

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

Faint

Mailed: October 28, 2010

Concurrent Use No. 94002382

Yes Yes, Inc.
(Application Serial No.
76621541)

v.

American Residential
Services, LLC (assignee of
24/7 Service Corporation)
(Registration No. 3573896)¹

**Before Walters, Walsh and Ritchie,
Administrative Trademark Judges.**

By the Board:

In response to the Board's order of August 11, 2010, the parties provided a (third) Addendum to clarify the territories each claims for use of its mark.²

Yes Yes Inc. (hereinafter "YYI") is seeking to register the mark YES YES for "air conditioning contractor services, and installation, repair, and maintenance of air conditioning apparatus" in International Class 37 for the area consisting of the "states or territories east of the Mississippi River,

¹ An assignment for this registration is recorded in the USPTO Assignments Database at Reel/Frame Nos. 3955/0978.

² In response to the Board's order of November 27, 2009, the parties provided copies of the Settlement Agreement dated August 17, 2005, and a (second) Addendum to the Agreement, dated December 14, 2009. The first Addendum, dated August 17, 2005 was previously filed by the parties. The first Addendum notes that ARS is the assignee of the YES! mark and that ARS and its assignor 24/7 Service Corp. are bound by the terms of the settlement agreement entered into by the assignor and YYI.

excluding Florida, namely, Alabama, Connecticut, Delaware, Georgia, Illinois, Indiana, Kentucky, Maine, Maryland, Massachusetts, Michigan, Mississippi, New Hampshire, New Jersey, New York, North Carolina, Ohio, Pennsylvania, Rhode Island, South Carolina, Tennessee, Vermont, Virginia, Washington D.C., West Virginia, and Wisconsin."

American Residential Services, LLC, as assignee of 24/7 Service Corp. (hereinafter "ARS"), is the owner of Registration No. 3573896 for the mark YES! for, "plumbing services, namely, installation, maintenance, and repair and air conditioning services, namely, installation, maintenance, and repair" in International Class 37 for the area consisting of, "Florida and states or territories west of the Mississippi River, namely, Alaska, Arizona, Arkansas, California, Colorado, Hawaii, Idaho, Iowa, Kansas, Louisiana, Minnesota, Missouri, Montana, Nebraska, Nevada, New Mexico, North Dakota, Oklahoma, Oregon, South Dakota, Texas, Utah, Washington and Wyoming."³

The agreement and addendums provide that the parties do not believe that confusion is likely between their respective marks in their separate geographical areas. The parties state that they will take commercially reasonable steps to prevent actual confusion, and agree to use distinctly different packaging, labeling, signs or other marks in association with their marks to distinguish their marks and avoid likelihood of confusion between the marks.

The parties also agree that they will not advertise their respective marks in the other party's service area. The parties further state that they will take commercially reasonable steps to ensure that any spillover advertising (defined as "Internet advertising website advertising national television and radio advertising") of their respective services will prominently indicate the service areas and display a disclaimer that the owner of the advertised mark is not affiliated with the owner of the other mark.

The parties further provide that, in the event any actual confusion occurs, they will cooperate and work together, and take steps, to avoid future confusion.⁴ By the second and third Addendums the parties specifically consent to the geographic restrictions of their respective marks.

Upon careful consideration of the agreement between the parties, which supports each of the parties' right to concurrent use registrations, the Board is persuaded that under the circumstances of this case, concurrent use by the parties of their involved marks will not, in fact, be likely to cause confusion.

³ The assignment was recorded in the USPTO Assignments database at reel/frame 3955/0978 on February 17, 2009.

⁴ The Board notes, too, that the parties agreed to, and have, withdrawn Opposition No. 91163597, and agree not to oppose or cancel each other's applications or registrations for their respective marks.

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 entrance 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:

Applicant, Yes Yes, Inc. is entitled to registration of its mark YES YES for "air conditioning contractor services, and installation, repair, and maintenance of air conditioning apparatus" in International Class 37 for the area consisting of the "states or territories east of the Mississippi River, excluding Florida, namely, Alabama, Connecticut, Delaware, Georgia, Illinois, Indiana, Kentucky, Maine, Maryland, Massachusetts, Michigan, Mississippi, New Hampshire, New Jersey, New York, North Carolina, Ohio, Pennsylvania, Rhode Island, South Carolina, Tennessee, Vermont, Virginia, Washington D.C., West Virginia, and Wisconsin." (Application Serial No. 76621541.)

Registration No. 3573896 for the mark YES! for "plumbing services, namely, installation, maintenance, and repair and air conditioning services, namely, installation, maintenance, and repair" in International Class 37 will be restricted to the area consisting of "Florida and states or territories West of the Mississippi River, namely, Alaska, Arizona, Arkansas, California, Colorado, Hawaii, Idaho, Iowa, Kansas, Louisiana, Minnesota, Missouri, Montana, Nebraska, Nevada, New

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Mexico, North Dakota, Oklahoma, Oregon, South
Dakota, Texas, Utah, Washington and Wyoming."

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