

**This Opinion is Not a
Precedent of the TTAB**

Mailed: April 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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PM Pediatrics Management Group LLC

v.

PM Pediatric Holdings, LLC

—
Concurrent Use No. 94002610
—

Martin W. Schiffmiller of Kirschstein Israel Schiffmiller & Pieron PC for PM
Pediatrics Management Group LLC

Samuel L. Miller of Baker Donelson Bearman Caldwell & Berkowitz for PM
Pediatric Holdings, LLC

—
Before Quinn, Kuhlke and Shaw,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

PM Pediatrics Management Group LLC, Applicant, has applied for a concurrent
use registration for the mark shown below for “medical services,” in Class 44.



The application includes a disclaimer of the word “PEDIATRICS” and a claim of
acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §

1052(f), for the wording “PM PEDIATRICS.” In addition, the application contains the following description of the mark and color claim:

The mark consists of the letter “P” appearing in purple with a white half-moon in the center of the “P”. Below and to the right of the “P” is the letter “M” appearing in teal resembling a person wearing a stethoscope. To the right of the letter “M” is the word “PEDIATRICS” in purple underlined in teal.

The color(s) purple, white, and teal is/are claimed as a feature of the mark.

The application, as amended, recites Applicant’s area of use as comprising the United States with the exception of the states of Tennessee, Kentucky, Arkansas, Louisiana, Mississippi, Alabama, and the following countries [sic] in the States [sic] of Georgia: Catoosa, Chattanooga, Dade, Dawson, Fannin, Floyd, Gilmer, Gordon, Habersham Lumpkin, Murray, Pickens, Rabun, Stephens, Towns, Union, Walker, White and Whitfield.

Applicant cited Registration No. 3193477 as the sole exception to its exclusive right to use its PM PEDIATRICS and design mark. Registration No. 3193477 is for the mark shown below for “Pediatric Medical Care,” in Class 44.



The registration includes a disclaimer of the word “PEDIATRICS.” In addition, the registration contains the following description of the mark, color claim and color location statement:

The mark consists of puzzle pieces in dark blue, green, yellow and pink/purple and lettering in light and medium blue.

The colors dark blue, green, yellow, pink/purple, light blue and medium blue are claimed as a feature of the mark.

The colors dark blue, green, yellow and pink/purple appear individually in the puzzle pieces; the lettering "PM" appears in light blue and the lettering "PEDIATRICS" appears in medium blue.

By way of background, Applicant initially filed a petition to cancel Registrant's registration. *See PM Pediatrics Management Group LLC v. P.M. Pediatrics, LLC*, Cancellation No. 92055016.¹ On February 20, 2014, that case was dismissed without prejudice based on the parties' stipulation and this concurrent use proceeding was instituted on August 21, 2014.

On November 14, 2014, Applicant filed the parties' "Stipulation and Agreement to (1) Amend Registration to Include Concurrent Use Geographic Restrictions and (2) Issue Concurrent Use Registration on Pending Application." Pursuant to the terms of the attached "Concurrent Use Agreement" the parties agree to geographic restrictions to the use and registration of their marks, and Registrant consents to having its existing Registration No. 3193477 be amended to geographically restrict the registration to "the States of Tennessee, Kentucky, Arkansas, Louisiana, Mississippi, Alabama and parts of Georgia (as delineated in the map annexed hereto as Exhibit A)" (¶¶ Nos. 1-2). The Concurrent Use Agreement also provides

¹ Subsequent to the institution of the Cancellation proceeding, the assignment of Registration No. 3193477 from P.M. Pediatrics, LLC to PM Pediatric Holdings, LLC was recorded with the USPTO Assignment Division on September 4, 2012 at Reel/Frame 004854/0834.

that the parties “will not open or run any medical practice or otherwise provide any goods or services” outside of their respective territories (§§ 3-4). While the parties recognize the possibility of spill-over advertising (§ 5), they agree to use “their best efforts to ensure that there is no likelihood of confusion” and “to consult and attempt to rectify any instances of confusion which may arise in the future” (§ 8). Finally, the parties state that there have been no known instances of actual confusion during the seven-year period that the parties’ medical practices have operated concurrently (§ 6).

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 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 delineations 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 Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988) (agreement allowed for spill over advertising).

Decision:

We find that the Agreement entered into between the parties is adequate evidence that confusion is unlikely and supports Applicant’s right to register its

mark with appropriate geographical restrictions. *See In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993).

Accordingly, Applicant's concurrent use application Serial No. 85344372 is entitled to proceed to registration of the mark PM PEDIATRICS and design for "medical services" as geographically restricted to:² the United States with the exception of the states of Tennessee, Kentucky, Arkansas, Louisiana, Mississippi, Alabama, and the following counties in the State of Georgia: Catoosa, Chatanooga, Dade, Dawson, Fannin, Floyd, Gilmer, Gordon, Habersham, Lumpkin, Murray, Pickens, Rabun, Stephens, Towns, Union, Walker, White and Whitfield.

Registrant's Registration No. 3193477 for the mark PM PEDIATRICS and design will be geographically restricted to:³ the states of Tennessee, Kentucky, Arkansas, Louisiana, Mississippi, Alabama, and the following counties in the State of Georgia: Catoosa, Chatanooga, Dade, Dawson, Fannin, Floyd, Gilmer, Gordon, Habersham, Lumpkin, Murray, Pickens, Rabun, Stephens, Towns, Union, Walker, White and Whitfield.

* * *

² The Board will correct the typographical errors in the application by deleting "countries" and replacing it with "counties" and deleting "States" and replacing it with "State."

³ The Board has translated the map in Exhibit A of the agreement into a listing of the counties for purposes of the restriction statement in the registration.