

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: April 21, 2009

Concurrent Use No. 94002212

Westfield Savings Bank

v.

Ohio Farmers Insurance Company

v.

Westfield Financial
Corporation

**Before Holtzman, Grendel and Kuhlke,
Administrative Trademark Judges.**

By the Board:

Applicant Westfield Savings Bank ("WSB") seeks to register the mark, WESTFIELD BANK in typed form for "retail, commercial, savings, and mortgage banking services, namely, individual, partnership and corporate deposit accounts; personal, business and commercial loans, lines of credit and lease financing; safe deposit, depository and safekeeping services; and personal, consumer, business and commercial financial transactional services."¹

¹ Application Serial No. 76229151, filed March 23, 2001, claiming a date of first use anywhere and first use in commerce of March 31, 1997 for services in International Class 36. A disclaimer of "BANK" is of record.

Registrant Ohio Farmers Insurance Company ("OFIC") is the owner of a registration for the mark, WESTFIELD GROUP in typed form for "insurance underwriting services in the field of property, casualty, accident, and health; fidelity and surety services; insurance agency services in the field of property, casualty, accident and health; insurance brokerage services; banking and financing services; financial planning services; financial management services."²

Registrant Westfield Financial Corporation ("WFC") is the owner of a registration for the mark, WESTFIELD BANK in typed form for "banking; savings and loan services."³

Pursuant to the Board's order of December 13, 2008, the parties have submitted a stipulation to dismiss OFIC's Registration No. 2992750 from this concurrent use proceeding, and an amendment to their concurrent use agreement that describes WSB's and WFC's respective geographical territories with more specificity.

By way of review, in the original concurrent use agreement between WSB and WFC, the parties agreed to restrict the use of their respective marks to a mutually

² Registration No. 2992750, filed November 14, 2000, with a date of first use anywhere and first use in commerce of February 2001 for services in International Class 36. A disclaimer of "GROUP" is of record.

³ Registration No. 3139398, filed November 6, 2000, with a date of first use anywhere and first use in commerce of February 2001 for services in International Class 36. A disclaimer of "BANK" is of record. A claim of acquired distinctiveness in part under Trademark Act §2(f) as to "WESTFIELD" also is of record.

exclusive geographic division of the United States and to take appropriate steps to avoid creating confusion among consumers. The agreement provided that the parties acknowledge and agree that the geographic limitations set forth in the agreement will prevent any likelihood of confusion as to the source of the parties' respective services, and note that there has been no actual confusion, mistake or deception up to this time from the parties' concurrent use in their respective geographic areas. The parties agreed that their respective Internet web sites are and may continue to be accessible to customers located in each other's territories and explain procedures to address and ameliorate any possible consumer confusion. Further, the parties agreed to cooperate and consult with one another to insure no substantial likelihood of confusion between their marks.

The amendment to the concurrent use agreement provides for concurrent use by the parties of their marks for WESTFIELD BANK, and concurrent use registration thereof, within specified geographical territories. The geographic area for WSB's mark is described as "the states of Connecticut, Maine, Massachusetts, New Hampshire, Rhode Island, Vermont and that portion of the State of New York that lies East of Interstate 81, including New York City and Long Island." The geographic area for WFC's mark is

described as, "all of the United States except for the states of Connecticut, Maine, Massachusetts, New Hampshire, Rhode Island, Vermont and that portion of the State of New York that lies East of Interstate 81, including New York City and Long Island."

Upon careful consideration of the agreement between the parties the Board is persuaded that, under the circumstances of this case, the concurrent use restrictions proposed for the involved marks will not be likely to cause confusion, in view of their proposed geographic restrictions on use.

In making this determination, the Board has taken into account not only the provisions of the agreement and the actual geographic restrictions of the areas of use, but also the voluntary entry by the parties into an agreement which includes provisions for concurrent use when it would be clearly against their business interests to cause confusion on the part of the public. See *Amalgamated Bank of New York v. Amalgamated Trust & Savings*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988).

DECISION:

Registration No. 2992750 is dismissed from this concurrent use proceeding.

Applicant, Westfield Savings Bank, is entitled to the registration of its mark WESTFIELD BANK, for "retail, commercial, savings, and mortgage banking services, namely, individual, partnership and corporate deposit accounts; personal, business and commercial loans, lines

of credit and lease financing; safe deposit, depository and safekeeping services; and personal, consumer, business and commercial financial transactional services," for the area consisting of "the states of Connecticut, Maine, Massachusetts, New Hampshire, Rhode Island, Vermont and that portion of the State of New York that lies East of Interstate 81, including New York City and Long Island." (Application Serial No. 76229151).

Registration No. 3139398, owned by Westfield Financial Corporation, for the mark WESTFIELD BANK for "banking; savings and loan services," will be restricted to the area consisting of "all of the United States except for the states of Connecticut, Maine, Massachusetts, New Hampshire, Rhode Island, Vermont and that portion of the State of New York that lies East of Interstate 81, including New York City and Long Island."
