

ESTTA Tracking number: **ESTTA983811**

Filing date: **06/27/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | | | |
|---------|---|-------------|----------|
| Name | Barco Uniforms, Inc. | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 350 W. Rosecrans Avenue Gardena, CA 90248 UNITED STATES | | |

| | | | |
|----------------------|--|--|--|
| Attorney information | Jeffrey H. Kaufman Muncy, Geissler, Olds & Lowe, P.C. 4000 Legato Road, Suite 310 Fairfax, VA 22033 UNITED STATES jhk@mg-ip.com 7036493800 | | |
|----------------------|--|--|--|

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 88273297 | Publication date | 05/28/2019 |
| Opposition Filing Date | 06/27/2019 | Opposition Period Ends | 06/27/2019 |
| Applicant | Balco Clo 505 N McClurg Court, APT # 1706 Chicago, IL 60611 UNITED STATES | | |

Goods/Services Affected by Opposition

| |
|--|
| Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Tops; bottoms; t-shirts; shirts; hoodies; jumpers; sweatshirts; sweatpants; track pants; shorts; blouses; suits; waist coats; pants; jeans; dresses; skirts; sweaters; ties; clothing wraps; scarves; foulards; pocket squares; vests; robes; socks; stockings; tights; underwear; swimwear; boas; coats; jackets; raincoat; hoods; belts; suspenders; pajamas; gloves; mittens; earmuffs; sashes; leotards; uniforms; gym suits; body suits; cuffs; muffs; collars; jumpsuits; leg warmers; denim jeans, pants, shorts, shirts and jackets; footwear, except orthopedic footwear; headwear, namely, hats, caps, headbands, sun visors, bandanas and berets |
|--|

Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
|--------------------------------------|----------------------------|

Marks Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|--------|------------------|------------|
| U.S. Registration No. | 872191 | Application Date | 02/05/1968 |
|-----------------------|--------|------------------|------------|

| | | | |
|---------------------|--|-----------------------|------|
| Registration Date | 07/01/1969 | Foreign Priority Date | NONE |
| Word Mark | BARCO | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1930/04/28 First Use In Commerce: 1930/04/28 UNIFORMS, SMOCKS, SHIFTS, AND DRESSES FOR PROFESSIONAL WOMEN SUCH AS NURSES, RESEARCH WORKERS, PHARMACISTS, COSMETOLOGISTS, AND MEDICAL ASSISTANTS | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 897406 | Application Date | 06/25/1969 |
| Registration Date | 08/25/1970 | Foreign Priority Date | NONE |
| Word Mark | BARCO | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1956/07/01 First Use In Commerce: 1956/07/01 UNIFORMS, SMOCKS, SHIFTS, AND DRESSES FOR PROFESSIONAL WOMEN SUCH AS NURSES, RESEARCH WORKERS, PHARMACISTS, COSMETOLOGISTS, MEDICAL ASSISTANTS; AND SHIRT COATS, LAB COATS AND JACKETS FOR PROFESSIONALMEN SUCH AS MEDICAL DOCTORS, INTERNS, RESEARCH WORKERS, MEDICAL ASSISTANTS, PHARMACISTS AND NON-PROFESSIONALS SUCH AS BARBERS | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 871824 | Application Date | 02/05/1968 |
| Registration Date | 06/24/1969 | Foreign Priority Date | NONE |
| Word Mark | MR. BARCO | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1960/06/14 First Use In Commerce: 1960/06/14 SHIRT COATS, LAB COATS AND JACKETS FOR PROFESSIONAL MEN SUCH AS MEDICAL DOCTORS, INTERNS, RESEARCH WORKERS, MEDICAL ASSISTANTS, PHARMACISTS, AND NON-PROFESSIONALS SUCH AS BARBERS | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 5224011 | Application Date | 12/01/2015 |
| Registration Date | 06/13/2017 | Foreign Priority Date | NONE |
| Word Mark | BARCO ONE | | |

| | |
|---------------------|---|
| Design Mark | <h1>BARCO ONE</h1> |
| Description of Mark | NONE |
| Goods/Services | <p>Class 010. First use: First Use: 2016/06/00 First Use In Commerce: 2016/06/00 Medical uniforms, namely, scrubs, scrubtops, and scrub pants, sterilized shirts and sterilized T-shirts used in medical evaluation or treatment; non-sterile medical uniforms used in medical evaluations or treatment, namely, lab coats, lab-jackets, shirts, and t-shirts</p> <p>Class 025. First use: First Use: 2016/06/00 First Use In Commerce: 2016/06/00 Uniforms, tops, shirts, pants, lab coats, and jackets; medical uniforms, not for medical purposes, namely, scrubs, scrub tops, scrub pants, lab coats, jackets, shirts, pants, leggings and T-shirts; non-sterile medical uniforms, not used in medical evaluations or treatment, namely, lab coats, lab jackets, shirts, and t-shirts</p> |

| | |
|-------------|---|
| Attachments | 86835845#TMSN.png(bytes) Notice of Opposition.pdf(186970 bytes) |
|-------------|---|

| | |
|-----------|----------------------|
| Signature | /Jeffrey H. Kaufman/ |
| Name | Jeffrey H. Kaufman |
| Date | 06/27/2019 |

Attorney Docket No.: BARC.US.00045.L

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | | |
|-----------------------|---|------------------------------|
| _____ |) | |
| Barco Uniforms, Inc., |) | |
| |) | |
| Opposer, |) | |
| |) | Opposition No. _____ |
| v. |) | Appln. Serial No. 88/273,297 |
| |) | |
| Balco Clo, |) | Mark: BALCO |
| |) | |
| Applicant. |) | |
| _____ |) | |

NOTICE OF OPPOSITION

Barco Uniforms, Inc., a corporation duly organized and existing under the laws of Delaware, located and doing business at 350 W. Rosecrans Avenue, Gardena, California 90248 (hereinafter "Opposer"), believing that it will be damaged by registration, hereby opposes Application Serial No. 88/273,297, filed January 23, 2019, under the Trademark Act of 1946, in the name of Balco Clo, published for opposition in the *Official Gazette* of May 28, 2019, for the mark BALCO.

The grounds of Opposition are as follows:

1. Opposer, Barco Uniforms, Inc., a corporation duly organized and existing under the laws of Delaware, having its principal place of business at 350 W. Rosecrans Avenue, Gardena, California 90248.

2. Prior to Applicant's filing date, Opposer used, itself and/or through its subsidiaries and/or related companies, and is now using, Opposer's BARCO marks (hereinafter sometimes referred to as "Opposer's Marks") in connection with clothing products which are marketed, distributed, offered and/or sold by Opposer in commerce (hereinafter referred to as "Opposer's Goods").

3. Opposer is the owner of, and will rely herein, upon the following federal trademark registrations:

| <u>MARK</u> | <u>REG. NOS.</u> | <u>ISSUED</u> |
|--------------------|-------------------------|----------------------|
| BARCO | 872,191 | July 1, 1969 |
| BARCO | 897,406 | August 25, 1970 |
| MR. BARCO | 871,824 | June 24, 1969 |
| BARCO ONE | 5,224,011 | June 13, 2017 |

Printed information from the TARR and Assignment electronic databases of the USPTO showing the current status and title of these Registrations is attached as Exhibit(s) A (hereinafter referred to "Opposer's Marks"). These registrations are valid, subsisting, and are *prima facie* evidence of Opposer's exclusive rights to use Opposer's Marks in connection with the goods. Reg. Nos. 871,824, 872,191 and 897,406 have obtained incontestable status.

4. Commencing prior to Applicant's filing date, Opposer, itself and/or through its predecessor(s) in interest, has used Opposer's Marks in connection with Opposer's Goods, which are offered, distributed and sold by Opposer in commerce.

5. Upon information and belief, on January 23, 2019, Applicant filed an application for registration of the alleged BALCO mark for "Tops; bottoms; t-shirts; shirts; hoodies; jumpers; sweatshirts; sweatpants; track pants; shorts; blouses; suits; waist coats; pants; jeans; dresses; skirts; sweaters; ties; clothing wraps; scarves; foulards; pocket squares; vests; robes; socks; stockings; tights; underwear; swimwear; boas; coats; jackets; raincoat; hoods; belts; suspenders; pajamas; gloves; mittens; earmuffs; sashes; leotards; uniforms; gym suits; body suits; cuffs; muffs; collars; jumpsuits; leg warmers; denim jeans, pants, shorts, shirts and jackets; footwear, except orthopedic footwear; headwear, namely, hats, caps, headbands, sun visors, bandanas and berets, in Class 25" (Applicant's Goods). Said application was assigned Serial No. 88/273,297, and was published for Opposition in the Official Gazette of May 28, 2019.

6. Opposer believes and alleges that Applicant's trademark, when applied to Applicant's Goods, is likely to cause confusion or mistake or to deceive the relevant consuming public into believing that Applicant is licensed or controlled by Opposer or that Applicant is a subsidiary of or in some way related to Opposer, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

7. Upon information and belief, Opposer's and Applicant's goods and/or services will be offered and consumed by the same general class of purchasers.

8. Opposer has priority based on its prior use and registration of Opposer's Marks in the United States.

9. Upon information and belief, the *bona fides* of Applicant's intent-to-use the mark is not apparent from materials of record in the subject application, and Opposer therefore challenges same and leaves Applicant to its proofs with regard to the nature and sufficiency of its intent to use at the time of filing Application Serial No. 88/273,297, or at any time thereafter.

10. Opposer, upon information and belief, avers that it will be damaged by the registration by Applicant of the alleged BALCO mark, as set forth in Applicant's Trademark Application Serial No. 88/273,297, in that the mark is confusingly similar to Opposer's Marks and common law rights and will be used in connection with goods and services identical and/or related to the goods and services offered by Opposer.

WHEREFORE, Opposer, Barco Uniforms, Inc. believes and avers that it is being and will continue to be damaged by registration of the BALCO mark as aforesaid, and requests that said Application Serial No. 88/273,297 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed JEFFREY H. KAUFMAN, of the law firm of Muncy, Geissler, Olds & Lowe, P.C., a member of the Bar of the Commonwealth of Virginia, to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

Jeffrey H. Kaufman
Muncy, Geissler, Olds & Lowe, P.C.
4000 Legato Road, Suite 310
Fairfax, Virginia 22033

Correspondence in this proceeding should be addressed to: JEFFREY H. KAUFMAN at the following email addresses: JHK@MG-IP.COM and MAILROOM@MG-IP.COM.

The required fee for this Opposition was paid through ESTTA. The Commissioner is hereby authorized to charge, any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-3828.

Respectfully submitted,

Barco Uniforms, Inc.

/Jeffrey H. Kaufman/

By: Jeffrey H. Kaufman
Muncy, Geissler, Olds & Lowe, P.C.
4000 Legato Road, Suite 310
Fairfax, VA 22033
(703) 649-3800
fax (703) 991-9188
e-mail: *JHK@MG-IP.COM*
Counsel for Opposer

Dated: June 27, 2019

Exhibit A

Generated on: This page was generated by TSDR on 2019-06-27 10:40:53 EDT

Mark: BARCO

US Serial Number: 72290244

Application Filing Date: Feb. 05, 1968

US Registration Number: 872191

Registration Date: Jul. 01, 1969

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Aug. 01, 2018

Mark Information

Mark Literal Elements: BARCO

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US Registrations: 0573305

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: UNIFORMS, SMOCKS, SHIFTS, AND DRESSES FOR PROFESSIONAL WOMEN SUCH AS NURSES, RESEARCH WORKERS, PHARMACISTS, COSMETOLOGISTS, AND MEDICAL ASSISTANTS

International Class(es): 025

U.S Class(es): 039 - Primary Class

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 28, 1930

Use in Commerce: Apr. 28, 1930

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No
Filed 44E: No
Filed 66A: No
Filed No Basis: No

Currently 44E: No
Currently 66A: No
Currently No Basis: No

Current Owner(s) Information

Owner Name: BARCO UNIFORMS, INC.
Owner Address: 350 W. ROSECRANS AVENUE
GARDENA, CALIFORNIA UNITED STATES 90248
Legal Entity Type: CORPORATION
State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: JEFFREY H KAUFMAN
Attorney Primary Email Address: mailroom@mg-ip.com
Docket Number: BARC00001
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JEFFREY H KAUFMAN
Muncy, Geissler, Olds & Lowe, P.C.
4000 Legato Road, Suite 310
Fairfax, VIRGINIA UNITED STATES 22033
Phone: 703-649-3800
Fax: 703-991-9188
Correspondent e-mail: mailroom@mg-ip.com / jhk@mg-ip.com
Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

| Date | Description | Proceeding Number |
|---------------|--|-------------------|
| Aug. 01, 2018 | NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED | |
| Aug. 01, 2018 | REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS) | 76533 |
| Aug. 01, 2018 | REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED | 76533 |
| Jul. 31, 2018 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL | 76533 |
| Jul. 18, 2018 | TEAS SECTION 8 & 9 RECEIVED | |
| Jul. 01, 2018 | COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED | |
| Apr. 04, 2016 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Jan. 20, 2015 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Mar. 09, 2009 | CASE FILE IN TICRS | |
| Sep. 09, 2008 | REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS) | 59807 |
| Sep. 09, 2008 | REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED | |
| Aug. 14, 2008 | REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED | |
| Aug. 14, 2008 | PAPER RECEIVED | |
| Jul. 01, 1989 | REGISTERED AND RENEWED (FIRST RENEWAL - 20 YRS) | |
| Apr. 13, 1989 | REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8 | |

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE
Date in Location: Aug. 01, 2018

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: BARCO OF CALIFORNIA

Assignment 1 of 2

Conveyance: MERGER

Reel/Frame: [2144/0341](#)

Pages: 5

Date Recorded: Sep. 01, 2000

Supporting Documents: [assignment-tm-2144-0341.pdf](#)

Assignor

Name: [BARCO OF CALIFORNIA](#)

Execution Date: Feb. 19, 1999

Legal Entity Type: CORPORATION

State or Country Where Organized: CALIFORNIA

Assignee

Name: [BARCO HOLDING CO., INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 350 W. ROSECRANS AVENUE
GARDENA, CALIFORNIA 92048

Correspondent

Correspondent Name: OBLON, SPIVAK, MCCLELLAN, ET AL.

Correspondent Address: JEFFREY H. KAUFMAN
1755 JEFFERSON DAVID HIGHWAY
FOURTH FLOOR
ARLINGTON, VA 22202

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: CHANGE OF NAME

Reel/Frame: [2144/0383](#)

Pages: 5

Date Recorded: Sep. 01, 2000

Supporting Documents: [assignment-tm-2144-0383.pdf](#)

Assignor

Name: [BARCO HOLDING CO., INC.](#)

Execution Date: Feb. 01, 2000

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Assignee

Name: [BARCO UNIFORMS, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 350 W. ROSECRANS AVENUE
GARDENA, CALIFORNIA 92048

Correspondent

Correspondent Name: OBLON SPIVAK MCCLELLAND MAIER, ET. AL.

Correspondent Address: JEFFREY H. KAUFMAN
ATTORNEYS AT LAW
1755 JEFFERSON DAVIS HIGHWAY, 4TH FLOOR
ARLINGTON, VA 22202

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding [91239046](#)
Number:

Filing Date: Jan 12, 2018

Status: Terminated

Status Date: May 02, 2018

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: Barcos Co., Ltd.

Correspondent Address: TANABE YOSHIHIRO
C/O TANABE PATENT&T
YONEI BULD 180-25
SHIMANE JAPAN , 690-0886

Associated marks

| Mark | Application Status | Serial Number | Registration Number |
|--------|---|--------------------------|---------------------|
| BARCOS | Abandoned - After Inter-Partes Decision | 79219131 | |

Plaintiff(s)

Name: Barco Uniforms, Inc.

Correspondent Address: JEFFREY H KAUFMAN
MUNCY GEISSLER OLDS & LOWE PC
4000 LEGATO RD STE 310
FAIRFAX VA UNITED STATES , 22033

Correspondent e-mail: mailroom@mg-ip.com , jhk@mg-ip.com

Associated marks

| Mark | Application Status | Serial Number | Registration Number |
|----------------------|--|--------------------------|-------------------------|
| BARCO | REGISTERED AND RENEWED | 72290244 | 872191 |
| BARCO | REGISTERED AND RENEWED | 72330897 | 897406 |
| BARCO'S NIGHTINGALES | Section 8 and 15 - Accepted and Acknowledged | 77696762 | 4206247 |
| GRAFX BY BARCO | Cancelled - Section 8 | 77942730 | 4234379 |
| BARCO ONE | Registered | 86835845 | 5224011 |

Prosecution History

| Entry Number | History Text | Date | Due Date |
|--------------|--|--------------|--------------|
| 1 | FILED AND FEE | Jan 12, 2018 | |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jan 19, 2018 | Feb 28, 2018 |
| 3 | PENDING, INSTITUTED | Jan 19, 2018 | |
| 4 | NOTICE OF DEFAULT | Mar 10, 2018 | |
| 5 | BD DECISION: SUSTAINED | May 02, 2018 | |
| 6 | TERMINATED | May 02, 2018 | |

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Mark: BARCO

US Serial Number: 72330897

Application Filing Date: Jun. 25, 1969

US Registration Number: 897406

Registration Date: Aug. 25, 1970

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Mar. 01, 2011

Mark Information

Mark Literal Elements: BARCO

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US Registrations: 0573305

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: UNIFORMS, SMOCKS, SHIFTS, AND DRESSES FOR PROFESSIONAL WOMEN SUCH AS NURSES, RESEARCH WORKERS, PHARMACISTS, COSMETOLOGISTS, MEDICAL ASSISTANTS; AND SHIRT COATS, LAB COATS AND JACKETS FOR PROFESSIONAL MEN SUCH AS MEDICAL DOCTORS, INTERNS, RESEARCH WORKERS, MEDICAL ASSISTANTS, PHARMACISTS AND NON-PROFESSIONALS SUCH AS BARBERS

International Class(es): 025

U.S Class(es): 039 - Primary Class

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 01, 1956

Use in Commerce: Jul. 01, 1956

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: BARCO UNIFORMS, INC.

Owner Address: 350 W. ROSECRANS AVENUE
GARDENA, CALIFORNIA 92048
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: JEFFREY H. KAUFMAN

Docket Number: 177137US

Attorney Primary Email Address: tmddocket@oblon.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JEFFREY H. KAUFMAN
Muncy, Geissler, Olds & Lowe, P.C.
4000 Legato Road, Suite 310
Fairfax, VIRGINIA 22033
UNITED STATES

Phone: 703-649-3800

Fax: 703-991-9188

Correspondent e-mail: mailroom@mg-ip.com jhk@mg-ip.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

| Date | Description | Proceeding Number |
|---------------|--|-------------------|
| Apr. 04, 2016 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Jan. 20, 2015 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Mar. 01, 2011 | REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS) | 68502 |
| Mar. 01, 2011 | REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED | |
| Feb. 26, 2011 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL | 68502 |
| Feb. 25, 2011 | TEAS SECTION 8 & 9 RECEIVED | |
| Nov. 20, 2008 | CASE FILE IN TICRS | |
| Feb. 15, 2001 | REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS) | |
| Feb. 15, 2001 | REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED | |
| Aug. 25, 2000 | REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED | |
| Jun. 25, 1991 | REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS) | |
| Apr. 22, 1991 | AMENDMENT UNDER SECTION 7 - ISSUED | |
| Feb. 22, 1991 | RESPONSE RECEIVED TO POST REG. ACTION | |
| Feb. 11, 1990 | POST REGISTRATION ACTION MAILED - SEC. 7 | |
| Nov. 21, 1990 | SEC 7 REQUEST FILED | |
| Nov. 21, 1990 | REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8 | |
| Nov. 21, 1990 | REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8 | |
| Feb. 28, 1977 | REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK. | |

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Aug. 25, 2010

Change in Yes

Registration:

Amendment to a Registration/Renewal Certificate: IN THE STATEMENT, COLUMN 2, LINES 7 AND 8 ARE DELETED AND THE DRAWING IS AMENDED TO APPEAR AS FOLLOWS:
BARCO

TM Staff and Location Information

TM Staff Information - None
File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Mar. 01, 2011

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: BARCO OF CALIFORNIA

Assignment 1 of 2

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Reel/Frame: [2144/0341](#)

Pages: 5

Date Recorded: Sep. 01, 2000

Supporting Documents: [assignment-tm-2144-0341.pdf](#)

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Execution Date: Feb. 19, 1999

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ARLINGTON, VA 22202

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Pages: 5

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Supporting Documents: [assignment-tm-2144-0383.pdf](#)

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State or Country Where Organized: DELAWARE

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State or Country Where Organized: DELAWARE

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GARDENA, CALIFORNIA 92048

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Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: Barcos Co., Ltd.
Correspondent Address: TANABE YOSHIHIRO
C/O TANABE PATENT&T
YONEI BULD 180-25
SHIMANE , 690-0886
JAPAN

Associated marks

| Mark | Application Status | Serial Number | Registration Number |
|--------|---|--------------------------|---------------------|
| BARCOS | Abandoned - After Inter-Partes Decision | 79219131 | |

Plaintiff(s)

Name: Barco Uniforms, Inc.
Correspondent Address: JEFFREY H KAUFMAN
MUNCY GEISSLER OLDS & LOWE PC
4000 LEGATO RD STE 310
FAIRFAX VA , 22033
UNITED STATES
Correspondent e-mail: mailroom@mg-ip.com , jhk@mg-ip.com

Associated marks

| Mark | Application Status | Serial Number | Registration Number |
|----------------------|--|--------------------------|-------------------------|
| BARCO | REGISTERED AND RENEWED | 72290244 | 872191 |
| BARCO | REGISTERED AND RENEWED | 72330897 | 897406 |
| BARCO'S NIGHTINGALES | Section 8 and 15 - Accepted and Acknowledged | 77696762 | 4206247 |
| GRAFX BY BARCO | Cancelled - Section 8 | 77942730 | 4234379 |
| BARCO ONE | Registered | 86835845 | 5224011 |

Prosecution History

| Entry Number | History Text | Date | Due Date |
|--------------|--|--------------|--------------|
| 1 | FILED AND FEE | Jan 12, 2018 | |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jan 19, 2018 | Feb 28, 2018 |
| 3 | PENDING, INSTITUTED | Jan 19, 2018 | |
| 4 | NOTICE OF DEFAULT | Mar 10, 2018 | |
| 5 | BD DECISION: SUSTAINED | May 02, 2018 | |
| 6 | TERMINATED | May 02, 2018 | |

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Mark: MR. BARCO

US Serial Number: 72290243

Application Filing Date: Feb. 05, 1968

US Registration Number: 871824

Registration Date: Jun. 24, 1969

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Sep. 09, 2008

Mark Information

Mark Literal Elements: MR. BARCO

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US Registrations: 0573305

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: SHIRT COATS, LAB COATS AND JACKETS FOR PROFESSIONAL MEN SUCH AS MEDICAL DOCTORS, INTERNS, RESEARCH WORKERS, MEDICAL ASSISTANTS, PHARMACISTS, AND NON-PROFESSIONALS SUCH AS BARBERS

International Class(es): 025

U.S Class(es): 039 - Primary Class

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 14, 1960

Use in Commerce: Jun. 14, 1960

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No
Filed 44E: No
Filed 66A: No
Filed No Basis: No

Currently 44E: No
Currently 66A: No
Currently No Basis: No

Current Owner(s) Information

Owner Name: BARCO UNIFORMS, INC.
Owner Address: 350 W. ROSECRANS AVENUE
GARDENA, CALIFORNIA UNITED STATES 90248
Legal Entity Type: CORPORATION
State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: JEFFREY H KAUFMAN
Attorney Primary Email Address: mailroom@mg-ip.com
Docket Number: BARC00003
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JEFFREY H KAUFMAN
Muncy, Geissler, Olds & Lowe, P.C.
4000 Legato Road, Suite 310
Fairfax, VIRGINIA UNITED STATES 22033
Phone: 703-649-3800
Fax: 703-991-9188
Correspondent e-mail: mailroom@mg-ip.com / jhk@mg-ip.com
Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

| Date | Description | Proceeding Number |
|---------------|--|-------------------|
| Jun. 25, 2019 | TEAS SECTION 8 & 9 RECEIVED | |
| Jun. 24, 2018 | COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED | |
| Apr. 04, 2016 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Jan. 20, 2015 | TEAS CHANGE OF CORRESPONDENCE RECEIVED | |
| Mar. 09, 2009 | CASE FILE IN TICRS | |
| Sep. 09, 2008 | REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS) | 59807 |
| Sep. 09, 2008 | REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED | |
| Aug. 29, 2008 | ASSIGNED TO PARALEGAL | 59807 |
| Aug. 14, 2008 | REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED | |
| Aug. 14, 2008 | PAPER RECEIVED | |
| Jun. 24, 1989 | REGISTERED AND RENEWED (FIRST RENEWAL - 20 YRS) | |
| Feb. 22, 1989 | REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8 | |

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: SCANNING ON DEMAND
Date in Location: Mar. 09, 2009

Assignment Abstract Of Title Information

Summary

Total Assignments: 2
Registrant: BARCO OF CALIFORNIA

Assignment 1 of 2

Conveyance: MERGER

Reel/Frame: [2144/0341](#)

Pages: 5

Date Recorded: Sep. 01, 2000

Supporting Documents: [assignment-tm-2144-0341.pdf](#)

Assignor

Name: [BARCO OF CALIFORNIA](#)
Legal Entity Type: CORPORATION
Execution Date: Feb. 19, 1999
State or Country Where Organized: CALIFORNIA

Assignee

Name: [BARCO HOLDING CO., INC.](#)
Legal Entity Type: CORPORATION
State or Country Where Organized: DELAWARE
Address: 350 W. ROSECRANS AVENUE
GARDENA, CALIFORNIA 92048

Correspondent

Correspondent Name: OBLON, SPIVAK, MCCLELLAN, ET AL.
Correspondent Address: JEFFREY H. KAUFMAN
1755 JEFFERSON DAVID HIGHWAY
FOURTH FLOOR
ARLINGTON, VA 22202

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: CHANGE OF NAME

Reel/Frame: [2144/0383](#)

Pages: 5

Date Recorded: Sep. 01, 2000

Supporting Documents: [assignment-tm-2144-0383.pdf](#)

Assignor

Name: [BARCO HOLDING CO., INC.](#)
Legal Entity Type: CORPORATION
Execution Date: Feb. 01, 2000
State or Country Where Organized: DELAWARE

Assignee

Name: [BARCO UNIFORMS, INC.](#)
Legal Entity Type: CORPORATION
State or Country Where Organized: DELAWARE
Address: 350 W. ROSECRANS AVENUE
GARDENA, CALIFORNIA 92048

Correspondent

Correspondent Name: OBLON SPIVAK MCCLELLAND MAIER, ET. AL.
Correspondent Address: JEFFREY H. KAUFMAN
ATTORNEYS AT LAW
1755 JEFFERSON DAVIS HIGHWAY, 4TH FLOOR
ARLINGTON, VA 22202

Domestic Representative - Not Found

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Mark: BARCO ONE

BARCO ONE

US Serial Number: 86835845

Application Filing Date: Dec. 01, 2015

US Registration Number: 5224011

Registration Date: Jun. 13, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jun. 13, 2017

Publication Date: Sep. 27, 2016

Notice of Allowance Date: Nov. 22, 2016

Mark Information

Mark Literal Elements: BARCO ONE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Translation: The English translation of the word "BARCO" in the mark is "boat".

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Uniforms, tops, shirts, pants, lab coats, and jackets; medical uniforms, not for medical purposes, namely, scrubs, scrub tops, scrub pants, lab coats, jackets, shirts, pants, leggings and T-shirts; non-sterile medical uniforms, not used in medical evaluations or treatment, namely, lab coats, lab jackets, shirts, and t-shirts

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 2016

Use in Commerce: Jun. 2016

For: Medical uniforms, namely, scrubs, scrub tops, and scrub pants, sterilized shirts and sterilized T-shirts used in medical evaluation or treatment; non-sterile medical uniforms used in medical evaluations or treatment, namely, lab coats, lab jackets, shirts, and t-shirts

International Class(es): 010 - Primary Class

U.S Class(es): 026, 039, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 2016

Use in Commerce: Jun. 2016

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Barco Uniforms, Inc.

Owner Address: 350 W. Rosecrans Avenue
Gardena, CALIFORNIA 90248
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jeffrey H. Kaufman

Docket Number: 463778US33

Attorney Primary Email Address: tmocket@oblon.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JEFFREY H. KAUFMAN
Muncy, Geissler, Olds & Lowe, P.C.
4000 Legato Road, Suite 310
Fairfax, VIRGINIA 22033
UNITED STATES

Phone: 703-649-3800

Fax: 703-991-9188

Correspondent e-mail: mailroom@mg-ip.com jhk@mg-ip.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

| Date | Description | Proceeding Number |
|---------------|--|-------------------|
| Jun. 13, 2017 | REGISTERED-PRINCIPAL REGISTER | |
| May 10, 2017 | NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED | |
| May 09, 2017 | ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED | |
| May 08, 2017 | STATEMENT OF USE PROCESSING COMPLETE | 71906 |
| Apr. 12, 2017 | USE AMENDMENT FILED | 71906 |
| May 04, 2017 | CASE ASSIGNED TO INTENT TO USE PARALEGAL | 71906 |
| Apr. 12, 2017 | TEAS STATEMENT OF USE RECEIVED | |
| Nov. 22, 2016 | NOA E-MAILED - SOU REQUIRED FROM APPLICANT | |
| Sep. 27, 2016 | OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED | |
| Sep. 27, 2016 | PUBLISHED FOR OPPOSITION | |
| Sep. 07, 2016 | NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED | |
| Aug. 25, 2016 | LAW OFFICE PUBLICATION REVIEW COMPLETED | 68171 |
| Aug. 25, 2016 | APPROVED FOR PUB - PRINCIPAL REGISTER | |
| Aug. 24, 2016 | EXAMINER'S AMENDMENT ENTERED | 88888 |
| Aug. 24, 2016 | NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED | 6328 |
| Aug. 24, 2016 | EXAMINERS AMENDMENT E-MAILED | 6328 |
| Aug. 24, 2016 | EXAMINERS AMENDMENT -WRITTEN | 92456 |
| Aug. 04, 2016 | TEAS/EMAIL CORRESPONDENCE ENTERED | 68171 |
| Aug. 04, 2016 | CORRESPONDENCE RECEIVED IN LAW OFFICE | 68171 |
| Jul. 28, 2016 | ASSIGNED TO LIE | 68171 |
| Jul. 21, 2016 | TEAS RESPONSE TO OFFICE ACTION RECEIVED | |
| Mar. 19, 2016 | NOTIFICATION OF NON-FINAL ACTION E-MAILED | 6325 |
| Mar. 19, 2016 | NON-FINAL ACTION E-MAILED | 6325 |
| Mar. 19, 2016 | NON-FINAL ACTION WRITTEN | 92456 |
| Mar. 19, 2016 | ASSIGNED TO EXAMINER | 92456 |

Jan. 29, 2016 TEAS CHANGE OF CORRESPONDENCE RECEIVED
 Dec. 05, 2015 NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM
 Dec. 04, 2015 NEW APPLICATION ENTERED IN TRAM

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: May 09, 2017

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91239046](#)

Filing Date: Jan 12, 2018

Status: Terminated

Status Date: May 02, 2018

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: Barcos Co., Ltd.

Correspondent Address: TANABE YOSHIHIRO
 C/O TANABE PATENT&T
 YONEI BULD 180-25
 SHIMANE , 690-0886
 JAPAN

Associated marks

| Mark | Application Status | Serial Number | Registration Number |
|--------|---|--------------------------|---------------------|
| BARCOS | Abandoned - After Inter-Partes Decision | 79219131 | |

Plaintiff(s)

Name: Barco Uniforms, Inc.

Correspondent Address: JEFFREY H KAUFMAN
 MUNCY GEISSLER OLDS & LOWE PC
 4000 LEGATO RD STE 310
 FAIRFAX VA , 22033
 UNITED STATES

Correspondent e-mail: mailroom@mg-ip.com , jhk@mg-ip.com

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| BARCO | REGISTERED AND RENEWED | 72330897 | 897406 |
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| GRAFXY BY BARCO | Cancelled - Section 8 | 77942730 | 4234379 |
| BARCO ONE | Registered | 86835845 | 5224011 |

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| 3 | PENDING, INSTITUTED | Jan 19, 2018 | |
| 4 | NOTICE OF DEFAULT | Mar 10, 2018 | |
| 5 | BD DECISION: SUSTAINED | May 02, 2018 | |
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