

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513**

Mailed: March 30, 2004

Concurrent Use No. 94001212

Sisters of Saint Francis
Health Services, Inc.,
substituted as party plaintiff
by assignment from Saint
Margaret Mercy Healthcare
Centers, Inc.¹

v.

Prime Advantage, Inc.

Peter Cataldo, Interlocutory Attorney

On August 8, 2001, the Board issued an order dismissing without prejudice Opposition No. 91114165, involving the parties herein, and instituting the instant concurrent use proceeding.² In addition, the Board suspended this concurrent use proceeding pending the publication of applicant's concurrent use application Serial No. 75803859,

¹ Evidence thereof is recorded with the Assignment Branch of this Office at Reel 2453, Frame 0655.

² The August 8, 2001 order identified the opposition as Opposition No. 114,165 and the concurrent use proceeding as Concurrent Use No. 1212.

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so that its application could be made part of this proceeding so long as no opposition was filed, or all oppositions filed were dismissed.

On March 26, 2003, applicant filed a motion to amend its application Serial No. 75803859 to seek a geographically unrestricted registration and to terminate the instant concurrent use proceeding.³ In support of its motion, applicant asserts that applicant and Prime Advantage, Inc., the sole excepted user herein, have entered into a settlement agreement; that under the terms of the settlement agreement, the excepted user sold, assigned and transferred to applicant the service mark PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS and application Serial No. 75460711, along with all rights, title and interest in that mark, together with all goodwill associated therewith, and any and all registration(s) that may issue therefrom; that the excepted user has further agreed to cease all use of the PRIME ADVANTAGE EXPERIENCE HAS ITS REWARDS mark; and that, in consequence thereof, the instant concurrent use proceeding is rendered moot.

However, applicant does not indicate its intentions for the disposition of concurrent use application Serial No.

³ It is noted that concurrent use application Serial No. 75803859 was published for opposition on September 18, 2001. Office records indicate that no notice of opposition to the registration of concurrent use application Serial No. 75803859 was filed during the opposition period.

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75460711, acquired from excepted user by assignment. It is noted that in accordance with the parties' September 30, 1999 motion in Opposition No. 91114165, the Board geographically restricted application Serial No. 75460711 to the territory encompassing the entire United States with the exception of the states of Illinois, Indiana, and Michigan. Application Serial No. 75460711 thus is a concurrent use application, and the instant concurrent use proceeding may not be dissolved while that application is subject to the stated geographic limitation.

In view thereof, applicant is allowed until thirty days from the mailing date hereof in which to either abandon application Serial No. 75460711 or file a motion to seek a geographically unrestricted registration therefor, failing which, the instant concurrent use proceeding will be continued.

Proceedings herein are otherwise suspended.

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