

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

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Mailed: November 1, 2004

Concurrent Use No. 94001229

Stavan Center L.P.

v.

Woodbury Village Shopping  
Center Limited Partnership<sup>1</sup>

Before Simms, Hairston and Walters, Administrative Trademark  
Judges.

By the Board:

On June 27, 2002, the Board instituted this concurrent  
use proceeding involving Stavan Center L.P.'s ("Stavan")  
concurrent use application Serial No. 75639673<sup>2</sup> for the  
following mark (shown in reduced form):



WOODBURY VILLAGE

for "shopping center services" in International Class 36.

The Board also noted that Woodbury Village Shopping Center

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<sup>1</sup> Pursuant to Trademark Rule 2.99(e), the caption for this  
proceeding has been reversed from the caption appearing in the  
Board's June 27, 2002 order.

<sup>2</sup> Application Serial No. 75639673 was filed on February 11, 1999  
and claims first use and first use in commerce in November 1997.

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Limited Partnership ("Woodbury") filed concurrent use application Serial No. 76121917<sup>3</sup> for the mark "WOODBURY VILLAGE" (in typed form) for "leasing shopping space to retail shopping facilities, leasing office space to commercial business offices and leasing restaurant space to restaurants, none of the foregoing relating to outlet shopping centers" in International Class 36; and that the application had not yet been received by the Board.

Further, the Board suspended proceedings pending receipt by the Board of application Serial No. 75121917, noting that if appropriate when proceedings are resumed, the Board would add, inter alia, related application Serial No. 76121917 to this proceeding.

Because application Serial No. 76121917 now has been received by the Board, proceedings are resumed and application Serial No. 76121917 is added to this proceeding.

On September 3, 2002, Stavan filed a copy of a settlement agreement between the parties. In the settlement agreement, the parties acknowledge that Woodbury began using "the Mark"<sup>4</sup> as early as July 1991 and Stavan began using the

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<sup>3</sup> Application Serial No. 76121917 was filed on September 5, 2000 and claims first use and first use in commerce in July 1991.

<sup>4</sup> As noted above, the parties' applications are for different trademarks, both of which contain the common term "WOODBURY VILLAGE," but the agreement refers only to one "mark." The Board construes the agreement as covering the mark which is the subject of Stavan's application when it refers to Stavan's mark, and as covering the mark which is the subject of Woodbury's application when it refers to Woodbury's mark.

mark in November 1997. Further, the agreement provides that Stavan agrees *not* to use "the Mark" or any confusingly similar variant thereof in the following states:

Minnesota, Wisconsin, Michigan, Ohio, Indiana, Illinois, Missouri, Iowa, North Dakota, South Dakota, Nebraska, Kansas, New Mexico, Arizona, Colorado, Utah, Nevada, Wyoming, Montana, Idaho, Washington, Oregon, California, Alaska or Hawaii.

Woodbury agrees *not* to use "the Mark" or any confusingly similar variant thereof in the following:

New York, New Jersey, Connecticut, Delaware, District of Columbia, Maryland, New Hampshire, Vermont, Massachusetts, Rhode Island, Maine, Pennsylvania, West Virginia, Virginia, Kentucky, North Carolina, South Carolina, Georgia, Florida, Tennessee, Alabama, Mississippi, Arkansas, Louisiana, Oklahoma or Texas.

Additionally, the parties agree that "there is no likelihood that consumers have been or will be confused by the concurrent use and registration of the two marks"; that "there have been no instances of confusion"; and that "the Mark is used primarily on permanent signs in front of the shopping center"; and that "[a]s such, the Mark is not widely seen or disseminated." Significantly, the parties have also agreed "to take reasonable steps necessary in the future to prevent public confusion concerning their offering of services under the Mark including instructions to their respective officers and employees to instruct the public, should the occasion arise, that the parties and their services are not affiliated."

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Upon careful consideration of the settlement agreement, we are persuaded that use of the parties' involved marks as provided for under the terms of the settlement agreement will not, in fact, be likely to cause confusion.

**DECISION:**

Stavan Center L.P. is entitled to the registration of its mark set forth in application Serial No. 75639673 for "shopping center services" for the area comprising New York, New Jersey, Connecticut, Delaware, District of Columbia, Maryland, New Hampshire, Vermont, Massachusetts, Rhode Island, Maine, Pennsylvania, West Virginia, Virginia, Kentucky, North Carolina, South Carolina, Georgia, Florida, Tennessee, Alabama, Mississippi, Arkansas, Louisiana, Oklahoma and Texas.

Woodbury Village Shopping Center Limited Partnership is entitled to the registration of its mark set forth in application Serial No. 76121917 for "leasing shopping space to retail shopping facilities, leasing office space to commercial business offices and leasing restaurant space to restaurants, none of the foregoing relating to outlet shopping centers," for the area comprising Minnesota, Wisconsin, Michigan, Ohio, Indiana, Illinois, Missouri, Iowa, North Dakota, South Dakota, Nebraska, Kansas, New Mexico, Arizona, Colorado, Utah, Nevada, Wyoming, Montana, Idaho, Washington, Oregon, California, Alaska and Hawaii.

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In due course, the Board's shall forward application  
Serial Nos. 75639673 and 76121917 to registration.