

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

Mailed: August 15, 2011

Concurrent Use No. 94002351

Critical Homecare Solutions,
Inc.

v.

Catholic Health Services of
Long Island and/or CHS Home
Support Services

Before Grendel, Holtzman and Shaw, Administrative Trademark
Judges.

By the Board:

Critical Homecare Solutions (hereinafter "applicant") seeks a concurrent use registration for the mark CHS¹ for "home health care services, namely, home infusion therapy, nursing, specialty pharmacy, namely, preparation and dispensing of medications, and respiratory services; leasing of home medical equipment and supplies." Applicant's claimed territory of use is the area comprising the "United States except in the counties of Nassau, Suffolk, and Queens in the state of New York." Applicant names Catholic Health Services of Long Island and/or CHS Home Support Services as

¹ Application Serial No. 77012845, filed October 3, 2006, claiming as its date of first use and as its date of first use in commerce as June 2, 2007.

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an exception to its exclusive right to use its mark. In an order dated May 5, 2009, the Board entered default judgment against user Catholic Health Services of Long Island and/or CHS Home Support Services. Trademark Rule 2.99(d)(3).

The entry of judgment has the effect of precluding Catholic Health Services of Long Island and/or CHS Home Support Services, the named excepted user, from claiming any right more extensive than that acknowledged in the involved concurrent use application. *Id.* See also TBMP § 1107 (3d ed. 2011). The Board, in its order, also allowed applicant time in which to submit proof of its entitlement to registration. Trademark Rule 2.99(e). Applicant filed a response on June 29, 2009.

There are two requirements for issuance of a concurrent use registration in a proceeding before the Board. First, a concurrent use applicant needs to meet the jurisdictional requirement of good faith use in commerce. Second, a concurrent use applicant also must show that use of the mark for which it seeks a concurrent registration will not result in a likelihood of confusion. See Section 2(d) of the Trademark Act. See also TBMP § 1101.01 (3d ed. 2011). Applicant has submitted proof that there is no likelihood of confusion but it has not submitted evidence that it is a good faith user of the mark.

Jurisdictional Issues

Generally, concurrent rights arise when a party, in good faith, and without knowledge of a prior party's use in another geographic area, adopts and uses the same or similar mark for the same or similar goods or services within its own geographic area. TBMP § 1103.01(d)(2). However, where a junior user appropriates a mark with knowledge that it is actually being used by another, that use is not believed to be a good faith use and such a user is not entitled to concurrent use registration. *Woman's World Shops Inc. v. Lane Bryant Inc.*, 5 USPQ2d 1985 (TTAB 1988).

Applicant filed its intent to use application identifying the excepted user on October 3, 2006. The concurrent use statement, as amended on October 17, 2006, reads:

To the best of Applicant's knowledge, Catholic Health Services of Long Island and/or CHS Home Support Services potentially have common law rights in the CHS mark or a confusingly similar mark for use with identical services in the excepted geographic area since 12/31/2001.

On April 3, 2008 applicant filed an Amendment to Allege use with a date of first use of the mark of June 2, 2007. That is, applicant claims to have begun using the mark 8 months after the filing of the original application identifying the excepted user.

Applicant does not appear to be a good faith user entitled to a concurrent use registration because, according to its dates of use, applicant first used its mark with

knowledge that the same mark was already being used by the excepted user on the same or similar services. Applicant must explain how it is entitled to a concurrent use registration in light of the foregoing. Trademark Rule 2.99(d)(3).

Likelihood of Confusion Showing

In support of its entitlement to a concurrent use registration of its mark as against the defaulting user, applicant has submitted the declaration of Nitin Patel, applicant's Senior Vice President of Operations. In his declaration Mr. Patel declares:

Upon information and belief Catholic Health Services of Long Island and/or CHS Home Support Services (the "User") is an integrated healthcare delivery system which conducts business in Long Island, New York.

Upon information and belief, the User operates only in Nassau, Suffolk, and Queens counties in the state of New York.

Through its subsidiaries, CHS [applicant] operates in a number of states, primarily in the Southeast, Midwest and Northeast regions of the United States. CHS does not currently operate in New York.

The areas where CHS operates and does business are geographically remote from the New York areas, or any area where CHS is likely to operate.

CHS will not conduct business in the New York Counties under the CHS mark. CHS will also not advertise in local media located within the New York Counties directed to inhabitants of the New York Counties, so long as the User continues to use its mark in connection with home health care services.

CHS is not aware of any actual confusion with the User to date. If CHS encounters any actual consumer confusion between its CHS mark and User's trademark, CHS will cooperate reasonably with the User in order to thereafter avoid such confusion.

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Regarding the likelihood of confusion showing, we find that applicant has established, *prima facie*, as to the named excepted user, that concurrent use of its mark is not likely to lead to confusion, mistake or deception. Accordingly, this showing is approved, but a concurrent use registration will not be approved until applicant has addressed the jurisdictional issues above.

Applicant is allowed until **THIRTY DAYS** from the mailing date on this order in which to submit proof of its entitlement to registration, failing which concurrent use registration to applicant will be refused, and the concurrent use proceeding will be dissolved with prejudice.