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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Walden Book Company, Inc. and Kroch's & Brentano's, Inc.
v.
Brenntano Co., Ltd.

Opposition No. 85,214
to application Serial No. 73/781,475
filed on February 13, 1989

Cancellation No. 23,187

Harold J. Fassnacht of Bullwinkel Partners, Ltd. for Walden Book Company and Kroch's & Brentano's, Inc.

Richard L. Kirkpatrick and Susan T. Brown of Cushman, Darby & Cushman for Brenntano Co., Ltd.

Before Rice, Cissel and Quinn, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

This consolidated case involves Walden Book Company, Inc.'s (hereinafter "Walden") opposition to an application filed by Brenntano Co., Ltd.,(hereinafter "Brentanno") and Walden's and Kroch's & Brentano's, Inc.'s petition for cancellation of a registration owned by Brenntano. The application is for the mark BRENNTANO for "men's, women's

and children's clothing, namely, suits, skirts, sportcoats, overcoats, jackets, sweaters, dress and sports shirts, jumpers, sports uniforms, stockings, socks, trousers, vests, blouses, undershirts, neckties, hats and headbands."[1] The registration is for the mark shown below

for "men's suits; men's, women's and children's clothing, namely, skirts, sportcoats, overcoats, jackets, sweaters, dress and sport shirts, jumpers, sport uniforms, stockings, socks, trousers, vests, blouses, undershirts, neckties, hats, and headbands."[2]

Both the notice of opposition and the petition for cancellation are based on priority and likelihood of confusion under Section 2(d) of the Act. Walden owns a concurrent use registration, namely, Registration No. 1,493,633 for the mark BRENTANO'S for "retail book store services" for the entire United States with the exception of the states of Illinois, Indiana, Wisconsin and Michigan.[3]

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[1] Application Serial No. 73/781,475, filed February 13, 1989, claiming a right of priority under Section 44(d) based on Korean application no. 1988-25492.

[2] Registration No. 1,809,257, issued December 7, 1993.

[3] This registration issued June 21, 1988 under Section 2(f); combined Sections 8 and 15 affidavit filed.

The excepted user is the other plaintiff in this case, Kroch's & Brentano's, Inc.

Brenntano, in its answer, denied the salient allegations of likelihood of confusion.

The record in these consolidated proceedings consists of the pleadings; the files of the involved application and registration; trial testimony, with related exhibits, taken by both sides;[4] copies of third-party registrations, excerpts from printed publications, including dictionary listings, and a certified copy of an official record, all introduced by way of Walden's notices of reliance; and portions of a discovery deposition and exhibits, and Walden's responses to certain discovery requests, made of record in Brenntano's notice of reliance. Both parties filed briefs on the case and both were represented by counsel at an oral hearing before the Board.

Walden, a wholly owned subsidiary of Border's Inc., operates a chain of sixty retail book stores under the mark BRENTANO'S. Walden has positioned these stores as "upscale", with enhanced customer service, nicer furnishings and literary titles that appeal to a more affluent customer. Use of the mark dates back to 1933. In 1933, Walden's predecessor in interest entered into an agreement with

Kroch's & Brentano's, Inc. wherein the predecessor retained exclusive rights to the mark BRENTANO'S in the entire United States except for the states of Illinois, Indiana, Wisconsin and Michigan. Kroch's and Brentano's, Inc. was given, by amended agreement, exclusive trademark rights in those four states. These concurrent use rights are reflected in Walden's pleaded Registration No. 1,493,633. Walden's sales under the mark have increased from $3 million in 1984 to over $70 million in 1990 (the most recent sales figures of record). Walden has promoted its BRENTANO'S bookstores in newspapers, yellow pages directories, catalogs, direct mailings and on the radio. Advertising expenditures in 1994 exceeded $400,000.

Brenntano is a Korean corporation that has been selling clothing in foreign markets. According to Yu Si Man, Brenntano's president, Brenntano has deferred using its mark in the United States until after the present dispute is resolved. Mr. Yu testified that the mark was selected to suggest that Brenntano's clothing has the look and flair of Italian fashion styles.

Before turning to the merits of the likelihood of confusion claim, we direct our attention to the other party in these proceedings, namely, Kroch's & Brentano's, Inc.

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[4] The testimony includes affidavit and declaration testimony pursuant to the parties' stipulations. Brenntano Co., Ltd. also took a testimony deposition upon written questions.

Little was heard from this party after it joined Walden in filing the petition for cancellation. What little we do know is from Nasir M. Ashemimry, chairman of Businesship International, Inc. In his affidavit testimony, Mr. Ashemimry indicated that Kroch's & Brentano's, Inc. became a wholly owned subsidiary of Businesship International, Inc. in 1993 at a time when Kroch & Brentano's, Inc. operated seven book stores in the Chicago area. Mr. Ashemimry goes on to testify that "Kroch's & Brentano's, Inc. filed a petition in bankruptcy in June 1995, and does not currently operate stores under the Kroch's & Brentano's name."[5]

Kroch's & Brentano's, Inc. cannot prevail in the cancellation proceeding. An essential element of proof in any cancellation or opposition proceeding is that the petitioner or opposer has standing to be heard on the pleaded claim, that is, that the plaintiff possesses a "real interest" in the proceeding. Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Further, in order to prevail on a claim of likelihood of confusion, the plaintiff must establish priority of use. In the present case, there is scant evidence on Kroch's &

[5] Mr. Ashemimry also asserted that his company purchased Kroch's and Brentano's, Inc. because of the strong name recognition that it had in the Chicago area, that the KROCH'S & BRENTANO'S trademark remains a valuable asset of his company, and that Businesship International, Inc. would consider requests to license or sell the trademark.

Brentano's, Inc. use of the pleaded mark. In point of fact, the company has gone bankrupt and has closed its stores. Accordingly, Kroch's & Brentano's, Inc. has failed to prove facts which satisfy the standing and the priority requirements. No Nonsense Fashions, Inc. v. Consolidated Foods Corporation, 226 USPQ 502 (TTAB 1985). Accordingly, Kroch's & Brentano's petition must fail.[6]

Also as a preliminary matter, we note that there are five evidentiary objections regarding the record in these proceedings. At the oral hearing, the Board was given a "stipulated summary of applicant/respondent's objections and petitioners' responses to objections."[7] Objections one, four and five are overruled, essentially for the reasons set forth by Walden. However, with respect to objections two and three, that is, the deficient introduction of Walden's pleaded registration and the irrelevancy of Brenntano's application for registration of a service mark, respectively, see discussion, infra.

We first turn to the matter of priority of use. Walden, during the September 22, 1995 testimony of Charles

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[6] We would point out that, in any event, the mark KROCH'S & BRENTANO'S is less similar to Brenntano's mark than is Walden's mark which we have found, as discussed infra, to be not confusingly similar to Brenntano's mark.

[7] The evidentiary objections that are listed in the stipulation are ones also raised in the briefs at final hearing. No other objections have been considered. Reflange, Inc. v. R-Con International, 17 USPQ2d 1125 (TTAB 1990).

Guinta, a retired senior vice president for administration at Walden, introduced into evidence a certified copy of the registration file of Walden's pleaded Registration No. 1,493,633 (Guinta dep., p. 23, ex. 4). However, as pointed out by Brenntano's, there is an absence of testimony regarding the current status and title of this registration. Indeed, given the fact that Mr. Guinta testified that he has no present business relationship with Walden, his ability to testify as to current status and title (of which, presumably, he lacks personal knowledge) is highly questionable.

The certified copy of Walden's registration file, dated December 5, 1994, does not reflect status and title. That is to say, it is not a copy of the registration whereon the Office has entered information regarding status and title. Thus, this document does not establish current status and title.

Notwithstanding the evidentiary problem with Walden's registration, we find that, in any event, Walden's other evidence establishes that it owns the BRENTANO'S mark and has priority of use. The testimony and evidence show that Walden's use of the mark BRENTANO'S predates the earliest date upon which Brenntano's may rely in these proceedings.

We now turn to the merits of the likelihood of confusion claim. Our determination under Section 2(d) of

the Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As dictated by the evidence, different factors may play dominant roles in determining likelihood of confusion. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). The factors deemed pertinent in the proceeding now before us are discussed below.

With respect to the marks, BRENTANO'S and BRENNTANO are virtually identical, the only differences being a possessive letter "s" in Brentano's mark and an additional letter "n" in Brenntano's mark. The marks look alike and are indistinguishable in sound. Simply put, the marks convey virtually identical overall commercial impressions. The same is true with respect to Walden's mark and Brenntano's mark BRENNTANO and design.

The crux of this case centers on the relatedness between Walden's retail book store services and Brenntano's clothing items. Walden highlights the fact that the BRENTANO'S mark has appeared on non-book items such as shirts worn by store personnel during store promotions and on fabric tote bags. Walden also points out that advertisements for its bookstores have appeared in print

next to clothing ads. Walden essentially contends that it has "bridged the gap" between book stores and clothing, and that Walden's BRENTANO'S mark is entitled to a wide scope of protection which extends into the clothing field.

As indicated above, Walden has been engaged for many years in rendering bookstore services under the mark BRENTANO'S. Although the great majority of Walden's sales are for books, Amy Hancock, Walden's merchandise manager for store planning, testified that the bookstores also have sold items such as audio recordings, puzzles, booklights, games, maps, greeting cards and calendars. Ms. Hancock also testified that there are plans to expand the sale of nonbook items in BRENTANO'S stores, and that the sale of clothing items cannot be ruled out, giving as examples jogging shorts with a book about jogging and a handyman apron in connection with a handyman book. Ms. Hancock went on to testify that tote bags bearing the mark BRENTANO'S have been given away at store openings, and that others have been sold. The only sales figures given show that in an approximately six-month period in 1995, Walden sold 887 tote bags for a total of $733.

The record also includes the testimony of Robert Childs, Walden's manager of store operations, budget and expense control, and Beth Ann Koehler, a merchandise buyer for Walden. Their testimony reveals that bookstore

employees have worn, at times, shirts bearing the name BRENTANO'S. In this connection, Ms. Koehler testified about the use of BRENTANO'S on polo shirts in 1987-1990 and on t-shirts in 1990-1992. In some instances, the shirts were part of a dress code for store employees (numbering about 100) so that they could be easily identified by customers. Both Mr. Childs and Ms. Koehler stated that none of the shirts was ever sold to the public.

In addition to the above, Ms. Koehler testified that caps and shirts bearing the mark BORDER'S (another chain of retail bookstores owned by Walden) are sold at BORDER'S bookstores.

We find, on the record before us, that the connection between Walden's retail bookstore services on the one hand, and Brenntano's clothing items on the other hand, is too tenuous upon which to base a finding of likelihood of confusion. With one exception (the BORDER'S example), there has been no evidence of a practice in the bookstore trade to sell clothing or to license a bookstore mark for use on clothing. More specifically, Walden's has not sold any clothing items in its BRENTANO'S bookstores. And, although Walden's has sold a variety of goods other than books in its BRENTANO'S stores, these goods, by and large, are book-related items (as, for example, booklights, bookmarks, etc.)

or items commonly found in bookstores (as, for example, calendars, maps, etc.).

To the extent that Walden's emphasizes its use of BRENTANO'S on tote bags, we would point out that these bags are not clothing items. Instead, they are mere promotional items for the retail bookstore services. The tote bags were sold only in Walden's stores, and typically at store openings. As shown by Brentanno's evidence, it is not uncommon for non-clothing stores to sell tote bags displaying the stores' service mark.

Further, Brenntano's has introduced copies of third-party registrations showing that registrations for the same or similar marks have been issued to two different entities for clothing and bookstore services. Such evidence would tend to suggest that consumers may be accustomed to distinguishing source based on the differences between clothing and bookstore services.

Simply put, we find that consumers familiar with Walden's BRENTANO'S bookstores, wherein clothing has never been sold (but, admittedly, has been used in a promotional manner), would not expect that BRENNTANO'S clothing found in another store (perhaps even in the same shopping mall) emanated from the same source. Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1332 (TTAB 1992).

Another factor concerns the fame of Walden's BRENTANO'S mark. There is no question but that Walden (and/or its predecessors) have enjoyed success in their retail bookstore services rendered under the BRENTANO'S mark. Although Brenntano's suggests that Walden's BRENTANO'S stores are on the decline, the sales and advertising figures of record are nevertheless impressive. The mark has been in use for many years and, further, the record is devoid of any third-party uses of BRENTANO'S in any field.

While we find that Walden's mark is a strong and distinctive mark for retail bookstore services, we do not view the mark in the same fashion in relation to non-book items such as clothing. Walden has neither marketed clothing to purchasers nor registered its mark for clothing. There is no evidence on which we can find that Walden's registered mark for retail bookstore services is so strong and distinctive that the strength and distinctiveness carries over to non-book items such as clothing. There simply is no evidence establishing public awareness and transference of the service mark function of Walden's mark to clothing items by virtue of the strength of Walden's mark for retail bookstore services. G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292, 16 USPQ2d 1635, 1639 (Fed. Cir. 1990); Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984); and Bausch & Lomb Inc. v.

Leupold & Stevens Inc., 6 USPQ2d 1475 (TTAB 1988). Thus, to the extent that any fame can be accorded to Walden's mark BRENTANO'S, the fame is confined to retail bookstore services, and does not extend to non-book items such as clothing.

Further, the fact that Brenntano's mark may call to mind Walden's mark is not dispositive. Likelihood of confusion under Section 2(d) means more than the likelihood that the public will recall a mark on seeing the same or similar mark used by another. It must also be established that "there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark." University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983), aff'g 213 USPQ 594 (TTAB 1982). See also: Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982), aff'g 211 USPQ 165 (TTAB 1981); In re Ferrero, 479 F.2d 1395, 178 USPQ 167 (CCPA 1973); Original Appalachian Artworks, Inc. v. Streeter, 3 USPQ 1717 (TTAB 1987); and American Express Co. v. Payless Cashways, Inc., 222 USPQ 907 (TTAB 1984). Here, the record falls short of establishing the reasonable basis contemplated by the Court.

In reaching our decision, we have considered Walden's argument that owners of well known trademarks often use or license the use of their marks on clothing. See, e.g., In re Phillips-Van Heusen Corp., 228 USPQ 949 (TTAB 1986). For the reasons set forth by Brenntano in its brief (pp. 33-34), the cases principally relied upon by Walden are distinguishable from the present case. Suffice it to say that the evidence of record bearing on Walden's own marketing practices and those in the industry simply does not establish the proposition urged by Walden.

Based on the record before us, we see the likelihood of confusion claim asserted by Walden as amounting to only a speculative, theoretical possibility. Language by our primary reviewing court is helpful in resolving the likelihood of confusion controversy in this case:

> We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), *citing* Witco Chemical Co. v. Whitfield Chemical Co., Inc., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

As a final note, Walden has expressed, in arguing that confusion is likely, great concern about Brenntano's

proposed use of the mark BRENNTANO in connection with retail clothing store services.[8] Whether or not Brenntano's use of BRENNTANO as a service mark for retail clothing stores is likely to cause confusion with Walden's use of its mark for retail bookstore services is irrelevant to this proceeding. Here Brenntano is seeking to register its trademark for clothing items, and our determination in these proceedings must be based on a consideration of the identified goods in the involved application and registration, and not whether confusion is likely in connection with activities listed in an application not presently before us. Saks & Co. v. Snack Food Association, 12 USPQ2d 1833, 1836 (TTAB 1989). The dismissal of the present cases in no way precludes the Board from reaching a different result, based on a different record, if the parties were to litigate Brenntano's right to registration of BRENNTANO'S as a service mark for retail clothing stores.

Decision: The opposition and petition for cancellation are dismissed.

J. E. Rice

R. F. Cissel

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[8] Brenntano owns application serial no. 74/500,143 for the service mark BRENNTANO and design. The mark was published for opposition, and when no opposition was filed, a notice of allowance issued. The application currently is under an extension of time to file a statement of use.

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board