

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

McCarthy/Butler

Mailed: April 21, 2020

Cancellation No. 92066434

*Birth to Three & Beyond Pediatric Therapies,  
LLC, dba The Therapy Tree, LLC  
(Application No. 87184418)*

*v.*

*Therapy Tree PLLC  
(Registration No. 4913538)*

---

Concurrent Use No. 94002929

*Birth to Three & Beyond Pediatric Therapies,  
LLC, dba The Therapy Tree, LLC  
(Application No. 87184418)*

*v.*

*Therapy Tree PLLC  
(Registration No. 4913538)*

**By the Trademark Trial and Appeal Board:**

Therapy Tree PLLC (“Respondent”) owns Registration No. 4913538 for the mark **THERAPY TREE** for “speech, occupational and physical therapy” in International Class 44.<sup>1</sup> Birth to Three & Beyond Pediatric Therapies, LLC, dba The Therapy Tree,

---

<sup>1</sup> Registered on March 8, 2016, claiming a date of first use anywhere and a date of first use in commerce of October 6, 2014.

LLC (“Petitioner”) sought to cancel Respondent’s registration on the grounds of priority of use and likelihood of confusion. 1 TTABVUE. Petitioner claims ownership



of the mark for, inter alia, therapy (including speech and language therapy, occupational therapy, physical therapy, massage therapy, pediatric oral motor feeding therapy and psychotherapy) in International Class 44; and marriage counseling, personal development counseling, and family counseling in International Class 45.<sup>2</sup>

On July 23, 2019, the parties filed a Joint Stipulation for Suspension and Conversion to Concurrent Use Proceeding (“Stipulation”) indicating that the parties have settled their dispute and that Petitioner had amended its Application No. 87184418 to include a concurrent use claim. 40 TTABVUE 2-3. Petitioner recites its territory of use as the geographic area comprising the states of Illinois, Wisconsin, Iowa, Michigan, Minnesota, Indiana, and Ohio. At the parties’ request, the Board suspended proceedings to allow Petitioner’s application time to proceed through publication. 41 TTABVUE. Petitioner’s concurrent use application published on September 10, 2019 with no successful oppositions.

---

<sup>2</sup> Application No. 87184418, filed on September 27, 2016, claiming a date of first use anywhere and a date of first use in commerce of July 2010.

This proceeding now comes up for consideration of the parties' request to convert the cancellation proceeding to a concurrent use proceeding and the parties' Concurrent Use Agreement ("Agreement").

**MOTION TO AMEND TO CONCURRENT USE PROCEEDING AND WITHDRAW CANCELLATION**

A cancellation proceeding may be terminated in favor of a concurrent use proceeding when one party has a concurrent use application reciting the adverse party in the cancellation proceeding as an exception to its claim of exclusive use, the application is published for opposition, and no opposition is filed or the filed oppositions are all dismissed or withdrawn. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1113.02 (2019). Petitioner's Application No. 87184418 published on September 10, 2019 with no successful opposition and with the following concurrent use statement:

Subject to Concurrent Use Proceeding with Registration No. 4,913,538. Birth to Three & Beyond Pediatric Therapies, LLC d/b/a The Therapy Tree, LLC, claims the exclusive right to use the mark in the area comprising the states of Illinois, Wisconsin, Iowa, Michigan, Minnesota, Indiana, and Ohio. Concurrent registration with Therapy Tree PLLC, Suite E-540 20100 N. 51st Ave., Glendale, AZ 95308, owner of U.S. Reg. No. 4,913,538.

The Board notes that the parties have not filed a formal stipulation to dismiss the cancellation proceeding in favor of a concurrent use proceeding. However, Trademark Rule 2.114(c), 37 U.S.C. § 2.114, allows for a petition for cancellation to be withdrawn without prejudice before an answer is filed. Since no answer has been filed, and since both parties have signed the Stipulation and the Agreement, Cancellation No.

92066434 is hereby dismissed without prejudice.<sup>3</sup> Petitioner, as a concurrent use applicant, will remain the plaintiff in the concurrent use proceeding. Respondent, as registrant, will remain the defendant in the concurrent use proceeding. *See* TBMP § 1108 (“In a concurrent use proceeding, a junior party stands in the position of plaintiff, in that it is the applicant-plaintiff that is seeking to reduce the geographic area of the senior party-defendant, thereby making the senior party stand in the position of defendant.”).

### NOTICE OF INSTITUTION OF A CONCURRENT USE PROCEEDING

The applicant of Application No. 87184418 has applied for concurrent use registration for the trademark set forth below:

Name of applicant:	Birth to Three & Beyond Pediatric Therapies, LLC dba The Therapy Tree, LLC
Applicant’s address:	PO Box 764 89 Cedar Avenue Lake Villa, IL 60046
Applicant’s mark:	
Goods or services:	Speech and language therapy services; occupational therapy services; physical therapy; massage therapy; pediatric oral motor feeding therapy; health screening services in the field of pediatric developmental assessment; nutrition counseling; counseling in the field of mental health and wellness; psychotherapy and psychotherapy counseling for children and

---

<sup>3</sup> In view of the dismissal of the cancellation proceeding without prejudice, no further papers should be filed in Cancellation No. 92066434. All subsequent papers should use only the concurrent use portion of the case title listed at the top of this order, and should be filed in the concurrent use proceeding.

	adults in individual and family sessions in International Class 44; Marriage counseling; counseling in the field of personal development, namely, self-improvement, self-fulfillment, and interpersonal communication; counseling in the field of developing, strengthening and sustaining well-balanced families and family relationships in International Class 45
Filing date:	September 27, 2016
The territory of use:	The geographic area comprising the states of Illinois, Wisconsin, Iowa, Michigan, Minnesota, Indiana, and Ohio
Attorney:	Jeffrey Wakolbinger Katten Muchin Rosenman, LLP 525 West Monroe Street Chicago, IL 60661

In its application, Petitioner has recited as an exception to its allegation of exclusive use of said mark, use by Therapy Tree PLLC of an identical or very similar registered mark. This identical or very similar mark, the services, and the territory of use, *as acknowledged in* the referenced application, are set out below in a summary of details of the application.

The mark:	THERAPY TREE
Registration No.	4913538
The goods or services:	Speech, occupational and physical therapy in International Class 44
The territory of use:	The geographic area comprising the entire United States except the states of Illinois, Wisconsin, Iowa, Michigan, Minnesota, Indiana, and Ohio

The Office has determined that Petitioner's mark appears entitled to registration, subject to a concurrent use proceeding with Therapy Tree PLLC. Therefore, a concurrent use proceeding is hereby instituted under the provisions of Section 2(d) of the Trademark Act of 1946. This notice of institution is forwarded pursuant to

Trademark Rules 2.99(d)(1), and constitutes service of this proceeding. An electronic version of the proceeding is viewable on TTABVUE at <http://ttabvue.uspto.gov/ttabvue/>. See Trademark Rule 2.99(d)(1). The parties should diligently monitor this proceeding via TTABVUE.

The proceeding will be conducted in accordance with the Rules of Practice in Trademark Cases (“Trademark Rules”), as set out in Title 37 of the Code of Federal Regulations.

The parties to this proceeding must advise the Trademark Trial and Appeal Board of any relevant applications or registrations, other than those already referenced herein, which should be included in this concurrent use proceeding. Any response in this regard should be in writing.

#### **THE PARTIES’ CONCURRENT USE AGREEMENT**

The parties also submitted a copy of their executed Agreement on July 23, 2019. 40 TTABVUE 6-10. As a preliminary matter, the Board notes that Respondent’s Registration No. 4913538 is incorrectly listed in paragraphs 2 and 5 of the Agreement as either “4913358” or “3913358”. Paragraph 12 lists the Registration No. as 4913538. In accordance with the Stipulation, signed by both parties, and paragraph 12 of the Agreement, the Board assumes 4913538 to be the correct number for Respondent’s registration. The parties have **15 days** to notify the Board if this presumption is incorrect.

Substantively, the Agreement provides that the parties are unaware of any instance of actual confusion even though they have coexisted for approximately six

years; that, because the nature of the services attract localized clientele, concurrent use of the parties' respective marks is unlikely to create consumer confusion as to the source of the parties' respective services; that the parties will use their respective marks to avoid confusion and that should one party become aware of an actual instance of consumer confusion, it will promptly notify the other so that both shall discuss and cooperate to eliminate the confusion; that the parties agree not to use or directly advertise their services under their respective marks in the other's geographic region, but acknowledges that the parties have limited rights regarding promotions at conferences and publications; and that future applications by each party to register the THERAPY TREE mark will contain the same geographic restrictions. *Id.* at 6-8. The parties also acknowledge that each may maintain online and social media use. *Id.*

Such provisions are of the type that support concurrent use registration for each party. 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 assessed not only the provisions of the Agreement, but also that the parties voluntarily entered 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).

## DECISION

Entry of concurrent use is deferred for **15 days** to allow the parties time to inform the Board if its presumption regarding Respondent's Registration No. 4913538 is incorrect. At the end of the 15 day period, if the Board receives no communications from either party, the concurrent use proceeding will be processed as follows:

Concurrent use registration is **approved** for Petitioner's pending application for



the mark  for speech and language therapy services; occupational therapy services; physical therapy; massage therapy; pediatric oral motor feeding therapy; health screening services in the field of pediatric developmental assessment; nutrition counseling; counseling in the field of mental health and wellness; psychotherapy and psychotherapy counseling for children and adults in individual and family sessions in International Class 44; and marriage counseling; counseling in the field of personal development, namely, self-improvement, self-fulfillment, and interpersonal communication; counseling in the field of developing, strengthening and sustaining well-balanced families and family relationships in International Class 45. Restriction of Respondent's Registration No. 4913538 for the mark **THERAPY TREE** for "speech, occupational and physical therapy" in International Class 44 is **approved**. The concurrent use statements will read as follows:

Cancellation No. 92066434; Concurrent Use No. 94002929

**Birth to Three & Beyond Pediatric Therapies, LLC dba The Therapy Tree, LLC's Application No. 87184418**

Registration limited to the area comprising the states of Illinois, Wisconsin, Iowa, Michigan, Minnesota, Indiana, and Ohio pursuant to Concurrent Use No. 94002929. Concurrent registration with Therapy Tree PLLC (Registration No. 4913538).

**Therapy Tree PLLC's Registration No. 4913538**

Registration limited to the area comprising the entire United States except the states of Illinois, Wisconsin, Iowa, Michigan, Minnesota, Indiana, and Ohio pursuant to Concurrent Use No. 94002929. Concurrent registration with Birth to Three & Beyond Pediatric Therapies, LLC dba The Therapy Tree, LLC (Application No. 87184418).