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PRECEDENT OF THE TTAB

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Mailed:  
February 24, 2016

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*Robert Moore*

*v.*

*Juan Mean Burrito, Inc.*

Concurrent Use No. 94002646

Before Bergsman, Masiello, and Lynch, Administrative Trademark Judges.

By the Board:

Robert Moore (“Applicant”) seeks a concurrent use registration of the mark BANDIT BURRITO for “Restaurant and catering services; Take-out restaurant services.”<sup>1</sup> The application names Juan Mean Burrito, Inc. (“JMB”) as an exception to Applicant’s exclusive right to use the mark in commerce. JMB owns U.S. Reg. No.

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<sup>1</sup> Application Serial No. 85278793, filed March 28, 2011 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), on the basis of Applicant’s asserted *bona fide* intention to use the mark in commerce. Applicant subsequently filed an allegation of use, stating June 1, 2008 as the date of first use and first use in commerce. No claim is made to the exclusive right to use BURRITO apart from the mark as shown.

4240116 for the mark BURRITO BANDITO for “Restaurant; Restaurant services” (the “JMB Registration”).<sup>2</sup>

Applicant seeks registration of its mark for “a geographic location defined by a 250 mile radius surrounding East 9th and Grand, Des Moines, Iowa plus an additional 50 mile radius clockwise from the 5 o’clock position to the 1 o’clock position.” This territorial restriction was initially set forth in Applicant’s petition to the Director filed July 17, 2015. As a result of a clerical error, it was stated incorrectly in the Board’s order instituting this concurrent use proceeding.

On February 5, 2016, the parties filed a “Joint Request to Amend Concurrent Use Proceeding No. 94002646,”<sup>3</sup> in which the territory allotted to Applicant was stated as set forth above. The Joint Request also stated:

Additionally, the parties jointly request that the territory of use for the registered mark having U.S. Registration No. 4240116, BURRITO BANDITO, owned by JMB, be amended to read as follows in order to reflect the language of U.S. Serial No. 85278793:

The area comprising the entire United States except for the geographic location defined by a 250 mile radius surrounding East 9th and Grand, Des Moines, Iowa plus an additional 50 mile radius clockwise from the 5 o’clock position to the 1 o’clock position.

Also on February 5, 2016, the parties filed a settlement agreement for the Board’s consideration and jointly moved to suspend this proceeding pending such review.<sup>4</sup> In

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<sup>2</sup> Reg. No. 4240116 issued November 13, 2012. No claim is made to the exclusive right to use BURRITO apart from the mark as shown.

<sup>3</sup> 4 TTABVUE.

<sup>4</sup> 5 TTABVUE.

the settlement agreement, the parties agree to limit the use of their respective marks “and advertisement of the same” to restaurants in their respective geographic territories, as set forth above. They also agree to “undertake to cooperate with each other to jointly take whatever additional steps are necessary to avoid customer confusion, including customer confusion at ‘border areas.’” The parties agree that if they are unable to agree to such additional steps, they shall “submit their separate proposals to mediation in the jurisdiction in which such customer confusion is likely to occur or is occurring.”<sup>5</sup> The agreement also provides that “JMB shall take the steps deemed necessary ... to help MOORE obtain a concurrent use trademark registration for ‘BANDIT BURRITO’ ...” for use in Applicant’s territory as set forth above.<sup>6</sup>

We construe the parties’ Joint Request to Amend and the settlement agreement as a stipulated request that that the USPTO issue a geographically restricted concurrent use registration to Applicant and that it amend the JMB Registration by entry of a geographic restriction and a reference to the concurrent use of Applicant.

The parties’ agreed measures for the avoidance of confusion are not extensive. However, we have been enjoined to give “substantial” and even “great” weight to agreements entered into between the parties in good faith, and to defer to the parties’ assessment of the likelihood of confusion. *See Amalgamated Bank v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1307 (Fed. Cir. 1988) (citing *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973)):

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<sup>5</sup> Agreement, ¶ 8 a-d, 5 TTABVUE 6.

<sup>6</sup> Agreement, ¶ 7, 5 TTABVUE 6.

Thus when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't.

*Du Pont*, 177 USPQ at 568.

[T]here can be no better assurance of the absence of any likelihood of confusion, mistake or deception than the parties' promises to avoid any activity which might lead to such likelihood.

*In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431, 437 (CCPA 1970).

[I]n trademark cases involving agreements reflecting parties' views on the likelihood of confusion in the marketplace,... they are in a much better position to know the real life situation than bureaucrats or judges and therefore such agreements may, depending on the circumstances, carry great weight....

*Bongrain Int'l (American) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987), quoted with approval in *Houlihan v. Parliament Import Co.*, 921 F.2d 1258, 17 USPQ2d 1208, 1212 (Fed. Cir. 1990); *see also Holmes Oil Co. v. Myers Cruizers of Mena, Inc.*, 101 USPQ2d 1148, 1150 (TTAB 2011) (accepting settlement agreement to resolve concurrent use proceeding even though "this agreement could be improved upon by including a more detailed statement listing [the] steps the parties will take should cases of actual confusion arise and an explanation of the reasons for the parties' belief that confusion is not likely.").

The parties have, by agreement, established mutually exclusive territories for their business operations and have committed to take whatever steps are necessary to prevent actual confusion. We assume that they are familiar with trade and market

practices for their industry as well as the realities of the marketplace and channels of trade for their services. We find that the measures set forth in the settlement agreement are sufficient to insure that use of the parties' marks within their respective geographic zones will not be likely to cause confusion, and that Applicant has shown that it is entitled to a concurrent use registration.

**Decision:**

Applicant is entitled to a registration of its mark that is restricted as follows:

Registration limited to the geographic location defined by a 250 mile radius surrounding East 9th and Grand, Des Moines, Iowa plus an additional 50 mile radius clockwise from the 5 o'clock position to the 1 o'clock position, pursuant to Concurrent Use Proceeding No. 94002646. Concurrent registration with Juan Mean Burrito, Inc., Registration No. 4240116.

The registration will contain a disclaimer of the exclusive right to use BURRITO apart from the mark as shown.

Registration No. 4240116 shall be restricted as follows:

Registration limited to the geographic area comprising the United States except the geographic location defined by a 250 mile radius surrounding East 9th and Grand, Des Moines, Iowa plus an additional 50 mile radius clockwise from the 5 o'clock position to the 1 o'clock position, pursuant to Concurrent Use Proceeding No. 94002646. Concurrent registration with Robert Moore, Application Serial No. 85278793.