

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Concurrent Use No. 94002254

OVERWAITEA FOOD GROUP LIMITED
PARTNERSHIP

v.

URBAN FARE, LLC

Before Quinn, Zervas, and Cataldo, Administrative Trademark
Judges.

By the Board:

Overwaitea Food Group Limited Partnership (hereinafter
"Overwaitea") filed an application to register the mark
URBAN FARE (FARE disclaimed) for "retail grocery store
services" (Application Serial No. 76071579).

The Board will not recount the procedural history of
this proceeding in detail but notes that the application
published for opposition with a basis of bona fide intent to
use the mark in commerce, was later amended to seek
registration pursuant to Trademark Act Section 44(e) and
published for opposition again, and subsequently was amended
to seek a concurrent use registration for the geographic

area comprising the United States, excluding the State of Minnesota.¹ On September 14, 2007, the Board instituted this proceeding.²

Overwaitea's amendment to seek a concurrent use registration included a declaration that applicant commenced use of the mark in commerce at least as early as January 1, 2002, and lists Urban Fare, LLC as an exception to Overwaitea's right to exclusive use. Overwaitea acknowledges that Urban Fare, LLC uses the mark URBAN FARE for soups, chicken and vegetable stocks and broths in the State of Minnesota.

On September 2, 2008, having received no answer to the order setting forth the rights claimed by Overwaitea, the Board entered default judgment against Urban Fare, LLC and allowed Overwaitea time to prove its entitlement to the concurrent use registration sought by an *ex parte* type of showing. See TBMP § 1107.

¹ Trademark Rule 2.73 currently provides that only an application that includes Section 1(a) of the Trademark Act as a filing basis, or for which an acceptable allegation of use under §2.76 or §2.88 has been filed, may be amended to seek concurrent use registration. However, at the time Overwaitea filed its amendment, Trademark Rule 2.73 provided that applications under Section 44 or Section 66(a) of the Act may be amended to recite concurrent use. For a discussion of the change, see "Miscellaneous Changes to Trademark Rules of Practice," 73 Fed. Reg. 67759, 67761 (November 17, 2008).

² Since Overwaitea's application seeks registration of Overwaitea's mark for less than the entire United States and its territories, and since the the statutory basis for registration did not change, the amendment to seek a concurrent use registration did not require republication of the application.

A concurrent use applicant must make a prima facie showing that confusion is not likely to result from the concurrent use by applicant and the named exception to applicant's use. That is, the burden of proof in a concurrent use proceeding is upon the party or parties seeking concurrent use registrations to establish facts which would show that there is no likelihood of confusion arising from their concurrent use of similar marks in their respective geographical areas. See *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970); and *Handy Spot, Inc. v. J. D. Williams Company, Incorporated*, 181 USPQ 351 (TTAB 1974).

In support of its application for a concurrent use registration, Overwaitea submitted the declaration of John Paisley, Director of Urban Fare Merchandising and Operations of Overwaitea Food Group Limited partnership. In his declaration, Mr. Paisley states, inter alia, that Overwaitea currently operates two URBAN FARE retail locations in Vancouver, British Columbia, Canada, and intends to open a third location; that Overwaitea has used its mark URBAN FARE in connection with retail grocery store services since at least January 1, 2002; that Vancouver is only twenty four miles from the U.S. border and the closest metropolitan area for many residents of northern Washington State; that Overwaitea's URBAN FARE stores serve customers who are

residents and citizens of the United States; and that Overwaitea's URBAN FARE stores are advertised in print publications and television and radio advertisements which reach customers in the United States, but the state of Minnesota is not part of the expected distribution, viewing or listening area for those advertisements.

Mr. Paisley's declaration also avers that Urban Fare LLC used the mark URBAN FARE for soups, chicken and vegetable stocks and broths in the state of Minnesota prior to Overwaitea's application filing date; that Overwaitea is unaware of Urban Fare LLC selling its products outside the state of Minnesota; that Overwaitea does not have any URBAN FARE grocery stores in or near the state of Minnesota and has no present intention of opening URBAN FARE groceries in or near the state of Minnesota; that Overwaitea is aware of no instances of actual confusion of either party's customers regarding goods and services sold under the URBAN FARE mark; and that no customers of either party are likely to be confused about the source of Urban Fare LLC's URBAN FARE soups, stocks and broths and Overwaitea's URBAN FARE grocery store services.

A party is not entitled to a concurrent use registration unless the "touchstone" requirement of no likelihood of confusion to the public is met. See *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed.

Cir. 1987). In this case, the parties use the same URBAN FARE mark on related foods and grocery store services. However, Overwaitea's evidence of use in separate geographic areas and the lack of actual confusion over the years that the marks have co-existed establish a prima facie case that the concurrent use of the involved marks is not likely to lead to confusion. See *Precision Tune Inc. v. Precision Anti-Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987).

Upon careful consideration of Overwaitea's evidence, the Board is persuaded that under the circumstances of this case, concurrent use by these parties of their involved marks will not, in fact, be likely to cause confusion.

DECISION

Concurrent use applicant Overwaitea is entitled to registration of the mark URBAN FARE for its "retail grocery store services" for the area comprising the United States, excluding the state of Minnesota (application Serial No. 76071579).
