

*Terminated
Dismissed
w/ prejudice*

TTAB

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11-15-1999

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

U.S. Patent & TMO/TM Mail Rcpt Dt. #54

-----X	
STEVEN LINK,	:
dba DR. ROOF	:
	:
Petitioner	:
	:
v.	:
	:
DR.ROOF, INC.,	:
	:
Registrant	:
-----X	

Cancellation No. 23, 626

#24

**MOTION FOR SUSPENSION OF CANCELLATION PROCEEDING
PENDING INSTITUTION OF CONCURRENT USE PROCEEDING.**

On February 22, 1995, the Petitioner Steven M. Link filed an application to register DR. ROOF in the U.S. Patent and Trademark Office. At approximately the same time, the Petitioner filed the captioned Petition for Cancellation against prior U.S. Reg. No. 1,578,137.

The Petition for Cancellation was instituted, an answer was filed and discovery dates were set. Thereafter, the Petitioner and the Registrant reached an Agreement limiting the territory of both parties so as to avoid a likelihood of confusion.

The Petitioner is also the Applicant of pending App. No. 74/637,996 for the mark DR. ROOF AND DESIGN for home maintenance, construction and repair services. The Petitioner/Applicant has now filed with the PTO a "Request To Convert Application To Concurrent Use Application". A copy of the Request is annexed hereto as Exhibit "A". Annexed to the Exhibit "A" request is a copy of the agreement between the parties in the captioned proceeding (i.e., exhibit 1 to the Request).



08-30-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #72

The agreement between the parties expressly limits their trademark/service mark rights on a geographically basis so as to avoid any overlap-see paragraphs three (3) and four (4) of the agreement.

The parties also agreed not to advertise or use their respective marks in the other's territory-see paragraphs five (5) and six (6). The parties further agree not to use their respective mark in the other's territory-see paragraphs seven (7) and eight (8).

The Registrant has specifically consented to the granting of a concurrent registration to Petitioner and consented to an amendment to Registrant's U.S. Reg. No. 1,578,137 to exclude the Petitioner's territory-see paragraphs nine (9) and ten (10).

It is respectively requested that the captioned proceedings be suspended pending formal institution of a concurrent use proceeding based upon Petitioner's converted concurrent use application.

Respectfully submitted,

BAKER & FRIEDMAN

By _____

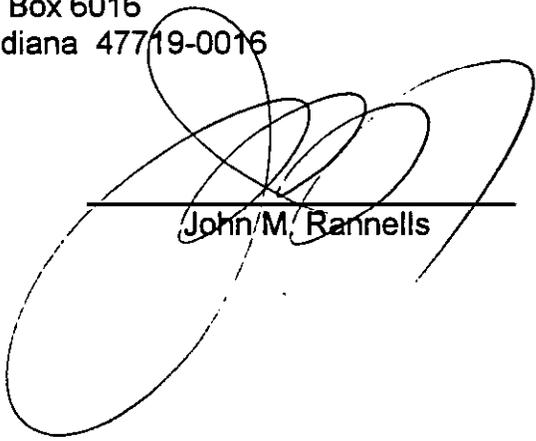
John M. Rabnells
Attorney for Petitioner
359 East Main Street
Somerville, NJ 08876
908-722-5640

November 11, 1999

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing MOTION FOR SUSPENSION OF CANCELLATION PROCEEDING PENDING INSTITUTION OF CONCURRENT USE PROCEEDING, in re Steven Link, dba Dr. Roof v. Dr. Roof, Inc., Can. No. 23,626, was forwarded by first class postage pre-paid mail this 11th day of November, 1999 to the attorney for Registrant at this following address:

Johnson, Carroll and Griffith
Attn: Gary K. Price, Esq.
2230 West Franklin St.
P.O. Box 6016
Evansville, Indiana 47719-0016



John M. Rannells

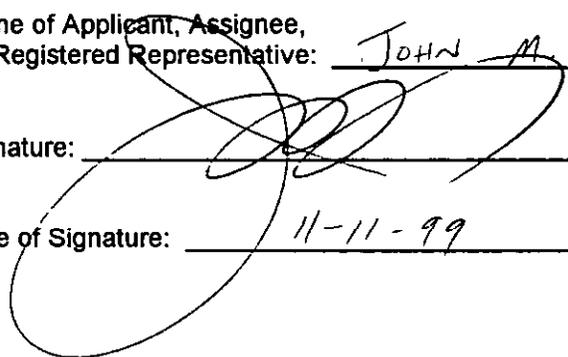
Dated: November 11, 1999

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202

Date of deposit: 11-11-99

Name of Applicant, Assignee,
or Registered Representative: JOHN M. RANWELLS

Signature: 

Date of Signature: 11-11-99



EXH A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK LAW OFFICE 102
SERIAL NUMBER: 74/637996
MARK: DR. ROOF AND DESIGN

APPLICANT: Steven M. Link
FILED: February 22, 1995

Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Attn: Cheryl S. Goodman, Trademark Examining Attorney, Law Office 102

REQUEST TO CONVERT APPLICATION TO CONCURRENT USE APPLICATION

Prosecution of the above referenced application has been suspended pending the outcome of Cancellation No. 23626 which cancellation proceeding concerns registration no. 1,578,137 which registration is the basis of the Examiner's 2(d) rejection. The parties to the cancellation proceeding have entered into an agreement providing for concurrent use of their respective marks in distinct geographical areas. A copy of the agreement is annexed hereto as Exhibit 1.

The geographical area in which Applicant now seeks registration is limited as follows: Maine, Vermont, New Hampshire, Massachusetts, Rhode Island, New York, Connecticut, and Pennsylvania east of Interstate Highway 81, New Jersey, and Delaware ("Applicant's Territory"). [See exhibit 1, paragraph 4].

The exception to the Applicant's right to exclusive use is by Ballast Revocable Living Trust, the service mark assignee of DR. ROOF, INC. and owner of U.S. Reg. No. 1,578,137, located and doing business at 951 S. Rotherwood Avenue, Evansville, IN 47714, who has agreed to limit its use of the mark DR. ROOF, for commercial and residential roof repair services, in the states of Pennsylvania west of Interstate Highway 81, West Virginia, Ohio, Maryland, Virginia, North Carolina, South Carolina, Michigan, Indiana, Kentucky, Tennessee, Alabama, Georgia, Florida, Wisconsin, Illinois, Mississippi, Louisiana, Arkansas, Missouri, Iowa, Minnesota, North Dakota, South Dakota, Nebraska, Kansas, Oklahoma, Texas, New Mexico, Colorado, Wyoming, Montana, Idaho, Utah, Arizona, Nevada, Washington, Oregon, California, Alaska, Hawaii, Guam, Puerto Rico, the U.S. Virgin Islands, and the District of Columbia ("Registrant's Territory"). [See exhibit 1, paragraph 3].

As stated and provided in the accompanying agreement, the parties have agreed not to use or advertise their services under their respective marks in the other's territory. [See exhibit 1, paragraphs 5 and 6].

The agreement further contains an express consent by the Registrant, Ballast Revocable Living Trust, the service mark assignee of DR. ROOF, INC. and owner of U.S. Reg. No. 1,578,137, to the grant of a concurrent registration issued to Applicant for the territories set forth in Applicant's Territory. [See exhibit 1, paragraph 9]. Said registrant has also consented to the amendment of its Reg. No. 1,578,137 to exclude Applicant's Territory. [See exhibit 1, paragraph 10].

The agreement between the above parties is binding on their respective assigns, successors-in-interest and subsidiaries, direct or indirect. [See exhibit 1, paragraph 12].

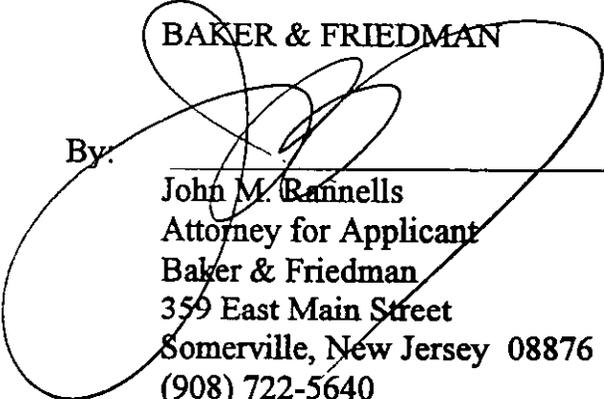
Immediately following the filing of this letter request, Applicant shall move before the Board, in Cancellation No. 23,626, to convert the cancellation proceeding to a concurrent use proceeding.

Accordingly, Applicant requests that its pending application, (App. Ser. No. 74/637,996), now be converted to a concurrent use application. Favorable consideration is thought to be in order.

Dated: November 11, 1999

Respectfully submitted,

BAKER & FRIEDMAN

By: 

John M. Bannells
Attorney for Applicant
Baker & Friedman
359 East Main Street
Somerville, New Jersey 08876
(908) 722-5640
Fax (908) 725-7088



EXH 1

AGREEMENT

This Agreement is entered into this _____ day of November, 1997, between Steven Link d/b/a DR. ROOF, a citizen of the U.S.A., doing business at 108 Thompson Street, Raritan, NJ 08869, referred to herein as "Petitioner", and BALLAST REVOCABLE LIVING TRUST, the service mark assignee of DR. ROOF, Inc., a corporation of Indiana with offices at 951 S. Rotherwood Avenue, Evansville, IN 47714, referred to herein as "Registrant".

R E C I T A L S

A. Petitioner asserts that he is the owner of the tradename and service mark DR. ROOF for home maintenance, construction and repairs. Petitioner has filed an application to register DR. ROOF and design for home maintenance, construction and repair in International Class 42, as follows:

PENDING APPLICATION

<u>MARK</u>	<u>SER.NO.</u>	<u>FILED</u>
DR. ROOF and design	74/637,986	February 22, 1995

B. Registrant has registered the mark DR. ROOF, Reg. No. 1,578,137, dated January 16, 1990, for commercial and residential roof repair services. Said registration is the subject of a cancellation proceeding initiated by Petitioner.

C. Petitioner has applied to register the mark DR. ROOF and design, Serial No. 74/637,996, filed February 22, 1995, for home maintenance, construction and repair services. The application has been rejected on DR. ROOF Reg. No. 1,578,137.

D. Petitioner and Registrant wish to resolve any dispute as may exist between them concerning the validity of

their respective marks and their respective right to use the same, and to facilitate the registration to Petitioner of the mark DR. ROOF and design for home maintenance, construction and repair, and to further facilitate the continued registration to Registrant of the mark DR. ROOF for commercial and residential roof repair services.

E. This agreement is expressly contingent upon the withdrawal by the U.S. Patent and Trademark Office of Registrant's registration as an obstruction to Petitioner's application for DR. ROOF and design for home maintenance, construction and repair. In the event the Registrant's registration is not ultimately withdrawn by the U.S. Patent and Trademark Office either during the prosecution of DR. ROOF and design application or as a result of an appeal from a final rejection based on the Registrant's registration, this agreement shall be considered null and void at the instance of Petitioner.

IN CONSIDERATION of all the foregoing expressed recitals and the mutual recitals contained herein, the parties agree as follows:

1. Petitioner shall take no action adverse to the Registrant's registration, or any right upon which the same is based, or to use the wordmark DR. ROOF in Registrant's Territory and Petitioner agrees to a dismissal of cancellation 23,626 with prejudice.

2. Registrant shall not oppose the DR. ROOF and design application identified above, or any concurrent use application filed by Petitioner which includes the wording "DR. ROOF" and which specifically excludes the Registrant's territory as set forth hereinafter. Registrant shall take no action adverse to

Petitioner's rights upon which its application is based.

3. Registrant agrees to limit its use of the mark DR. ROOF on any goods or services to the states of Pennsylvania west of Interstate Highway 81, West Virginia, Ohio, Maryland, Virginia, North Carolina, South Carolina, Michigan, Indiana, Kentucky, Tennessee, Alabama, Georgia, Florida, Wisconsin, Illinois, Mississippi, Louisiana, Arkansas, Missouri, Iowa, Minnesota, North Dakota, South Dakota, Nebraska, Kansas, Oklahoma, Texas, New Mexico, Colorado, Wyoming, Montana, Idaho, Utah, Arizona, Nevada, Washington, Oregon, California, Alaska, Hawaii, Guam, Puerto Rico, the U.S. Virgin Islands, and the District of Columbia (hereinafter "Registrant's Territory").

4. Petitioner agrees to limit its use of the mark DR. ROOF and design on any goods or services in the states of Maine, Vermont, New Hampshire, Massachusetts, Rhode Island, New York, Connecticut, and Pennsylvania east of Interstate Highway 81, New Jersey, and Delaware (hereinafter "Petitioner's Territory")

5. Petitioner agrees not to use or advertise the mark DR. ROOF and design, as shown in Application No. 74/637,996, or any mark confusingly similar to DR. ROOF, in Registrant's Territory.

6. Registrant agrees not to use or advertise the mark DR. ROOF, as shown in Reg. No. 1,578,137, or any confusingly similar mark, in Petitioner's Territory.

7. Petitioner consents to the use by Registrant of the mark DR. ROOF, as shown in Reg. No. 1,578,137, except in Petitioner's Territory.

8. Registrant consents to the use by Petitioner of the mark DR. ROOF and design, as shown in Application No. 74/637,996, and the word mark "DR. ROOF", in Petitioner's Territory.

9. Registrant consents to the grant by the United States Patent and Trademark Office to Petitioner of a concurrent registration limited to Petitioner's Territory for the mark DR. ROOF and design, as shown in Application No. 74/637,996.

10. Registrant consents to the amendment by the United States Patent and Trademark Office of Reg. No. 1,578,137 to exclude Petitioner's Territory, if a concurrent registration limited to Petitioner's Territory is granted by the United States Patent and Trademark Office to Petitioner for the mark DR. ROOF and design, as shown in Application No. 74/637,996, for home maintenance, construction and repair services and/or commercial and residential roof repair services and/or closely related services.

11. Either Registrant or Petitioner may file a copy of this Agreement in the United States Patent and Trademark Office in connection with Cancellation No. 23,626, Reg. No. 1,578,137, Application No. 74/637,996, or any other matter.

12. This Agreement shall be binding on the assigns, successors-in-interest and subsidiaries, direct or indirect, of both parties.

13. This Agreement shall be governed by the laws of the State of New Jersey without regard to conflicts of laws, and principles.

14. Any dispute regarding this agreement, including its validity, interpretation, performance or breach, shall be submitted to binding arbitration under the rules of the American Arbitration Association and the laws of the States of New York. Any notice or other communication given pursuant to this agreement shall be in writing and shall be deemed to have been

given on the earlier of (1) receipt or (2) five days after notice was sent to the receiving party at the following addresses or to such other addresses or telecopier numbers as such parties shall from time to time have specified in the manner indicated in this Section.

To: Steven Link
d/b/a DR. ROOF
108 Thompson Street
Raritan, NJ 08869

With a copy to: BAKER & FRIEDMAN
Attn: Stephen L. Baker
359 E. Main Street
Somerville, NJ 08876
fax: 908-725-7088
tel: 908-722-5640

To: BALLAST REVOCABLE LIVING TRUST
951 S. Rotherwood Avenue
Eveansville, IN 47714

With a copy to: Johnson, Carroll & Griffith
2230 West Franklin Street
P. O. Box 6016
Evansville, IN 47719-6016
fax: 812-425-4233
tel: 812-425-4466

15. The failure of either party to enforce any provision of this Agreement shall not be construed as a waiver of such provision or of the right of the party to thereafter enforce such provision.

16. This Agreement may not be amended except by a writing signed by the parties hereto. There are no understandings, agreements or representations, express or implied, not specified herein.

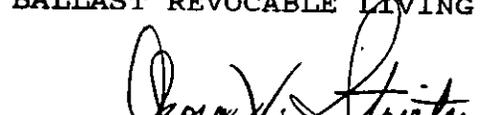
IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed on the date first written above.

Steven Link, d/b/a DR. ROOF

BALLAST REVOCABLE LIVING TRUST


Name: Steven Link

Title: *owner DR. ROOF*


Name: George V. Strieter

Title: Trustee

doc:dr.roof/agreements

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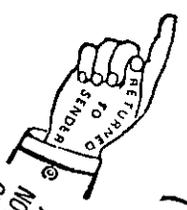
Stephen L Baker

7608

O. Friedman

Somer

in Street
NJ 08876



UNDELIVERABLE
AS ADDRESSED
NO FORWARDING
ORDER ON FILE