

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

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Mailed: August 26, 2009

Concurrent Use No. 94002100

Beach Mart, Inc., a North
Carolina Corporation

V.

Beach Mart, Inc., a Florida
Corporation

**Before Grendel, Rogers and Bergsman,
Administrative Trademark Judges.**

By the Board:

On May 26, 2005, the Board instituted this concurrent use proceeding under the provisions of Trademark Act Section 2(d). Beach Mart Inc., a North Carolina Corporation ("Beach Mart NC" or "applicant") filed an application based on Trademark Act Section 1(a) seeking to register the mark BEACH MART (standard characters, MART disclaimed) for "retail stores featuring tropical resort apparel, accessories and novelty items" in International Class 35.¹

In its application, Beach Mart NC identified Beach Mart, Inc., a Florida Corporation ("Beach Mart FL"), as an exception to its claim of an otherwise exclusive right to use the mark. Beach Mart NC included the following concurrent use statement

¹ Application Serial No. 76495364, filed March 7, 2003, alleging a date of first use and first use in commerce of July 10, 1995, and asserting acquired distinctiveness under Trademark Act Section 2(f). We note that Registration No. 2021521 for BEACH

in its application: "Applicant claims exclusive rights to use the mark in the area comprising all areas of the United States and its territories except for Georgia, Florida and except for a thirty mile radius around the city of Atlantic Beach, North Carolina."

Beach Mart FL is the owner of Registration No. 3190359, for the mark BEACH MART (standard characters, MART disclaimed), filed April 10, 1997, and registered January 2, 2007 for "retail store services featuring men's, women's and children's ready-to-wear clothing, namely, sweatshirts, shirts, jackets, pullovers, trousers, shorts, track suits, skirts, tee shirts, tank tops, dresses, pants, bathing suits and beach apparel and beach toys, decals, beach chairs, and souvenirs."²

After the Board's July 13, 2006 denial of applicant's motion for summary judgment, and a period of suspension to accommodate the parties' settlement efforts, the parties filed, on May 7, 2009, a consented motion for issuance of concurrent use registrations, as well as an accompanying executed "Consent to Use and Coexistence Agreement" ("Agreement").

By way of their Agreement, both parties consent to territorially restrict their use of the BEACH MART mark, and request 1) that Beach Mart NC's application proceed to issuance of a geographically restricted registration covering the area of Georgia, South Carolina, North Carolina, Virginia, Maryland,

MART, of which applicant claimed ownership, was cancelled on September 8, 2007 pursuant to Trademark Act Section 8.

² Registration No. 3190359, alleging a date of first use and first use in commerce of February 1, 1993, and asserting acquired distinctiveness under Trademark Act Section 2(f).

Delaware, New York, Rhode Island, Pennsylvania, New Jersey, New Hampshire, Massachusetts, Maine and Connecticut, and **2)** that Beach Mart FL's Registration No. 3190359 be amended to include a geographic restriction covering "all areas of the United States not allocated to Beach Mart (NC)." We interpret the latter provision as an intent to restrict Beach Mart FL's registration to the area of the entire United States except Georgia, South Carolina, North Carolina, Virginia, Maryland, Delaware, New York, Rhode Island, Pennsylvania, New Jersey, New Hampshire, Massachusetts, Maine and Connecticut.

The salient provisions of the Agreement, namely, those setting forth the steps the parties will take in order to prevent and address any likelihood of confusion arising from

the use of their respective marks, provide that each party:

- 1) will not use or advertise its mark in the other party's geographic territory, and will only advertise locally through local media;
- 2) will not advertise in any nationwide advertising media;
- 3) will include on its respective website a list of, including full address of, each store location, as well as a disclaimer stating non-affiliation and non-association with the other party;
- 4) will immediately notify each other to resolve any spillover advertising;
- 5) will train their store management employees regarding the parties' geographic territories and store locations, the appropriate use of disclaimers, and the appropriate statements to use when informing customers or vendors of the non-affiliation with the other party;
- 6) will promptly notify each other of any encounters with or instances of actual confusion related to the marks, and cooperate with each other to correct such confusion.

Furthermore, subject to the territorial restrictions set forth in the Agreement, Beach Mart FL consents to Beach Mart NC's use and/or registration or licensing of the mark SUPER BEACH MART for retail stores featuring apparel, novelty items, souvenirs and related items, and agrees that it will not use, register or license the mark SUPER BEACH MART.

Applicant meets the jurisdictional requirements for concurrent use set forth in Trademark Act Section 2(d) inasmuch

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as it asserts concurrent lawful use of the mark in commerce, and such asserted use is prior to the filing date of Beach Mart FL's Registration No. 3190359. See TBMP § 1103.01(a) (2d ed. rev. 2004). We also note that Beach Mart FL consents to the grant of a concurrent use registration to applicant. See TBMP § 1103.01(b) (2d ed. rev. 2004).

Under the facts and circumstances of record, and in view of the parties' rights as established under their Agreement, the parties are hereby adjudged to be entitled to the concurrent use registrations they seek.

Applicant Beach Mart NC shall be granted a geographically restricted registration based on application Serial No. 76495364. Such application shall be amended to include the following concurrent use statement: Applicant claims the exclusive right to use the mark in the area comprising Georgia, South Carolina, North Carolina, Virginia, Maryland, Delaware, New York, Rhode Island, Pennsylvania, New Jersey, New Hampshire, Massachusetts, Maine and Connecticut. The concurrent use statement that is presently of record in the application shall be deleted and replaced with this statement.

Beach Mart FL's Registration No. 3190359 shall be amended to include the following statement: Registrant claims the exclusive right to use the mark in the area comprising the entire United States except Georgia, South Carolina, North Carolina, Virginia, Maryland, Delaware, New York, Rhode Island, Pennsylvania, New Jersey, New Hampshire, Massachusetts, Maine and Connecticut.

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