

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

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Mailed: August 21, 2009

Opposition No. 91157005

PUBLIC STRATEGIES, INC.

v.

PUBLIC STRATEGIES
WASHINGTON, INC.

Concurrent Use No. 94002416

PUBLIC STRATEGIES
WASHINGTON, INC.

v.

PUBLIC STRATEGIES, INC.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on the parties' stipulated motions to amend opposed application Serial No. 76271837 to seek a concurrent use registration and to dismiss this opposition in favor of a concurrent use proceeding.¹

¹ The parties also submitted a settlement agreement requesting issuance of a concurrent use registration. Inasmuch as the

BACKGROUND

On June 10, 2003, Public Strategies, Inc. filed a notice of opposition to application Serial No. 76271837, which alleges use and use in commerce since March 1991 of the mark PUBLIC STRATEGIES WASHINGTON for consulting services in the field of government relations, on the ground of priority of use and likelihood of confusion with opposer's common law mark PUBLIC STRATEGIES for public relations consulting services. Applicant Public Strategies Washington, Inc. filed an answer denying the salient allegations of the opposition.²

On January 15, 2009, the parties filed a consented motion to amend opposed application Serial No. 76271837 to seek a concurrent use registration. On January 23, 2009, the parties stipulated to dismissal of the opposition without prejudice as moot.

APPLICATION SERIAL NO. 76271837 REQUIRES FURTHER AMENDMENT

By the consented motion to amend Application Serial No. 76271837, the parties seek to add the following statements:

Applicant is entitled to a registration of the mark PUBLIC STRATEGIES WASHINGTON for the territory comprising the District of Columbia, the Commonwealth of Virginia, and the State of Maryland.

opposed application is not properly amended to seek a concurrent use registration, consideration of the agreement is deferred.

² Opposition No. 91157005 was consolidated with Opposition No. 91163993. On January 16, 2009, applicant filed an abandonment of the subject application in Opposition No. 91163993 and judgment was entered against applicant.

Opposer, having an address of 98 San Jacinto, Suite 900, Austin, Texas, is entitled to use its mark PUBLIC STRATEGIES in those portions of the United States other than the District of Columbia, the Commonwealth of Virginia, and the State of Maryland.

The applicant must comply with the following requirements in a concurrent use application, especially those sections emphasized:

(1) The applicant must specify the goods and the geographic area for which the applicant seeks registration of the mark. Trademark Act Section §1051(a)(3)(D); Trademark Rule §2.42. The applicant must also set forth the mode of use. 15 U.S.C. §1052(d); 37 C.F.R. §2.42.

(2) The applicant must specify, to the extent of its knowledge, the exceptions to its claim of exclusive use, listing any concurrent use by others and the relevant goods, geographic areas and periods of this use. 15 U.S.C. §1051(a)(3)(D); 37 C.F.R. §2.42.

(3) The applicant must also list the names and addresses of the concurrent users, the registrations issued to or applications filed by them (if any), and the mode of such use. 37 C.F.R. §2.42.

(4) The verification for concurrent use should be modified to indicate an exception, that no one else except as specified in the application has the right to use the mark. 15 U.S.C. §1051(a)(3)(D).

Applicant is allowed until thirty days from the mailing date of this order in which to submit a consented amendment which complies with all requirements for a concurrent use application.

OPPOSITION NO. 91157005 IS DISMISSED

Oppositions determine whether the applicant is entitled to a geographically unrestricted registration. Geographic limitations to trademark registrations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use proceeding. See Trademark Rule 2.133(c). When an opposition is filed against an application for an unrestricted registration, the applicant may file a motion to amend its application to one for concurrent registration, reciting opposer as an exception to applicant's claim of exclusive use, together with a motion to terminate the opposition in favor of a concurrent use proceeding. If opposer consents to the amendment, the opposition will be dismissed without prejudice, and the concurrent use proceeding will be instituted. See TBMP §1113.01.

While, as set forth above, there are technical deficiencies in the opposed application, the stipulations filed by the parties make clear that the parties have agreed that applicant will seek a geographically restricted concurrent use registration and that the opposition should be dismissed without prejudice.

Accordingly, Opposition No. 91157005 is dismissed without prejudice.

CONCURRENT USE PROCEEDING IS INSTITUTED

A concurrent use proceeding is hereby instituted under the provisions of Section 2(d) of the Trademark Act. This concurrent use proceeding involves the following parties:

<u>Concurrent Use Applicant:</u>	<u>Public Strategies Washington, Inc.</u>
Serial Number:	76271837
Trademark:	PUBLIC STRATEGIES WASHINGTON
Services:	consulting services in the field of government relations
Filing Date:	June 15, 2001
Territory of Use:	The District of Columbia, the Commonwealth of Virginia, and the State of Maryland
Attorney:	Michael A. Grow ARENT FOX KINTNER PLOTKIN AND KAHN 1050 Connecticut Avenue, NW Washington, DC 20036-5303
<u>User</u>	<u>Public Strategies, Inc.</u>

Trademark:	PUBLIC STRATEGIES
Services:	public relations consulting services
Territory of Use:	All of the United States except The District of Columbia, the Commonwealth of Virginia, and the State of Maryland
Attorney:	Brooke Erdos Singer Davis & Gilbert LLP

The proceeding will be conducted in accordance with the Rules of Practice in Trademark cases, as set out in Title 37 of the Code of Federal Regulations.

Both parties are requested to advise the Board of any relevant applications or registrations which should be included in this concurrent use proceeding. The notice, if any, should be in writing and should be filed on or before thirty days from the mailing date of this order.

**CONSIDERATION OF THE PARTIES' SETTLEMENT AGREEMENT DEFERRED
PENDING APPLICANT'S RESPONSE TO THIS ORDER**

While institution of the concurrent use proceeding generally results in a schedule for answer, conference, disclosures, discovery, and trial, in this proceeding the parties have filed a settlement agreement seeking issuance of the concurrent use registration. Accordingly, upon receipt of the amendments to the application specified above, the Board will consider whether the settlement agreement warrants issuance of the concurrent use registration.

Proceedings herein are suspended pending applicant's response to this order.
