

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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

TJQ

Mailed: April 22, 2014

Concurrent Use No. 94002550

Community Tampa Bay, Inc.

v.

The National Conference for
Community and Justice of the
Piedmont Triad, Inc.

v.

The National Conference for
Community and Justice
Connecticut/Western
Massachusetts, Inc.

v.

The Interfaith Council of
Southern Nevada

v.

Valley of the Sun YMCA

v.

Oasis Center

v.

YWCA Central Alabama

v.

National Conference for
Community and Justice of
Greater Dayton

v.

Oklahoma Center for Community
and Justice

v.

New Orleans Council for
Community and Justice

v.

Inclusion Center

v.

National Conference for
Community and Justice of
Metropolitan St. Louis

Before Quinn, Wellington and Adlin,
Administrative Trademark Judges

By the Board:

On September 14, 2012, the Board instituted this concurrent use proceeding. The concurrent use statement, as amended, in involved application Serial No. 85488380¹ reads as follows:

The applicant seeks:
registration of the mark [ANYTOWN] without limitation to any particular mode of use for educational services, namely, conducting classes, seminars, dialogue groups and workshops

¹ Application Serial No. 85488380, filed December 6, 2011 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use anywhere and first use in commerce on July 21, 2005.

and facilitating participation in service learning events all in the fields of inclusive leadership training, diversity and sensitivity education and training, conflict mediation, advocacy and communication skill building, and distribution of course materials in connection therewith, and claims exclusive right to the mark in the area comprising the entire United States, with the exception of the following states and territories: North Carolina; the following counties in South Carolina: Chester County, Chesterfield County, Lancaster County, and York County; Connecticut, Massachusetts, Rhode Island, Maine, New Hampshire, Vermont, Nevada, Arizona, Tennessee, Alabama, Ohio, Oklahoma, Louisiana, Utah, Missouri and Illinois.

Applicant is aware of the following unregistered users of the ANYTOWN mark, and information regarding these uses is set forth as follows, to the best of the Applicant's knowledge:

- (1) The National Conference for Community and Justice of the Piedmont Triad, Inc., 713 North Greene Street, Greensboro, NC 27401; Geographic Area: North Carolina, and the following counties in South Carolina: Chester County, Chesterfield County, Lancaster County, and York County; Duration of Use: 2005 - present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (2) The National Conference for Community and Justice Connecticut/Western Massachusetts, Inc., 1095 Day Hill Road, Windsor, CT 06095; Geographic Area: Connecticut, Massachusetts, Rhode Island, Maine, New Hampshire, and Vermont; Duration of Use: 2005 - present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (3) The Interfaith Council of Southern Nevada, P.O. Box 73070, Las Vegas, NV 89170; Geographic Area: Nevada; Duration of Use: 2005 - present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (4) Valley of the Sun YMCA, 350 N. First Ave, Phoenix, AZ 85003; Geographic Area: Arizona; Duration of Use: 2010 - present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (5) Oasis Center, 1704 Charlotte Ave., Suite 200, Nashville, TN 37203; Geographic Area: Tennessee; Duration of Use: 2010 - present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (6) YWCA Central Alabama, 309 North 23rd Street, Birmingham, AL 35203; Geographic Area: Alabama;

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- Duration of Use: 2011 - present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (7) National conference for Community and Justice of Greater Dayton, 14 West First Street, Suite 401, Dayton, OH 45402-1259; Geographic Area: Ohio; Duration of Use: unknown; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (8) Oklahoma Center for Community and Justice, 100 West Fifth Street, LL 1030, Tulsa, OK 74103-4273; Geographic Area: Oklahoma; Duration of Use: 2007 - present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (9) New Orleans Council for Community and Justice, 650 Poydras Street, Suite 2303, New Orleans, Louisiana 70130; Geographic Area: Louisiana; Duration of Use: 2009 - present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (10) Inclusion Center, 14 Heritage Center, Salt Lake City, Utah 84112; Geographic Area: Utah; Duration of Use: 2005-present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.
- (11) National Conference for Community and Justice of Metropolitan St. Louis, 1405 Pine Street, Suite 203, Saint Louis, MO 63103; Geographic Area: Missouri and Illinois; Duration of Use: at least as early as 2005-present; Goods/Services: Youth educational seminars and/or events; Modes of Use: unknown.

All verifications or declarations in this application indicating that no one else to the best of Applicant's knowledge and belief, has the right to use the mark in commerce, refers to "no one else" except as specified in the application.

As indicated in the Board's order dated November 14, 2013, the named excepted users have each either: (1) answered the concurrent use application by acknowledging that its territory of use is as set forth in the application (YMCA Central Alabama); (2) stipulated to the territories set forth in the application, as amended (The National Conference for Community and Justice of the Piedmont Triad, Inc., The National Conference for Community

and Justice Connecticut/Western Massachusetts, Inc., and National Conference for Community and Justice of Metropolitan St. Louis); or (3) defaulted (The Interfaith Council of Southern Nevada, Valley of the Sun YMCA, Oasis Center, National Conference for Community and Justice of Greater Dayton, Oklahoma Center for Community and Justice, New Orleans Council for Community and Justice, and Inclusion Center). In its order of November 14, 2003, the Board indicated that those parties against whom default judgment has been entered are precluded from claiming any right more extensive than that acknowledged in the involved application. The Board advised applicant that it still has the burden of proving its entitlement to the registration sought as against every party specified in its application, including any defaulting party. *See* TBMP §§ 1107 and 1108 (3d ed. rev. 2 2013). That is, applicant still must prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and, where necessary, that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the application filing date. *See* Trademark Act § 2(d), 15 U.S.C. § 1052(d). The Board indicated that applicant may prove its entitlement by making an *ex parte* showing, and allowed applicant time to do so.²

² When an *ex parte* showing is allowed, a concurrent use applicant may prove its entitlement to registration by less formal procedures (such as by the submission of affidavit or declaration evidence) than those (such as depositions upon oral examination) normally required for the introduction of evidence in an *inter partes* proceeding. Such a showing may suffice if the concurrent use applicant can establish by less formal means that confusion is not likely to occur by addressing the factors the Board looks at in settlement agreements. *See* TBMP §§ 1108, 1110.

This case now comes up on applicant's response, filed February 11, 2014, comprising its *ex parte* showing. Applicant, in its response, sets forth a helpful summary in table form showing each of the named common law excepted users (as outlined above), and their current status in the proceeding. Applicant also introduced the declarations of Lance Lansrud, chair of applicant's board of trustees, and Jessica Estévez, applicant's director of programs.

Mr. Lansrud states that he is aware of the common law excepted users and their respective excluded territories, and that applicant, pursuant to a recently approved corporate policy, will not use its mark in any excluded territory unless and until the relevant common law excepted user has ceased use of its mark in that area. Further, new employee orientation will include training regarding the territories in which applicant may and may not use its mark. Applicant's primary means of advertisement is through word of mouth, and applicant only occasionally advertises through local newspapers or local television programs; thus, according to Mr. Lansrud, applicant has not and will not target any advertisements for its services rendered under its mark ANYTOWN to the excluded territories. Further, when applicant provides information about its services under the mark ANYTOWN on the internet, through its website and social media platforms, applicant will include a disclaimer that it does not operate in the excluded territories. Mr. Lansrud points out that applicant's use of its mark has coexisted with the common law excepted users' uses for approximately 8.5 years. Lastly, Mr.

Lansrud claims that “applicant will cooperate reasonably with the appropriate common law excepted user(s) to remedy any confusion that may occur in the future and to take steps to prevent such confusion from reoccurring.” (§ 11).

Ms. Estévez states, in relevant part, that applicant has not, to date, offered its ANYTOWN services in the excluded territories, and that it has not recruited participants for its programs from high schools or organizations in the excluded territories. Further, applicant’s services are regionally focused, designed to address diversity issues specific to a particular location based on the demographics and needs of the local community; and the common law excepted users’ services are also focused on and targeted to the needs of the specific community in which each organization is located. As detailed by Ms. Estévez, there is a lengthy, detailed process through which relevant customers purchase applicant’s services, and they do so only after careful consideration by parents who are entrusting their children to applicant and its programs. Lastly, applicant is not aware of any instance of actual confusion between applicant’s ANYTOWN services and the services offered by any of the common law excepted users.

As established by the declarations, applicant operates in different geographic areas from the common law excepted users; applicant does not and will not offer its services in the territories in which the common law excepted users use their marks unless and until the common law excepted users cease use of their marks; applicant does not and will not advertise its

services in the territories in which the common law users use their marks and is taking steps to include in its internet advertising the use of a disclaimer; relevant customers are likely to engage in a thoughtful decision in purchasing applicant's services and the services of the common law excepted users; and applicant's use of its mark has coexisted with the common law excepted users' use of their marks for at least 8.5 years without any known instances of actual confusion. Moreover, if there is any confusion in the future, applicant will cooperate reasonably with the other parties to correct the confusion and take steps to avoid any further confusion.

Upon consideration of applicant's *ex parte showing*, we find that the evidence is sufficient to establish that confusion is unlikely, and that applicant is entitled to a concurrent use registration with the appropriate geographical restrictions as detailed in its concurrent use statement, as amended.

Decision: Applicant is entitled to a concurrent use registration. Applicant's application Serial No. 85488380 is entitled to proceed to registration of the mark ANYTOWN for

Educational services, namely conducting classes, seminars, dialogue groups and workshops and facilitating participation in service learning events all in the fields of inclusive leadership training, diversity and sensitivity education and training, conflict mediation, advocacy and communication skill building, and distribution of course materials in connection therewith

in the area comprising the entire United States, with the exception of the following states and

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territories: North Carolina; the following counties in South Carolina: Chester County, Chesterfield County, Lancaster County, and York County; Connecticut, Massachusetts, Rhode Island, Maine, New Hampshire, Vermont, Nevada, Arizona, Tennessee, Alabama, Ohio, Oklahoma, Louisiana, Utah, Missouri and Illinois.