

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

Mailed: July 14, 2017

Concurrent Use No. 94002752

Frasca Food and Wine, Inc.

v.

Dunlay's Roscoe, LLC

Before Ritchie, Masiello, and Coggins,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Frasca Food and Wine, Inc. (“Applicant”) filed an application, as amended, for concurrent use registration of the mark FRASCA¹ (in standard characters) for “restaurant and bar services,” in International Class 43.² With its concurrent use application, Applicant claims the exclusive right to use its mark in “the United States of America EXCEPT Illinois, Indiana, Michigan.” Applicant names as the excepted user Dunlay’s Roscoe, LLC (“Registrant”), which owns a geographically unrestricted registration on the Principal

¹ Application Serial No. 87021371 was filed on May 2, 2016, reciting dates of first use and first use in commerce as August 1, 2004.

² The application was originally submitted with a “Coexistence Agreement” which was rejected by the Examining Attorney as a “naked consent.” The application was later converted by amendment to a concurrent use application.

Register for the mark FRASCA, in standard character format, for “bar and restaurant services,” in International Class 43.³

On May 9, 2017, the concurrent use application was published for opposition, and on June 29, 2017, the Board instituted this concurrent use proceeding and suspended proceedings to consider the parties’ original “Coexistence Agreement” and their later “Concurrent Use Agreement.” By way of the Concurrent Use Agreement, Applicant and Registrant have noted, *inter alia*, that they have been using their respective marks in connection with their identified services in their respective geographical areas for “more than ten (10) years without any instances of confusion or other conflict,” and that they “operate substantially different restaurants, offer substantially different products at different price points, and market to different consumers through separate trade channels.”⁴ The parties have agreed that Registrant will use its FRASCA mark in connection with its restaurants only “within the geographic area encompassed by the states of Illinois, Michigan and Indiana” and that Applicant will use its FRASCA mark in connection with bar and restaurant services only “within the entire United States, excluding the geographic area encompassed by the states of Illinois, Michigan and Indiana.”⁵

The parties agree to terms that address potentially overlapping marketing or other activities which could result in confusion, agree to avoid a likelihood

³ Registration No. 3899836, issued on January 4, 2011.

⁴ 3 TTABVUE 4.

of customer confusion between their marks, and agree to take steps to cooperate and resolve issues should any arise.⁶

Concurrent use agreements that include information as to why the parties believe confusion is unlikely, evidencing the parties' business-driven belief that there is no likelihood of confusion, and providing provisions to avoid any potential confusion, are entitled to great weight in favor of a finding that confusion is not likely. *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *Bongrain Int'l (Am.) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987). Based upon the foregoing, we find that concurrent use of the involved marks is not likely to cause confusion, mistake or deception in accordance with Section 2(d) of the Trademark Act. *See* Trademark Trial and Appeal Board Manual of Procedure § 1110 and cases cited therein. Accordingly, Applicant is entitled to the concurrent use registration it seeks, and Registrant's registration will be restricted geographically as agreed upon by the parties.

Specifically, Applicant shall be granted a registration in due course based on its application Serial No. 87021371 for the territory comprising "the entire United States, excluding the geographic area encompassed by the states of Illinois, Michigan and Indiana." Registrant's Registration No. 3899836 shall be geographically restricted to the territory comprising "the states of Illinois, Michigan and Indiana."

⁵ 3 TTABVUE 4.

⁶ 3 TTABVUE 5.

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It is so ordered.