

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

Faint

Mailed: December 13, 2008

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."<sup>1</sup>

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<sup>1</sup> 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."<sup>2</sup>

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."<sup>3</sup>

On August 1, 2008 the parties submitted a copy of their settlement agreement and joint statement in support of concurrent use registrations for consideration by the Board. In that submission the parties clarify that WFC is a wholly-owned subsidiary of OFIC, and ask that WFC's registration for the mark WESTFIELD BANK and WSB's application for the mark WESTFIELD BANK be amended to geographically restrict the use of their respective marks.

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<sup>2</sup> 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.

<sup>3</sup> 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.

As a preliminary matter we note that WSB filed an opposition against OFIC's application for the mark WESTFIELD GROUP. Based on the parties' settlement agreement which provides for OFIC's consent to WSB's use of the mark WESTFIELD BANK, WSB withdrew its opposition and OFIC's application issued into an unrestricted registration. It appears from the agreement that the parties' intent was to conclude the dispute between WSB and OFIC by way of a consent to use agreement without seeking geographic restrictions as regards OFIC's registration. However, OFIC's registration was made part of the concurrent use proceeding. In general, concurrent use proceedings only cover agreements based on geographic restrictions and registrations involving other agreements based on consent to use are not proper matters to be resolved in the context of a concurrent use proceeding. In view thereof, the parties are allowed until **THIRTY DAYS** from the mailing date of this order in which to file a stipulated dismissal of the concurrent use proceeding against Reg. No. 2992750 or clarify the geographic restrictions to be applied to that registration.

In the concurrent use agreement between WSB and WFC, the parties agree to restrict the use of their respective marks to a mutually exclusive geographic division of the United States and to take appropriate steps to avoid

creating confusion among consumers.<sup>4</sup> The agreement provides 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 agree 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 agree to cooperate and consult with one another to insure no substantial likelihood of confusion between their marks.

The joint statement 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 New England Territory," which is defined in the concurrent use agreement as, "the states of

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<sup>4</sup> The parties also explain that WSB claims to have used the mark WESTFIELD SAVINGS BANK from April 1853 to approximately March 1997, when it deleted "SAVINGS" from the mark, and has used the mark WESTFIELD BANK from March 1997 to the present. OFIC is the parent company of a group which claims to have begun using the name WESTFIELD COMPANIES as its trade name in 1971 and WESTFIELD GROUP as a service mark in approximately February 2001. WFC is one of the Westfield Companies and began using the mark WESTFIELD BANK in approximately February 2001.

Connecticut, Maine, Massachusetts, New Hampshire, Rhode Island, Vermont and that portion of New York state that lies East of Interstate 81, as depicted on the attached map of New York State, including New York City and Long Island." The geographic area for WFC's mark is described as, "the portion of the United States outside of the New England Territory."

In this case, the Board determines that the agreement is not sufficiently definite as to each party's territory. Specifically, the parties must provide a more definite description for each of their respective territories. The parties are reminded that the geographic territory to which they are entitled must appear on the face of the respective registrations, and therefore must be expressed in written form, without reference to a drawn map or other attachments. For instance the parties could describe WSB's territory as, "the states of Connecticut, Maine, Massachusetts, New Hampshire, Rhode Island, Vermont and that portion of New York state that lies East of Interstate 81, including New York City and Long Island;" and WFC's territory as, "all of the United States except for the states of Connecticut, Maine, Massachusetts, New Hampshire, Rhode Island, Vermont and that portion of New York state that lies East of Interstate 81, including New York City and Long Island."

Inasmuch as the parties appear desirous of resolving this concurrent use matter, they are allowed until **THIRTY DAYS** from the mailing date of this order in which to submit an amendment to their agreement stating each party's territory of use with the requisite specificity, and to file a stipulation of dismissal of this proceeding against OFIC. Proceedings otherwise are suspended.

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