Lac v. J. C. Gourmet Food Imports**

is not a distinguishing element. That design consists of a simple geometrically-shaped background on which the words AQUA GEAR appear depicted on a slant. It does not convey a commercial impression apart from the words AQUA GEAR. Thus, even if consumers were to note or remember the specific differences in the marks (and we point out that, under actual marketing conditions, consumers do not have the luxury to make side-by-side comparisons between marks, **Dassler KG v. Roller Derby Skate Corp.**, 206 USPQ 255 (TTAB 1980)), these differences are so minor that consumers are not likely to believe that they indicate goods originating from separate sources. Rather, they will view these differences as minor variations of the same mark, identifying goods from a single source.

Applicant, referring to several third-party registrations, argues that marks containing the term AQUA for outerwear can be distinguished by the inclusion of additional terms. The Examining Attorney has objected to these registrations because they were not properly made of record. We agree that, normally, the mere listing of marks, registration dates, and goods, as applicant has done here, is insufficient to make third-party registrations of record. See **In re Hub Distributing, Inc.**, 218 USPQ 284 (TTAB 1983). However, in the second Office action the previous Examining

Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd. 703 F.2d 1372, 217

Attorney not only did not object to applicant's listing of information, but treated the registrations as being of record. Accordingly, the present Examining Attorney cannot now object to their consideration. Having said this, we would point out that the third-party registrations are of little persuasive value. Applicant has not provided registrations by which we can check whether the registrations are still in effect, or even whether they are owned by the same party.

More importantly, the marks in the third-party registrations all contain, in addition to the term AQUA, a source-significant distinguishing element, e.g., AQUA B.U.M., EVERETT AQUASOX, AQUA TONIC, AQUAWASH. In the present situation, as noted above, the differences in the marks consist only of different generic terms for the goods, as well as a minimal background shape and slanted depiction of the letters. Thus, applicant's mark is far closer to the mark in the cited registration than any of the third-party AQUA marks are to each other.

Decision: The refusal of registration is affirmed.

E. J. Seeherman

Ser No. 74/695,068

E. W. Hanak

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board