

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

MBA

Mailed October 23, 2007

Concurrent Use No. 94002102

Easy Cash, Inc.

v.

Advantage Rent-A-Car, Inc.

**Before Seeherman, Holtzman and Taylor, Administrative
Trademark Judges**

By the Board:

On September 25, 2007, applicant in this concurrent use proceeding: (1) filed a copy of a trademark coexistence agreement with the remaining registrant, Advantage Rent-A-Car, Inc. ("ARAC"); (2) requested that this proceeding be dissolved; and (3) requested that a concurrent use registration be issued to applicant based on the parties' agreement. Although the parties' agreement details their belief that there would be no likelihood of confusion between their respective marks, and as explained in more detail below, the agreement also reveals that this is not a true concurrent use proceeding and that the issuance of a concurrent use registration would be inappropriate. Accordingly, we dissolve this concurrent use proceeding and

Concurrent Use No. 94002102

will re-publish applicant's application for opposition, without geographic restriction.

Background

On January 22, 2002, applicant Easy Cash, Inc., filed application Serial No. 76363248 for registration of the mark EASY CASH and Design for "short term secured lending and deferred payment check cashing and retail sales of consumer items" in International Class 36. On May 24, 2002, the examining attorney issued an office action refusing registration based on a likelihood of confusion between applicant's mark and American International Investment's ("AII") mark EASY CASH and Design for "financial services for electronically converting cash money into a predetermined, fixed amount debit card," as shown in Registration No. 2346604. In its November 22, 2002 response to the office action, applicant stated "to the extent that the Registration (sic) is still doing business, he is doing business locally on the west coast," while applicant "is doing business in Arkansas and the seven contiguous states." Accordingly, applicant argued that "[t]his is clearly a case for concurrent use."

The examining attorney then informed applicant, in an office action issued January 23, 2003, of the additional information which would be required for a concurrent use registration, and applicant provided some of the requested

Concurrent Use No. 94002102

information on July 21, 2003. In addition to identifying AII's mark as an exception to applicant's exclusive right to use its mark, applicant also identified registrant ARAC's stylized mark EASY CASH, Registration No. 2655325, for "providing an incentive commission program for travel agents with respect to leasing and rental of automobiles," "automobile rental and leasing reservations services," and "travel agency services, namely, making reservations and booking for temporary lodging." Applicant did not, however, provide information regarding AII's geographic area of use, other than indicating "that business in (sic) most likely confined to the western United States," nor did applicant provide information regarding ARAC's geographic area of use, other than indicating that ARAC's Web site "shows that services are offered in only the Western United States"

On October 7, 2003, an examiner's amendment was entered which amended applicant's identification of services to read "pawn shop services and short term secured lending and deferred payment check cashing services." The application was erroneously published for opposition on December 23, 2003, "subject to concurrent use proceeding with American Investment Corporation" only, with applicant claiming rights to Arkansas and to Tulsa and Oklahoma City, Oklahoma. No oppositions or extensions of time to oppose were filed.

Concurrent Use No. 94002102

For a variety of reasons, jurisdiction over the application was restored to the examining attorney, who issued an office action on September 21, 2004, requesting, among other things, additional information regarding AII and ARAC. Applicant responded on January 25, 2005, providing some of the requested information, and requesting another amendment to the description of services, this time to read "secured lending and deferred payment check cashing." On August 23, 2005, in response to a March 8, 2005 office action, applicant provided additional information about AII's and ARAC's marks, stating that AII's area of use was "unknown," and that ARAC's comprised "Arizona, California, Colorado, Nevada, New Mexico, Texas, Utah, Washington" On November 28, 2006, the application was published as a geographically restricted application, and no oppositions were filed.

The Board instituted this proceeding on April 13, 2007. Applicant is seeking a concurrent use registration for the geographic area comprising the state of Arkansas, and Tulsa and Oklahoma City, Oklahoma. As set forth in its August 23, 2005 office action response, applicant has named registrants AII and ARAC as the exceptions to applicant's claim of exclusive right to use the mark in commerce.

On August 7, 2007, the Board, noting that applicant had reported as a result of its investigation that AII was no

Concurrent Use No. 94002102

longer a "viable" corporation and further noting that AII's registration had been cancelled for failure to file a Section 8 affidavit of use, issued an order removing the concurrent use restrictions regarding AII because AII was apparently no longer using its mark. The Board's order allowed applicant 30 days in which to submit an amended concurrent use statement. On August 27, 2007, applicant submitted an amended concurrent use statement, seeking rights to the same territory as in its original concurrent use statement, but naming only ARAC as an excepted user.

On September 25, 2007, applicant filed a notice of agreement with registrant ARAC, including a copy of the parties' Agreement Regarding Use of Trademarks ("Agreement"), in which applicant requested that this proceeding be terminated and that applicant's application proceed to registration. The parties' Agreement provides that: (1) applicant uses its mark EASY CASH and Design for secured lending services and deferred payment check cashing services; (2) registrant uses its mark EASY CASH in stylized format for automobile rental services and related services, including automobile rental and leasing reservation services; travel agency services in the nature of making reservations and booking for temporary lodging; and providing an incentive commission program for travel agents with respect to leasing and rental of automobiles; (3)

Concurrent Use No. 94002102

neither party will use its mark in connection with the other party's services; (4) applicant will restrict its use of EASY CASH and Design for its services "to the territory described as the state of Arkansas, the approximately eastern half of the state of Oklahoma (including specifically the cities of Tulsa and Oklahoma City), and the approximately western half of the state of Mississippi ...;"¹ and (5) neither party will contest the use or registration of the other's mark, provided such use or registration is in compliance with the Agreement.

Decision

A careful review of the parties' agreement reveals that this proceeding is not a true concurrent use case. Generally, in concurrent use cases, each party seeks to use its mark in, and obtain registration of its mark for, a limited geographic area. In this case, however, only applicant is seeking to use its mark in, and obtain registration of its mark for, a limited and exclusive geographic area. According to the parties' agreement, ARAC will apparently have the right to use its mark nationwide, and its registration is geographically unrestricted. Thus, applicant's area of use is not exclusive; the agreement does not restrict ARAC from using its mark in the geographic area

¹ Although the Agreement indicates that applicant may use its mark in parts of Mississippi, applicant seeks a registration covering only Arkansas, and Tulsa and Oklahoma City, Oklahoma.

Concurrent Use No. 94002102

claimed by applicant. As a result, applicant's proposed geographic restriction is essentially meaningless, and will not be entered absent a corresponding geographic restriction to ARAC's registration.

It is clear from the agreement that the parties believe there is no likelihood of confusion not because of any geographic separation of their services, but because of the differences in the services themselves. Accordingly, there is no reason to geographically restrict applicant's application, and this proceeding must be dissolved.²

Although the application was previously published on December 23, 2003, it was published with a geographic restriction, and the description of services at that time was different from what it is now. Accordingly, applicant's mark must be re-published for opposition, without geographic restriction and with the current identification of services. In the event that no opposition is filed, applicant shall be entitled to a geographically unrestricted registration. In the event that the application is opposed, the Board will conduct an opposition proceeding.

News from the TTAB

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and

² As noted previously, during examination the Examining Attorney did not cite ARAC's registration as a bar, thus indicating that she did not perceive any likelihood of confusion between the two marks for the respective identified services.

Concurrent Use No. 94002102

Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stdnagmnt.htm>
