

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

Mailed: February 2, 2012

Concurrent Use No. 94002137

BLUEBONNET FEEDS, LP

v.

WELLPET LLC¹ by merger with
EAGLE PACK PET FOODS, INC.

Cheryl Goodman, Interlocutory Attorney:

On June 25, 2007, the parties filed a stipulated motion for judgment. The Board required the submission of the parties' concurrent use agreement, which the parties provided on October 17, 2007. On March 13, 2009, the Board required that the parties file amendments to set forth the geographic areas for the involved application (Serial No. 78310301) and registration (Registration No. 2156343), reflective of the parties' concurrent use agreement. On April 13, 2009, applicant Bluebonnet Feeds, LP ("Bluebonnet") filed an amendment limiting its area of use to the states of "Texas, Oklahoma, New Mexico, Louisiana, Arkansas and Mississippi." On April 13, 2009, registrant Wellpet LLC, formerly, Eagle Pack Pet Foods, Inc., ("Wellpet") filed an amendment to the registration for "the

area comprising the United States, excluding Texas, Oklahoma, New Mexico, Louisiana, Arkansas and Mississippi." The parties' motions to amend are granted.

The Board will consider any agreements worked out between the parties in determining whether concurrent registrations are to be granted, and if so, the geographic area to be covered by the registrations. See *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970).

While a settlement agreement may well serve as the basis for the resolution of a concurrent use proceeding, the burden of proof remains upon the parties to establish that there is no likelihood of confusion when the marks are used concurrently in the geographic areas allotted to each. See *Mid-States Distributing Co. Inc. v Morrison Oil Co.*, 10 USPQ2d 1860, 1862 (TTAB 1989).

Mere naked agreements, wherein the measures taken to preclude likelihood of confusion have not been delineated, are not persuasive in resolving the issue of registrable concurrent rights. See *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987). Therefore, the agreement between the parties must include a recitation of facts and circumstances sufficient to persuade the Board that the concurrent use of the marks by the parties for the

¹ The caption is amended to reflect the merger of Eagle Pack Pet Foods, Inc. with Wellpet LLC, recorded in the Office's Assignment Branch at Reel/Frame 3917/0119.

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same services in their respective geographical areas is not likely to cause confusion. See TBMP Section 1108 (2d ed. rev. 2004). See also Rice, Janet E., *Concurrent Use Applications and Proceedings*, 72 Trademark Reporter 403, 408, (1982).

The Board has reviewed the parties' concurrent use agreement. The parties' agreement expresses the proposed territorial limitation sought with respect to applicant's mark but does not identify the proposed territorial limitation sought for registrant's mark. While the agreement does address how abandonment by either party of its mark will affect the concurrent use rights of the other party, the agreement is silent as to what measures the parties have taken or will take to ensure that there will be no likelihood of confusion resulting from contemporaneous use of identical marks in connection with identical goods in contiguous territorial areas.²

For example, while the agreement specifies that Bluebonnet will not use the mark in areas outside of Texas, Oklahoma, New Mexico, Louisiana, and Mississippi, the agreement does not address Wellpet's use of the mark in Bluebonnet's geographic area, nor does the agreement specify

² Although the parties have entered into a licensing agreement with respect to Bluebonnet Feeds LP's use of the BLUE RIBBON mark, issues regarding the parties' concurrent use still need to be addressed in the concurrent use agreement.

whether the parties have agreed not to advertise their marks in the geographical area of the other party. The agreement also does not address whether the parties have initiated measures to prevent actual confusion, whether there are any agreements by the parties to use distinctly different signs or other marks or disclaimers in association with their marks, and whether, in the experience of the parties, concurrent use has resulted in actual confusion. *See, for example, Precision Tune, Inc. v. Precision Auto-Tune, Inc.*, 4 UPQ2d 1095 (TTAB 1987).

In view thereof, the Board finds that the parties' agreement is insufficient for resolving the parties' concurrent rights with respect to their respective marks.

However, the parties are allowed until SIXTY (60) days from the mailing date of this order to submit a revised or supplemental agreement which overcomes the deficiencies noted above, or to request instead that the concurrent use proceeding go forward to trial.

In the event that the proceeding goes forward, a revised scheduling order will be issued.

Proceedings herein are otherwise suspended.