

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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BUTLER

Mailed: April 18, 2014

Opposition No. 91195670
Opposition No. 91195671
Cancellation No. 92052674

Clover Farms Dairy Company

v.

Clover-Stornetta Farms, Inc.

Concurrent Use No. 94002602

Clover-Stornetta Farms, Inc.
(Concurrent Use Applicant)

v.

Clover Farms Dairy Company
(Excepted User)

By the Board:

Clover Farms Dairy Company (hereinafter also “Clover Farms”) opposes registration of Clover-Stornetta Farms, Inc.’s (hereinafter also “Clover-Stornetta”) applications for the marks CLOVER ORGANIC FARMS for “organic milk, eggs, and other dairy products, namely, cheese” and “ice

Concurrent Use No. 94002602; Cancellation No. 94052674

cream”¹ and CLOVER FARMSTEAD for “milk; eggs; and other dairy products, namely, cheese” and “ice cream.”² Clover Farms also seeks to cancel Clover-Stornetta’s registration for the mark CLOVER STORNETTA for “milk; eggs; and other daily products, namely, cheese” and “ice cream.”³ The three proceedings have been consolidated with Opposition No. 91195670 designated as the parent case.

Clover Farms has pending before the Trademark Examining Operation an application for the mark CLOVER FARMS for “milk, chocolate milk, buttermilk, butter, cottage cheese, egg nog, half and half, heavy cream, light cream, non-dairy creamer, sour cream, and whipping cream.”⁴ The application is suspended pending disposition of consolidated Opposition No. 91195670.

On December 3, 2013, Clover-Stornetta filed the parties’ motion to dismiss the consolidated proceedings in favor of a concurrent use proceeding. The “joint motion” is signed by both parties.

¹ Application Serial No. 76680931, filed August 20, 2007, claiming a date of first use anywhere and a date of first use in commerce of February 18, 2005. The application is the subject matter of Opposition No. 91195670.

² Application Serial No. 76680932, filed on August 20, 2007 under Trademark Act § 1(b), intent to use. The application is the subject matter of Opposition No. 91195671.

³ Registration No. 3503416, issued on September 23, 2008. The registration is the subject matter of Cancellation No. 92052674.

⁴ Application Serial No. 77763209, filed June 18, 2009, claiming a date of first use anywhere of 1940 and a date of first use in commerce of 1970.

Opposition No. 91195671

Clover-Stornetta seeks to abandon application Serial No. 76680932. In accordance with the parties' joint motion (referenced herein as "J. Mtn."), application Serial No. 76680932 stands abandoned, and Opposition No. 91195671 is dismissed with prejudice. (J. Mtn. at ¶¶ B. 1 & 2.)

Opposition No. 91195670

1. Amendment to Serial No. 76680931

By its consented, proposed amendment, Clover-Stornetta seeks to amend to geographically restrict its registration to the States of Minnesota, Iowa, Missouri, Arkansas, Louisiana, North Dakota, South Dakota, Nebraska, Kansas, Oklahoma, Texas, Montana, Wyoming, Colorado, New Mexico, Utah, Arizona, Idaho, Nevada, Washington, Oregon, California, Alaska, and Hawaii (also referred to as the "Western Territory" by the parties). (J. Mtn. at ¶¶ A. 18 & 19.)

Inasmuch as Clover Farms consents thereto, Clover-Stornetta's amendment to geographically restrict its application Serial No. 76680931 is approved and entered. *See* Trademark Rules 2.99 and 2.133(a).

2. Opposition No. 91195670 is dismissed with prejudice.

In view thereof, and because the parties have stipulated that the opposition be dismissed with prejudice (J. Mtn. at ¶ B. 1), and a concurrent use proceeding be instituted in its stead, Opposition No. 91195670 is dismissed with prejudice. *See, e.g.*, TBMP §1113.01(4) (2013).

Concurrent Use No. 94002602 is instituted

A concurrent use proceeding, namely Concurrent Use No. 94002602, is hereby instituted under the provisions of Section 2(d) of the Trademark Act between Clover-Stornetta Farms, Inc. as the concurrent use applicant (in the position as “plaintiff”) and Clover Farms Dairy Company as the named excepted user (in the position as “defendant”).

Clover Farms’ area of use is identified as the States of Maine, New Hampshire, Vermont, Massachusetts, Rhode, Island, Connecticut, New Jersey, Delaware, New York, Pennsylvania, Maryland, Virginia, West Virginia, North Carolina, South Carolina, Georgia, Florida, Alabama, Mississippi, Tennessee, Kentucky, Ohio, Indiana, Illinois, Michigan, Wisconsin as well as the District of Columbia and Puerto Rico (also referred to as the “Eastern Territory” by the parties). (J. Mtn. at ¶¶ 17 & 20.)

1. Clover Farms’ Serial No. 77763209

Insofar as Clover Farms’ application Serial No. 77763209 has not published for opposition, Clover Farms is identified as a common law user and its application is not involved in this proceeding. *See* TBMP § 1104 (2013).

As a named common law user with an application pending before the Trademark Examining Operation, Clover Farms may seek to amend its pending application Serial No. 77763209 to a concurrent use application naming Clover-Stornetta, and its application Serial No. 76680931 and Registration No. 3503416, as an exception to its exclusive right to use its

Concurrent Use No. 94002602; Cancellation No. 94052674

mark. The amendment must be filed with the Trademark Examining Attorney because the Board does not have jurisdiction over Clover Farms' application Serial No. 77763209. *See* TMEP § 1504 (Oct. 2013) and TBMP § 212.01 (2013). It is also Clover Farms' responsibility to inform the assigned Examining Attorney of the dispositions of Opposition Nos. 91195670 and 91195671 (and the abandonment of application Serial No. 76680932).

In view thereof, Clover Farms is allowed until THIRTY DAYS from the mailing date of this order in which to inform the Board whether it filed an amendment to concurrent use with respect to its application Serial No. 77763209, failing which, appropriate action will be taken herein.

2. Clover-Stornetta's Registration No. 3503416

Clover-Stornetta's registration cannot be included in the concurrent use proceeding at this time. *See* TBMP § 1113.02 (2013). However, if Clover Farms amends its application as discussed above, and its application becomes involved in the concurrent use proceeding, Clover-Stornetta's registration may then be subject to the concurrent use proceeding.

3. Consideration of the parties' agreement deferred.

The Board is allowing Clover Farms time to take the appropriate steps to amend its application pending before the Trademark Examining Operation. If Clover Farms is successful, its application will be published for opposition and, provided no opposition is filed or any opposition filed is dismissed, become part of this concurrent use proceeding. At such time, and as discussed

Concurrent Use No. 94002602; Cancellation No. 94052674

above, Clover-Stornetta's registration may become involved in this concurrent use proceeding.

Accordingly, consideration of the parties' agreement is deferred.

Consolidation

Concurrent Use No. 94002602 and Cancellation No. 92052674 are hereby consolidated. Concurrent Use No. 94002602 is the parent case.

Proceedings suspended

Proceedings are hereby suspended for THIRTY DAYS to allow Clover Farms time to take appropriate action with respect to its pending application.