

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: April 24, 2014

Concurrent Use No. 94002602

Clover-Stornetta Farms, Inc.
(Application Serial No. 76680931)

v.

Clover Farms Dairy Company

Cancellation No. 92052674

Clover Farms Dairy Company

v.

Clover-Stornetta Farms, Inc.

By the Board:

Clover-Stornetta Farms, Inc. (hereinafter also “applicant” and “concurrent use applicant”) seeks a concurrent use registration for the mark CLOVER ORGANIC FARMS for “organic milk, eggs, and other dairy products, namely, cheese” in International Class 29 and “organic ice cream” in International Class 30.¹ As an exception to its exclusive right to use its mark, applicant names Clover Farms Dairy Company (hereinafter also “Clover Farms”) use of its mark CLOVER FARMS for “various conventional

¹ Application Serial No. 76680931, filed August 20, 2007, claiming a date of first use and a date of first use anywhere of February 18, 2005.

dairy products, including milk, chocolate milk, buttermilk, butter, cottage cheese, egg nog, half-and-half, heavy cream, light cream, non-dairy creamer, sour cream and whipping cream.” (J. Mtn. at ¶ 2.)²

In their joint motion to convert Opposition No. 91195670 to a concurrent use proceeding, the parties identify applicant’s territory of use as 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.) They further identify Clover Farms’ territory of use 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.)

² The parties’ combined joint motion to convert to a concurrent use proceeding and stipulated facts in favor of concurrent use registration (signed by both parties) is of record in Opposition No. 91195670 at 53 TTABvue.

Application Serial No. 76680931 was the subject matter of Opposition No. 91195670. In accordance with the parties’ stipulation, the opposition proceeding has been dismissed with prejudice in favor of this concurrent use proceeding.

Clover Farms has pending before the Trademark Examining Operation an application (Serial No. 77763209) 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.” The application is presently suspended. Thus, the application is not involved in this concurrent use proceeding and Clover farms is identified as a common law user. *See* TBMP § 1104 (2013).

Cancellation No. 92052674

In their joint motion, the parties provided for the disposition of Cancellation No. 92052674. Specifically, the parties state that “... Clover Farms agrees to dismiss its petition to cancel” (J. mtn. at p. 2, 53 TTABvue at 3 of Opposition No. 91195670.) Cancellation No. 92052674 involves applicant’s registered mark CLOVER STORNETTA for “milk; eggs; and other daily products, namely, cheese” and “ice cream.”³ Clover Farms asserted use of its CLOVER FARMS mark.

In view of the parties’ stipulation, Cancellation No. 92052674 is dismissed with prejudice. (*See also* J. mtn. at B. 1., 53 TTABvue at 8 of Opposition No. 91195670.)

³ Registration No. 3503416.

Concurrent Use Agreement

In their stipulation, the parties agreed to geographic restrictions to the use and registration of applicant's CLOVER ORGANIC FARMS mark and Clover Farms' CLOVER FARMS mark in order to allow for concurrent use registration of both marks. The parties state their belief that the geographic restrictions on the (anticipated) registrations reduce any likelihood of confusion. The parties note that there has been no likelihood of confusion, further observing that the parties have used their CLOVER formative marks in their respective marks since the 1930's without any evidence of actual confusion. The parties agree to confer and cooperate in the event any confusion arises and have provided for specific steps with respect to any incidence(s) of actual confusion.

Upon careful consideration of the agreement between the parties, 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.

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, Clover-Stornetta Dairy Company, is entitled to registration of its mark CLOVER ORGANIC FARMS for “organic milk, eggs, and other dairy products, namely, cheese” in International Class 29 and “organic ice cream” in International Class 30” for the area consisting of “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.” (Application Serial No. 76680931.)⁴



⁴ Clover Farms is referred to TBMP § 1103.02 for the procedure to be followed should it amend its pending application to one seeking a concurrent use registration, naming Clover-Stornetta as the sole exception and relying on the determination made herein.