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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	94002373
Party	Applicant Asbury Automotive Group, Inc.
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Date	06/04/2010
Attachments	RESPONSE_TO_ORDER.pdf ( 11 pages )(441714 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----X		
ASBURY AUTOMOTIVE GROUP, INC.,	:	
	:	
Applicant,	:	
	:	
v.	:	Concurrent Use No. 94002373
	:	Serial No. 77/194,297
CROWN AUTOMOTIVE MANAGEMENT, INC.,	:	
	:	
Respondent.	:	
	:	
v.	:	
	:	
CROWN AUTOMOBILE CO., INC.,	:	
	:	
Respondent.	:	
-----X		

**APPLICANT’S RESPONSE TO ORDER**

By an Order of June 1, 2010, the Trademark Trial and Appeal Board requested further information concerning the settlement of this concurrent use proceeding.

By a Settlement Agreement entered into as of December 10, 2009, Applicant and Respondent Crown Automotive Management Inc. (“CAM”) agreed that Applicant could have a concurrent use registration for the States of New Jersey, North Carolina, South Carolina and Virginia. Applicant and its predecessor have used the mark CROWN for its automobile dealerships in those states for more than 30 years. Applicant acknowledged that Respondent CAM has exclusive rights to use CROWN for its automobile dealerships in Florida and Ohio. Respondent CAM has used the mark for more than 30 years in those states. A copy of the Settlement Agreement is attached.

By a separate Settlement Agreement entered into as of May 4, 2010, Applicant and Respondent Crown Automobile Co., Inc. (“CAC”) agreed that Applicant could have a concurrent use registration for the States of New Jersey, North Carolina South Carolina and Virginia. Applicant acknowledged that Respondent CAC has exclusive rights to use CROWN for its automobile

dealership in Alabama. Respondent CAC has used the mark for more than 30 years in that state. A copy of the Settlement Agreement is attached.

Accordingly, by the two Settlement Agreements, all parties to this concurrent use proceeding have agreed that:

1. The parties operate their businesses in separate defined geographic markets, with both Respondents separated by a buffer from Applicant.
2. The parties have operated their businesses for more than 30 years without likelihood of confusion, and that confusion is not likely in the future.
3. The parties have agreed to the use of their respective URLs for their websites, and that use of their respective marks on their websites is not likely to cause confusion.

Therefore, it is respectfully submitted that the concurrent use proceeding should be terminated and the concurrent use registration issued to Applicant

Respectfully,

COOPER & DUNHAM LLP

Dated: June 4, 2010

By: /norman h. zivin/  
Norman H. Zivin  
30 Rockefeller Plaza  
20<sup>th</sup> Floor  
New York, New York 10112  
Tel: (212) 278-0400  
Attorneys for Applicant

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing APPLICANT'S RESPONSE TO ORDER was served on this 4<sup>th</sup> of June, 2010 by first class mail on the following attorneys of record:

Howard P. Walthall Jr.  
Burr & Forman LLP  
420 North 20<sup>th</sup> Street  
Suite 3400  
Birmingham, Alabama 35203

and:

C. Douglas McDonald  
Carlton Fields, P.A.  
P.O. Box 3239  
Tampa, Florida 33601-3239

\_\_\_\_\_  
/norman h. zivin/  
Norman H. Zivin

## SETTLEMENT AGREEMENT

This Settlement Agreement (the "Agreement") is entered into as of December 10, 2009, (the "Effective Date"), by and between **Asbury Automotive Group Inc.**, ("Applicant") a corporation of the State of Delaware, having an address of 2905 Premiere Parkway, Suite 300, Duluth, GA 30097, and **Crown Automotive Management Inc.** ("Respondent"), a corporation of the State of Florida, having an address 6001 34<sup>th</sup> Street N, St. Petersburg, FL 33714, Applicant and Respondent being referred to, collectively, as the "Parties."

Applicant has applied, in concurrent use proceeding No. 94002373 in front of the United States Patent and Trademark Office, for a concurrent use registration of the service mark CROWN for motor vehicle dealership services, claiming exclusive rights based on long use only in the states of New Jersey, North Carolina, South Carolina and Virginia. Applicant has advertised those services in numerous other states.

Respondent has long used the service mark CROWN for motor vehicle dealership services in the States of Florida and Ohio and has advertised those services in numerous other states, and has opposed the concurrent use application of Applicant.

Both Applicant and Respondent desire to resolve the disputes between them with regard to ownership rights in the service mark CROWN for motor vehicle dealership services, and are willing to compromise their claims in this dispute to obtain such resolution.

### AGREEMENT

NOW, THEREFORE, in consideration of the mutual covenants set forth below, Applicant and Respondent, intending to be legally bound, hereby agree as follows:

1. Respondent will withdraw its opposition to, and consent to registration of, the application by Applicant for concurrent use registration of the service mark CROWN or CROWN AUTOMOTIVE for motor vehicle dealership services and related business operations limited to the states of New Jersey, North Carolina, South Carolina and Virginia, and allow such concurrent use application to proceed to registration.
2. Respondent acknowledges the exclusive rights of Applicant to use the service mark CROWN or CROWN AUTOMOTIVE in operating motor vehicle dealerships and related business operations in the States of New Jersey, North Carolina, South Carolina and Virginia.
3. Applicant acknowledges the exclusive rights of Respondent to use the service mark CROWN or CROWN CARS in operating motor vehicle dealerships and related business operations in the States of Florida and Ohio.
4. The Parties acknowledge that, as between the two Parties, neither of the Parties owns exclusive rights to the service mark CROWN for motor vehicle dealership services in any states other than those set forth in paragraphs 2 and 3 above, and agree that neither of the Parties will pursue a claim of such exclusive rights in any of those other states in the future.

5. The Parties agree that use and registration of the service mark CROWN in connection with motor vehicle dealership services and related business operations, as set forth in paragraphs 1-3 above, is not likely to cause confusion, mistake or to deceive the public, and each of the Parties agrees to concurrent registration of the other for those states specified.

6. Applicant agrees that use of the uniform resource locator (URL) "crown cars.com" by Respondent is not likely to cause confusion with any rights that Applicant owns or may own either in the service mark CROWN, or in any URL that Applicant owns, uses, or may own or may use. Applicant specifically agrees to the use by Respondent of the URL "crown cars.com" for Respondent's website.

7. Respondent agrees that use by Applicant of the URL "crown auto.com" is not likely to cause confusion with any rights that Respondent owns or may own in the service mark CROWN or in any URL that Respondent owns or uses or may own or may use. Respondent specifically agrees to the use by Applicant of the URL "crown auto.com" for Applicant's website.

8. Respondent will execute and file with the Trademark Trial and Appeal Board ("TTAB") a stipulation and letter of consent agreeing to Applicant's concurrent use registration limited to the States of New Jersey, North Carolina, South Carolina and Virginia, for the service mark CROWN or CROWN AUTOMOTIVE for motor vehicle dealership services.

9. Both Parties recognize, acknowledge and agree that use by either of the Parties of the service mark CROWN in offering motor vehicle dealership services and related business operations throughout the United States on the Parties' respective websites shall not be considered by either of the Parties to infringe any rights that either of the Parties may have.

10. The Parties understand and acknowledge that the promises made in this Agreement, are a full, final and complete settlement of all claims of any kind, known or unknown, actual or potential, that either Party has, had or at any time may have had for any acts, omissions, conduct of any kind relating to ownership of the service mark CROWN for motor vehicle dealership services.

11. The Parties understand that the exchange of promises stated herein is not to be considered an admission of any Party of any fault or liability whatsoever.

12. Both Applicant and Respondent acknowledge that they have been represented by counsel at all times and that no representation of fact or opinion has been made to them by the other Party that in any manner has induced either of the Parties to agree to this Settlement. Furthermore, Applicant and Respondent acknowledge that they have received, reviewed and executed this Settlement Agreement in consultation with counsel and further represent that they have read and understood this Settlement Agreement and that they intend to be bound by each provision contained herein.

13. This Settlement Agreement may be executed in two or more counterparts, each of which shall be deemed an original, but all of which together shall constitute but one and the same instrument.

14. This Settlement Agreement constitutes the entire agreement between the Parties relating to the subject matter, and may not be modified or waived except by a writing executed by both parties.

15. This Settlement Agreement shall be construed and enforced in accordance with the trademark laws of the United States.

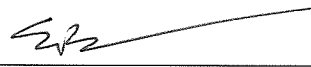
16. Nothing obtained in this Settlement Agreement shall be construed as making entire Party a licensee or agent of the other party.

17. Any notices required or necessary in accordance with this Settlement Agreement shall be sent by first class mail, with a copy by email, addressed to the Parties as stated above, and to their counsel.

IN WITNESS WHEREOF, the Settlement Agreement has been duly executed as of the day and year set forth below.

DATE: December 29, 2009

**Asbury Automotive Group Inc.**


By: 

Name: Elizabeth B. Chandler

Title: Vice President, General Counsel & Secretary

DATE: 1/27/10

**Crown Automotive Management Inc.**

By: 

Name: Thomas J. DeFuria

Title: CEO

## SETTLEMENT AGREEMENT

This Settlement Agreement (the "Agreement") is entered into as of May 4, 2010, (the "Effective Date"), by and between **Asbury Automotive Group Inc.**, ("Applicant") a corporation of the State of Delaware, having an address of 2905 Premiere Parkway, Suite 300, Duluth, GA 30097, and **Crown Automobile Co., Inc.** ("Respondent"), a corporation of the State of Alabama, having an address 1800 Montgomery Highway, Birmingham, Alabama 35244, Applicant and Respondent being referred to, collectively, as the "Parties."

Applicant has applied, in concurrent use proceeding No. 94002373 in front of the United States Patent and Trademark Office, for a concurrent use registration of the service mark CROWN for motor vehicle dealership services, claiming exclusive rights based on long use only in the states of New Jersey, North Carolina, South Carolina and Virginia. Applicant has advertised those services in numerous other states.

Respondent has long used the service mark CROWN for motor vehicle dealership services in the State of Alabama, has actively advertised those services in numerous other states (including specifically Alabama, Mississippi, Tennessee and the panhandle of Florida) and has opposed the concurrent use application of Applicant.

Both Applicant and Respondent desire to resolve the disputes between them with regard to ownership rights in the service mark CROWN for motor vehicle dealership services, and are willing to compromise their claims in this dispute to obtain such resolution.

### AGREEMENT

NOW, THEREFORE, in consideration of the mutual covenants set forth below, Applicant and Respondent, intending to be legally bound, hereby agree as follows:

1. Respondent will withdraw its opposition to, and consent to registration of, the application by Applicant for concurrent use registration of the service mark CROWN or CROWN AUTOMOTIVE for motor vehicle dealership services and related business operations limited to the states of New Jersey, North Carolina, South Carolina and Virginia, and allow such concurrent use application to proceed to registration.

2. Respondent acknowledges the exclusive rights of Applicant to use the service mark CROWN or CROWN AUTOMOTIVE in operating motor vehicle dealerships and related business operations in the States of New Jersey, North Carolina, South Carolina and Virginia.

3. Applicant acknowledges the exclusive rights of Respondent to use the service mark CROWN, CROWN AUTOMOTIVE, CROWN AUTOMOBILE, CROWN MERCEDES, CROWN INFINITI, CROWN SMART and CROWN SPRINTER in operating motor vehicle dealerships and related business operations in the State of Alabama. Applicant further acknowledges the exclusive rights of Respondent to engage in locally targeted



advertising (as opposed to general advertising on the internet) in the States of Alabama, Mississippi, Tennessee and the panhandle of Florida using these service marks.

4. The Parties acknowledge that, as between the two Parties, neither of the Parties owns exclusive rights to the service mark CROWN for motor vehicle dealership services in any states other than those set forth in paragraphs 2 and 3 above, and agree that neither of the Parties will pursue a claim of such exclusive rights in any of those other states in the future.

5. The Parties agree that use and registration of the service mark CROWN in connection with motor vehicle dealership services and related business operations, as set forth in paragraphs 1-3 above, is not likely to cause confusion, mistake or to deceive the public, and each of the Parties agrees to concurrent registration of the other for those states specified.

6. Applicant agrees that use of the CROWN service mark by Respondent in connection with Respondent's website, including the use of the uniform resource locator (URL) "crownautomobile.com," is not likely to cause confusion with any rights that Applicant owns or may own either in the service mark CROWN, or in any URL that Applicant owns, uses, or may own or may use. Applicant specifically agrees to the use by Respondent of the URL "crownautomobile.com" for Respondent's website.

7. Respondent agrees that use of the CROWN service mark by Applicant in connection with Applicant's website, including the use of the uniform resource locator (URL) "crownauto.com," is not likely to cause confusion with any rights that Respondent owns or may own in the service mark CROWN or in any URL that Respondent owns or uses or may own or may use. Respondent specifically agrees to the use by Applicant of the URL "crownauto.com" for Applicant's website.

8. Respondent will execute and file with the Trademark Trial and Appeal Board ("TTAB") a stipulation and letter of consent agreeing to Applicant's concurrent use registration limited to the States of New Jersey, North Carolina, South Carolina and Virginia, for the service mark CROWN or CROWN AUTOMOTIVE for motor vehicle dealership services.

9. Both Parties recognize, acknowledge and agree that use by either of the Parties of the service mark CROWN in offering motor vehicle dealership services and related business operations throughout the United States on the Parties' respective websites shall not be considered by either of the Parties to infringe any rights that either of the Parties may have.

10. The Parties understand and acknowledge that the promises made in this Agreement, are a full, final and complete settlement of all claims of any kind, known or unknown, actual or potential, that either Party has, had or at any time may have had for any acts, omissions, conduct of any kind relating to ownership of the service mark CROWN for motor vehicle dealership services.

11. The Parties understand that the exchange of promises stated herein is not to be considered an admission of any Party of any fault or liability whatsoever.

12. Both Applicant and Respondent acknowledge that they have been represented by counsel at all times and that no representation of fact or opinion has been made to them by the other Party that in any manner has induced either of the Parties to agree to this Settlement. Furthermore, Applicant and Respondent acknowledge that they have received, reviewed and executed this Settlement Agreement in consultation with counsel and further represent that they have read and understood this Settlement Agreement and that they intend to be bound by each provision contained herein.

13. This Settlement Agreement may be executed in two or more counterparts, each of which shall be deemed an original, but all of which together shall constitute but one and the same instrument.

14. This Settlement Agreement constitutes the entire agreement between the Parties relating to the subject matter, and may not be modified or waived except by a writing executed by both parties.

15. This Settlement Agreement shall be construed and enforced in accordance with the trademark laws of the United States.


16. Nothing obtained in this Settlement Agreement shall be construed as making entire Party a licensee or agent of the other party.

17. Any notices required or necessary in accordance with this Settlement Agreement shall be sent by first class mail, with a copy by email, addressed to the Parties as stated above, and to their counsel.

IN WITNESS WHEREOF, the Settlement Agreement has been duly executed as of the day and year set forth below.

DATE: \_\_\_\_\_

**Asbury Automotive Group Inc.**

By:   
Name: Elizabeth B. Chandler  
Title: VP & GC

DATE: \_\_\_\_\_

**Crown Automobile Co., Inc.**

By: \_\_\_\_\_  
Name: \_\_\_\_\_  
Title: \_\_\_\_\_

12. Both Applicant and Respondent acknowledge that they have been represented by counsel at all times and that no representation of fact or opinion has been made to them by the other Party that in any manner has induced either of the Parties to agree to this Settlement. Furthermore, Applicant and Respondent acknowledge that they have received, reviewed and executed this Settlement Agreement in consultation with counsel and further represent that they have read and understood this Settlement Agreement and that they intend to be bound by each provision contained herein.

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IN WITNESS WHEREOF, the Settlement Agreement has been duly executed as of the day and year set forth below.

DATE: \_\_\_\_\_

**Asbury Automotive Group Inc.**

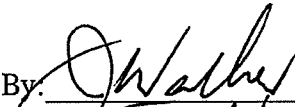
By: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_

DATE: \_\_\_\_\_

**Crown Automobile Co., Inc.**

By:  \_\_\_\_\_  
Name: JOHN WALKER

Title: GENERAL MANAGER