

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

Mailed: April 30, 2009

Concurrent Use No. 94002382

Yes Yes, Inc.
Concurrent Use Applicant

v.

24/7 Service Corporation
Registrant

**M. Catherine Faint,
Interlocutory Attorney:**

Yes Yes, Inc. (hereinafter "YYI") seeks concurrent use registration for the mark:

YES YES in stylized form for "air conditioning contractor services, and installation, repair, and maintenance of air conditioning apparatus," in International Class 37.¹ YYI recites its territory of use as, "the area comprising those states east of the Mississippi excluding the State of Florida."

YYI names registrant (hereinafter "24/7") as exception to YYI's exclusive right to use its mark in commerce. 24/7's registration is for the mark, "YES!" in standard character form for, "Plumbing services, namely, installation, maintenance, and repair and air conditioning services, namely, installation,

¹ Application Serial No. 76621541, filed November 22, 2004, claiming a date of first use anywhere and first use in commerce of May 1, 1990.

maintenance, and repair" in International Class 37.² YVI recites 24/7's territory of use as, "the area comprising those states west of the Mississippi River, including the State of Florida."

The Board instituted this concurrent use proceeding on January 31, 2009. On February 13, 2009 24/7 filed its "statement of consent" to concurrent use, reciting its exclusive territory as "all states west of the Mississippi River, plus the State of Florida."

The burden of proof in a concurrent use proceeding is upon the parties seeking concurrent use registrations to establish facts showing that there is no likelihood of confusion arising from their concurrent use of similar marks in their respective geographical areas. See *Handy Spot Inc. v. J.D. Williams Company, Incorporated*, 181 USPQ 351 (TTAB 1974); and *In re Beatrice Foods Co.*, 166 USPQ 431 (CCPA 1970). Often, the parties settle concurrent use proceedings on the basis of an agreement between them which provides for issuance to the concurrent use applicant of the sought-after concurrent use registration. See TBMP § 1110 (2d ed. rev. 2004). However, mere acknowledgement or consent to concurrent use registrations which does not delineate measures to be taken to avoid likelihood of confusion is insufficient to establish that there is no likelihood of confusion arising from the parties' concurrent use of similar marks in their respective geographical areas.

² Registration No. 3573896, registered February 10, 2009, claiming a

An agreement between the parties must include a recitation of facts and circumstances sufficient to persuade the Board that the concurrent use of the same mark by the parties for the same goods and services in their respective geographical areas is not likely to cause confusion. Some of the factors which may be included in such agreements are: (1) agreement by each party not to use or advertise in the geographical area of the any other party;³ (2) agreement that the parties will take whatever steps are necessary to prevent actual confusion; (3) establishment of a "buffer zone" between the geographical areas of the parties; (4) recitation of any specific differences between the respective marks and goods of the parties; (5) information concerning any particular aspects of the goods, services or channels of trade which may help to preclude likelihood of confusion; (6) agreement by the parties to use distinctly different packaging, labeling, signs, or others marks in association with their marks; and (7) information to the length and extent of concurrent use, and whether, in the experience of the parties, such use has resulted in any actual confusion. These factors are not all inclusive, and the parties may include any other relevant facts in demonstrating that there is no likelihood of confusion arising from the parties' concurrent use of similar marks in

date of first use anywhere and first use in commerce of March 19, 2005.
³ Some parties specifically address steps to be taken to avoid likelihood of confusion with Internet and other electronic advertising media.

their respective geographical areas. See Janet E. Rice, *Concurrent Use Applications and Proceedings*, 72 Trademark Reporter 403, 408 (1982). See also TBMP § 1110 (2d ed. rev. 2004).

The consent to concurrent registration does not address the issue of likelihood of confusion arising from the parties' concurrent use of the same or similar marks in their respective geographical areas.

Accordingly, the Board finds that there is insufficient evidence to demonstrate that the parties are entitled to concurrent use registrations. Inasmuch as the parties appear to be desirous of settling this case, proceedings herein are suspended for **SIXTY DAYS from the mailing date of this order** to allow the parties an opportunity to work out an appropriate agreement which delineates measures to be taken to avoid likelihood of confusion which may arise from the parties' concurrent use of similar marks in their respective geographical areas. If no word is heard from the parties concerning this matter prior to the expiration of the suspension period, proceedings will resume and dates will be reset by the Board.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For

further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>