

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DUNN

Mailed: September 9, 2009

Concurrent Use No. 94002334

Mr. Electric Corp.

v.

Sunburst Electric (California)

v.

Sunburst Electric (Michigan)


v.

Sun Burst Electric, Inc. (New
Mexico)

**Before Bucher, Kuhlke, and Taylor, Administrative Trademark
Judges:**

By the Board:

On February 21, 2007, Mr. Electric Corp. filed two concurrent use applications to register the marks shown below for "electrical repair, maintenance, installation and inspection services", both applications subsequently amended to allege first use since January 31, 2007 and first use in commerce since February 12, 2007.

	<p>SUNBURST ELECTRIC</p>
<p>App. Serial No. 77112684</p>	<p>App. Serial No. 77112688</p>

Mr. Electric Corp. seeks registration for the geographic area comprising the United States, excluding the Los Angeles, California metropolitan area including specifically Huntington Beach, California; the Albuquerque, New Mexico metropolitan area including specifically Bernalillo, New Mexico; and the counties of Ingham, Livingston, Macomb, Oakland, Wayne, Washentaw, Antrium, Charlevoix, Crawford, Emmet, Grand Traverse, Kalkaska, Leelanau, and Oteogo in Michigan.

Stated as exceptions to Mr. Electric Corp.'s right to exclusive use are common law users Sunburst Electric (CA), Sun Burst Electric, Inc. (NM), and Sunburst Electric (MI). Mr. Electric Corp. acknowledges that the three other entities were using the marks SUNBURST ELECTRIC on electrical related goods and services in specific geographic areas prior to the filing date of its applications.¹

¹ While the concurrent use statement published with the applications inadvertently omits the names of the excepted users, applicant supplied this information, and the modes of use, during examination.

On December 30, 2008, having received no answer to the institution order setting forth the rights claimed by Mr. Electric Corp., the Board granted an extension of time to answer for Sunburst Electric (MI), and entered default judgment against Sunburst Electric (CA), and Sun Burst Electric, Inc. (NM). On April 14, 2009, the Board entered default judgment against Sunburst Electric (Michigan), and allowed Mr. Electric Corp. to prove its entitlement to the concurrent use registration sought by an *ex parte* type of showing as against the three excepted users. On April 16, 2009, Mr. Electric Corp. submitted its proof of its entitlement to the concurrent use registration. The delay in acting upon this matter is regretted.

Mr. Electric Corp.'s evidence includes a settlement agreement with Sunburst Electric (MI) executed December 18, 2008, an attached consented amendment to the concurrent use application, and the April 13, 2009 declaration of Jeffrey Meyers, president of Mr. Electric Corp.

SETTLEMENT AGREEMENT WITH SUNBURST ELECTRIC (MI)

The settlement agreement between applicant and Sunburst Electric (MI) provides that Sunburst Electric (MI) was using the marks SUNBURST and SUNBURST ELECTRIC prior to the filing by Mr. Electric Corp. of its concurrent use applications, that the parties exchanged information regarding the scope

of Sunburst Electric (MI)'s use in the state of Michigan, and that the parties agreed to amend the concurrent use statement to reflect a greater geographic area for Sunburst Electric (MI) than originally described. The parties submitted a consented amendment by which Sunburst Electric (Michigan)'s geographic area is amended from:

Michigan, including specifically the city of Pinckney, Michigan, and Washtenaw County, Michigan

to:

the counties of Ingham, Livingston, Macomb, Oakland, Wayne, Washentaw, Antrium, Charlevoix, Crawford, Emmet, Grand Traverse, Kalkaska, Leelanau, and Oteogo in Michigan

Inasmuch as the proposed change does not expand the geographic area claimed by Mr. Electric Corp., it is approved. See Trademark Rule 2.133(a).²

In the settlement agreement the parties further provide that Mr. Electric Corp.'s geographic area of use is the United States, excluding the Los Angeles, California metropolitan area including specifically Huntington Beach, California; the Albuquerque, New Mexico metropolitan area including specifically Bernalillo, New Mexico; and the counties of Ingham, Livingston, Macomb, Oakland, Wayne, Washentaw, Antrium, Charlevoix, Crawford, Emmet, Grand

² Inasmuch as default judgment has been entered against Sunburst Electric (MI), its consent to the amendment is not necessary.

Traverse, Kalkaska, Leelanau, and Oteogo in Michigan; that each party has the exclusive right to use their respective marks in their specified geographic area; that each party will refrain from contesting the exclusive right to use and register the other's mark with the geographic restriction or from taking any action inconsistent with the other party's rights; and that each party shall undertake all actions necessary to avoid likelihood of confusion.

EX PARTE SHOWING WITH RESPECT TO SUNBURST ELECTRIC (CA) AND SUN BURST ELECTRIC, INC. (NM)

In his declaration, applicant's President, Jeffrey Meyers, states, *inter alia*, that Mr. Electric Corp. is a nationwide franchisor of electrical repair, maintenance, and installation services, which operates under the franchise name and mark MR. ELECTRIC; that Mr. Electric Corp. adopted, used, and licenses third parties to use, the SUNBURST ELECTRIC marks in connection with electrical repair, maintenance, and installation service in those geographic areas where the MR. ELECTRIC services are not available; that the settlement agreement with Sunburst Electric (MI) provides a clear geographic division of areas in which the parties will use their SUNBURST ELECTRIC marks; that the geographic division is designed to avoid possible confusion of the consuming public; that based on Mr. Electric Corp.'s investigation, the two other excepted users of SUNBURST

ELECTRIC marks each operate a single location in Huntington Beach, California and Bernalillo, New Mexico; that applicant has amended its applications to exclude not only Huntington Beach, California and Bernalillo, New Mexico but the surrounding metropolitan areas of Los Angeles and Albuquerque; that applicant has MR. ELECTRIC franchises in both the Los Angeles and Albuquerque metropolitan areas; that because applicant is using its main franchise mark MR. ELECTRIC in both the Los Angeles and Albuquerque metropolitan areas, and does not use the SUNBURST ELECTRIC marks in those geographic areas where the MR. ELECTRIC services are available, applicant does not intend to expand use of or advertising for its SUNBURST ELECTRIC marks to the Los Angeles and Albuquerque metropolitan areas; and that if applicant encounters any actual confusion with Sunburst Electric (CA) and Sun Burst Electric, Inc. (NM), applicant will cooperate with each party in order to avoid such confusion.

DISCUSSION

A party is not entitled to a concurrent use registration unless the "touchstone" requirement of no likelihood of confusion to the public is met. *See Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987). In this case, the parties use the same or

highly similar SUNBURST mark on similar electrical services. As noted above, applicant Mr. Electric Corp. and excepted user Sunburst Electric (MI) entered into an agreement for concurrent use of their marks, and we find that the agreement establishes a prima facie case that the concurrent use of the involved marks is not likely to lead to confusion. In making this determination, the Board has taken into account not only the provisions of the settlement agreement and actual geographic restrictions of each party's area of use, but also the voluntary entrance by the parties into an agreement of concurrent use when it would clearly be against their business interests to cause confusion on the part of the public. See *Amalgamated Bank of New York v. Amalgamated Trust and Savings*, 842 F.2d 1270, 6 USPQ2D 1305 (Fed. Cir. 1988).

With respect to the other two excepted users, we find that Mr. Electric Corp.'s evidence of use in separate geographic areas and the provisions to avoid any confusion of present and prospective customers also establishes a prima facie case that the concurrent use of the involved marks is not likely to lead to confusion. Moreover, we find that the averments in Mr. Meyer's declaration regarding creation of a buffer zone around the locations for Sunburst Electric (CA) and Sun Burst Electric, Inc. (NM)'s services further support a finding that no confusion is likely. See

Precision Tune Inc. v. Precision Anti-Tune Inc., 4 USPQ2d 1095 (TTAB 1987).

Upon careful consideration of Mr. Electric Corp.'s [different type size?] evidence, the Board is persuaded that under the circumstances of this case, concurrent use by these parties of their involved marks will not, in fact, be likely to cause confusion.

DECISION

Plaintiff Mr. Electric Corp. is entitled to registration of the SUNBURST ELECTRIC marks set forth earlier in this order for its "electrical repair, maintenance, installation and inspection services" for the area comprising the United States, excluding the Los Angeles, California metropolitan area including specifically Huntington Beach, California; the Albuquerque, New Mexico metropolitan area including specifically Bernalillo, New Mexico; and the counties of Ingham, Livingston, Macomb, Oakland, Wayne, Washentaw, Antrium, Charlevoix, Crawford, Emmet, Grand Traverse, Kalkaska, Leelanau, and Oteogo in Michigan (application Serial Nos. 77112684 and 77112688).
