

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Baxley

Mailed: August 6, 2008

Opposition No. **91169231**

Barbara J. Schell M.D. PLLC

v.

Graham D. Simpson

Andrew P. Baxley, Interlocutory Attorney:

Graham D. Simpson ("applicant") filed an intent-to-use application to register the mark THE AGELESS-ZONE in standard character form for "exercise consulting services" in International Class 41 and "spa services, namely, massage, mesotherapy, detoxification therapy, body wraps, body scrubs, exfoliating scrubs; salon services, namely, pedicures, manicures, facials, hair styling and cutting, skin treatment, and skin tanning; medical services, namely laser cosmetic surgery and injecting tissue augmenting gels, facial fillers, and pharmaceutical preparations for treating wrinkles, muscle dystonias, headaches, and spasms; nutrition counseling" in International Class 44.<sup>1</sup>

Barbara J. Schell M.D. PLLC ("opposer") has opposed registration of applicant's mark in International Class 44

---

<sup>1</sup> Application Serial No. 76619613, filed November 8, 2004 based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

Opposition No. 91169231

only on the ground of likelihood of confusion with its previously used marks AGELESS, AGELESS.COM, and AGELESSINSEATTLE.COM for use in connection with "services including but not limited to massage, mesotherapy, detoxification therapy, body wraps, body scrubs, exfoliating scrubs, facials, skin treatment, laser cosmetic surgery and injecting tissue augmenting gels, facial fillers, pharmaceutical preparations for treating wrinkles, muscle disastonias, headaches and spasms, cosmetic and medical treatments and procedures related to, and not limited to, anti-aging treatments, nutritional and dietary supplementation, medical and cosmetic lasters, light based systems, radio frequency treatments, surgical and non-surgical medical and cosmetic treatments for health, well-being, age related issues, face, body, mind and spirit rejuvenation. Applicant denied the salient allegations of the notice of opposition in his answer.

On July 11, 2008, opposer filed a copy of applicant's proposed amendment to his involved intent-to use application Serial No. 76619613 and a copy of the parties' "trademark usage agreement." Although the proposed amendment does not expressly state that opposer consents thereto, a review of the agreement indicates that such amendment is pursuant thereto. Accordingly, the Board will consider the proposed

amendment at this time. See TBMP Section 514.03 (2d ed. rev. 2004).

By the proposed amendment, applicant seeks to add the following statement: "For spa services in International Class 44, Applicant expressly agrees that Applicant shall not use the mark ... in the states of Washington, Oregon, Idaho, Montana, Wyoming and Alaska." Accordingly, the proposed geographic restriction applies only to the services in International Class 44 that are identified as "spa services, namely, massage, mesotherapy, detoxification therapy, body wraps, body scrubs, [and] exfoliating scrubs." By the proposed amendment, the application would remain geographically unrestricted as to the recited services in International Class 41, i.e., "exercise consulting services" and the remaining recited services in International Class 44, i.e., "salon services, namely, pedicures, manicures, facials, hair styling and cutting, skin treatment, and skin tanning; medical services, namely laser cosmetic surgery and injecting tissue augmenting gels, facial fillers, and pharmaceutical preparations for treating wrinkles, muscle dystonias, headaches, and spasms; nutrition counseling."

However, an application, such as applicant's, which is based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), cannot be amended to a concurrent use

application.<sup>2</sup> See Trademark Rule 2.73(b) and 2.99(g); TMEP Section 1207.04(b) (5<sup>th</sup> ed. 2007). In addition, the Board cannot consider geographic limitations in this opposition proceeding and can only consider such limitations in a concurrent use proceeding.<sup>3</sup> See Trademark Rule 2.133(b); TBMP Section 514.03 (2d ed. rev. 2004).

Further, the proposed amendment does not comply with certain requirements for concurrent use applications that are set forth in TMEP Section 1207.04(d)(i) (5<sup>th</sup> ed. 2007). In particular, applicant has not: (1) set forth his mode of use; (2) specified, to the extent of his knowledge, the exceptions to his claim of exclusive use, listing any concurrent use by others and the relevant goods, geographic areas and periods of this use; (3) listed the names and addresses of the concurrent users, the registrations issued to or applications filed by them (if any), and the mode of such use; and (4) modified the verification in support of the application to indicate an exception, that no one else *except as specified in the application* has the right to use

---

<sup>2</sup> Applicant cannot file either an amendment to allege use or a statement of use while the above-captioned proceeding is pending. See Trademark Rule 2.77.

<sup>3</sup> Applicant is not prohibited from pursuing an application that is geographically unrestricted as to some goods and geographically restricted as to others. See TMEP Section 1207.04(d)(i)(1). However, the better practice would be to divide the application into separate geographically unrestricted and concurrent use applications.

the mark. See Trademark Act Sections (a)(3)(D) and 2(d); Trademark Rules 2.42.

The Board notes in addition that the proposed geographic restriction set forth in applicant's application is inconsistent with the parties' trademark usage agreement. In that agreement, applicant agrees to amend the application to add a geographic limitation with regard to "spa and medical services ... in International Class 44," whereas, in the proposed amendment, the geographic restriction applies only to "spa services." Trademark Usage Agreement at paragraph 20; proposed amendment at page 2. Based on the foregoing, the proposed amendment is unacceptable.

In addition, a review of the parties' agreement indicates that the parties may intend to convert this proceeding to a concurrent use proceeding.<sup>4</sup> See TBMP Section 1113.01 (2d ed. rev. 2004). In particular, the parties have agreed to resolve this proceeding by agreeing to allow each party "to continue using its trademarks and tradenames in limited non-overlapping geographic territories." Trademark Usage Agreement at paragraph 16. However, while the agreement states that applicant will not use his mark in connection with spa and medical services "in the states of Washington, Oregon, Idaho, Montana, Wyoming

---

<sup>4</sup> However, no concurrent use proceeding can be instituted until this proceeding is dismissed and applicant files a statement of use in the involved application following such dismissal.

and Alaska," the agreement includes no express geographic restriction on opposer's use of its affected marks.

An applicant seeking a concurrent use registration must make a *prima facie* showing that confusion is not likely to result from the concurrent use by applicant and others. That is, the burden of proof in a concurrent use proceeding is upon the applicant(s) seeking concurrent use registrations to establish facts which would show that there is no likelihood of confusion arising from their concurrent use of similar marks in their respective geographical areas. See *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970); and *Handy Spot, Inc. v. J.D. Williams Company, Inc.*, 181 USPQ 351 (TTAB 1974). A party is not entitled to a concurrent use registration unless the "touchstone" requirement of no likelihood of confusion is met. *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987). Because the agreement between the parties does not specify any geographic restriction on opposer's use of its affected marks, the agreement would not constitute a *prima facie* showing that confusion is not likely to result from the concurrent use of the marks at issue by applicant and others and therefore of applicant's entitlement to a concurrent use registration.

The parties are allowed until sixty days from the mailing date set forth in the caption of this order to file

Opposition No. 91169231

a revised trademark use agreement in accordance with the foregoing.<sup>5</sup> Proceedings herein are otherwise suspended.

---

<sup>5</sup> As noted earlier in this order, applicant cannot amend the involved application to one for a concurrent use registration until this proceeding is dismissed and applicant files a statement of use.