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

Proceeding	94002033
Party	Applicant Link, Steven M. Link, Steven M. 108 Thompson Street Raritan, NJ 08869
Correspondence Address	Stephen L. Baker Baker & Friedman P.O. Box 672 359 East Main Street Somerville, NJ 08876
Submission	Motion for Granting of Concurrent Use Registrations
Filer's Name	Stephen L. Baker
Filer's e-mail	s.baker@br-tmlaw.com
Signature	/stephen baker/
Date	11/17/2004
Attachments	motion.tif (11 pages)

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

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	X	
In the matter of the Concurrent	X	
Use Application filed by Steven M.	X	Concurrent Use Proceeding
Link to register the mark DR.	X	94002033
ROOF & Design filed on February	X	
22, 1995 and assigned Serial No.	X	
74/637,996	X	
	X	
-----	X	

MOTION FOR GRANTING OF CONCURRENT USE REGISTRATIONS

This a Motion for Granting of Concurrent Use Registrations based upon Agreement between the parties executed on or about November 11, 1997 (The Agreement was executed in 1997. However, the day of execution was inadvertently not set forth in the agreement. Accordingly, the Agreement should be construed to have been executed on the last day of the month in which it was executed). A copy of the Agreement is annexed hereto as Exhibit 1. The Agreement avoids confusion, mistake or deception resulting from the simultaneous use of the marks of the parties as follows:

1. The geographical area in which Applicant 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]
2. The geographical area to which the Registrant has agreed to limit its use of the mark is Pennsylvania west of Interstate Highway 91, 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 US Virgin Islands and the District of Columbia ("Registrant's Territory"). [See Exhibit 1, Paragraph 3]

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, 6 7 and 8]

4. 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 US 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 10]

5. 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]

6. Admittedly, the marks of the parties are essentially identical except that Applicant's mark includes a design feature. Further, the services are clearly identical. Nevertheless, the parties have taken reasonable steps so as to avoid confusion. In that regard, they have limited their trademark/service mark rights

on a geographical basis so as to avoid any overlap. [See Exhibit 1, Paragraphs 3 and 4]

Argument

Under Section 2(d) of the Trademark Act, concurrent use of registrations should be allowed where the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce under such conditions that confusion, mistake, or deception is not likely to result from such continued use. In this case, the parties have co-existed for a number of years without any indication that confusion, mistake, or deception has occurred. Further, the parties have agreed to continue to avoid any geographical overlap in the use of their respective marks. Long years of concurrent use support the conclusion that confusion, mistake, or deception is unlikely. "In addition, the clear message of the case law is that agreements between parties who are in a position to assess the effect of their uses should be given great weight." See Mid-States Distributing Co., Inc. v Morrison Oil Co., 10 USPQ 2d 1860 (TTAB 1989).

In Mid-States, the marks were identical (DUREX v. DUREX) and the goods were identical (Anti-freeze for motor vehicles). The Board ruled that the Applicant was entitled to registration of its mark in certain states and that the pre-existing registration be restricted to reflect the right to use its mark in the remainder of the United States, with an exception as to where there may have been some overlap. In this case, there is no overlap and the parties have taken reasonable steps to avoid such overlap.

It is respectfully requested that a registration issue to Applicant for the states set forth in the Agreement and that the Registrant's mark be restricted as set forth in said Agreement.

Dated: November 17, 2004

Respectfully submitted,

BAKER AND RANNELLS PA

By:



Stephen L. Baker
Attorney for the Applicant
Baker and Rannells PA
626 North Thompson Street
Raritan, New Jersey 08866
908-722-5640
Fax 908-725-7088

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Motion Granting for Concurrent Use Registrations was mailed via first class mail, postage pre-paid on this date by mailing a copy of the same to the attorneys for the Registrant as follows:

Gary K. Price, Esq.
Johnson, Carroll & Griffith
2230 West Franklin Street
PO Box 6016
Evansville, Indiana 47719-6016

Date: NOV. 17 2004

Baker and Rannells PA



Stephen L. Baker
Attorney for Applicant

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

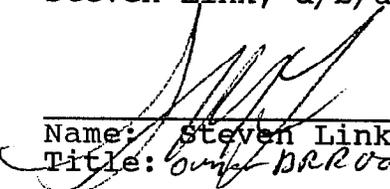
With a copy to: Johnson, Carroll & Griffith
2230 West Franklin Street
P. O. Box 6016
Evansville, IN 47719-6016
fax: 812-425-4233
tel: 812-425-4466

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.

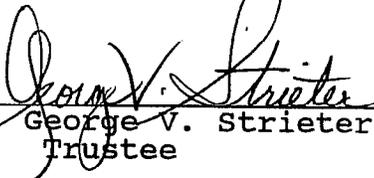
16. This Agreement may not be amended except by a writing signed by the parties hereto. There are no understandings, agreements or representations, express or implied, not specified herein.

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


Name: Steven Link
Title: *DR. ROOF*

BALLAST REVOCABLE LIVING TRUST


Name: George V. Strieter
Title: Trustee

doc:dr.roof/agreements