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

Proceeding	91157005
Party	Defendant Public Strategies Washington, Inc.
Correspondence Address	MICHAEL A. GROW ARENT FOX KINTNER PLOTKIN AND KAHN 1050 CONNECTICUT AVENUE, NW WASHINGTON, DC 20036-5303 UNITED STATES henrye@arentfox.com, TMDocket@arentfox.com, rosenberg.alec@arentfox.com
Submission	Other Motions/Papers
Filer's Name	Michael A. Grow
Filer's e-mail	henrye@arentfox.com, grow.michael@arentfox.com, rosenberg.alec@arentfox.com
Signature	/Michael A. Grow/
Date	01/15/2009
Attachments	psw.pdf (10 pages)(329702 bytes)

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

Public Strategies, Inc.,

Opposer,

v.

Opposition No. 91157005

Public Strategies Washington, Inc.,

Applicant.

**NOTICE OF SETTLEMENT,
REQUEST FOR AMENDMENT OF APPLICATION WITH OPPOSER'S CONSENT,
AND REQUEST FOR INSTITUTION OF CONCURRENT USE PROCEEDING**

Pursuant to TBMP Rule 605.03(a), Applicant hereby notifies the Board that the parties have reached a settlement agreement in this proceeding pursuant to which Opposer Public Strategies, Inc. will be filing a notice of dismissal. Pursuant to the settlement agreement, Applicant requests that its Application No. 76/271837 be amended to include a territorial limitation and a request for a concurrent use registration. Opposer has agreed to the amendment by entering into a concurrent use agreement, a copy of which is attached hereto as Exhibit A. Because the amendment includes a territorial limitation, Applicant requests that the Board institute a concurrent use proceeding between the parties so that the application may proceed to registration.

In accordance with the settlement agreement entered into by the parties, Applicant will be filing a notice of abandonment with respect to its Application Ser. No. 76/274706, which is the subject of Opposition Proceeding No. 91163992. That proceeding has been consolidated with

this proceeding. When filed, the notice of abandonment and the notice of dismissal will enable the board to terminate the consolidated proceeding.

AMENDMENT

Applicant requests that its Application No. 76/271837 be amended to include the following language:

- 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.
- 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 attached concurrent use agreement is signed by both of the parties to this proceeding and it shows that Opposer has consented in writing to the proposed amendment to the application at issue. (See ¶¶ 6-7).

REQUEST FOR CONCURRENT PROCEEDING

Based on their experience in the marketplace, the parties have agreed (i) that the use of their respective marks in their separate trading areas will not cause confusion and (ii) that they will cooperate in taking any action necessary to avoid any likelihood of confusion.

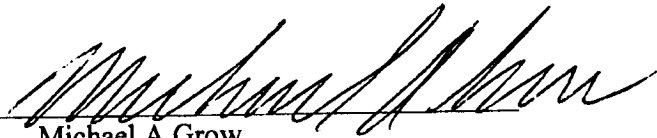
CONCLUSION

Based on the foregoing, Applicant requests that its application be amended, that a concurrent use proceeding be instituted and that Applicant's mark PUBLIC STRATEGIES

WASHINGTON be approved for issuance of a territorially restricted registration pursuant to the agreement between the parties.

PUBLIC STRATEGIES WASHINGTON, INC.

By



Michael A Grow
Alec P. Rosenberg
Arent Fox LLP
1050 Connecticut Avenue, NW
Washington, DC 20036
(202) 857 6000
Attorney for Applicant

January 15, 2009

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing is being served upon Opposer's counsel Brooke Erdos Singer of Davis & Gilbert LLP, 1740 Broadway, New York, New York 10019, by first class mail, postage prepaid, on January 15, 2009.

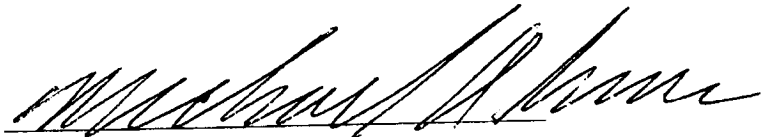


EXHIBIT A

EXHIBIT B

CONCURRENT USE AGREEMENT

This Concurrent Use Agreement (the "Agreement") is made and entered into as of January 5, 200~~8~~⁹ AMM (the "Effective Date") by and between Public Strategies, Inc., a Texas corporation with an address at 98 San Jacinto, Suite 900, Austin, Texas 78701 ("PSI"); and Public Strategies Washington, Inc., a District of Columbia corporation with an address at 633 Pennsylvania Avenue, NW, Washington, D.C. 20004 ("PSW") (collectively, the "Parties").

WHEREAS, PSW is using the mark PUBLIC STRATEGIES WASHINGTON as its trade name and service mark in connection with its government relations consulting services in the District of Columbia, the Commonwealth of Virginia, and the State of Maryland ("PSW's Trading Area");

WHEREAS, PSI is using the mark PUBLIC STRATEGIES as its trade name and service mark in connection with its public relations consulting services, throughout the United States other than the District of Columbia, the Commonwealth of Virginia, and the State of Maryland ("PSI's Trading Area");

WHEREAS, each Party has objected to use by the other Party of marks containing the phrase PUBLIC STRATEGIES in their respective Trading Areas, and PSI has filed Opposition No. 91,157,005 against PSW's U.S. Trademark Application Serial No. 76/271,837 and Opposition No. 91,163,992 against PSW's U.S. Trademark Application Serial No. 76/274,706;

WHEREAS, the Parties wish to provide for their continued use of their respective marks in their respective Trading Areas, to avoid likelihood of confusion, and to resolve any potential

conflicts arising by virtue of their use of or applications to register their respective marks pursuant to the terms of this Agreement;

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged by both Parties, the Parties agree as follows:

1. PSI agrees that it will not use or cause to be used directly or indirectly the mark PUBLIC STRATEGIES WASHINGTON or a mark that contains the words PUBLIC STRATEGIES with the words WASHINGTON or WASHINGTON DC in connection with any goods or services or on any printed materials.
2. PSI agrees that it will not use any mark containing the word PUBLIC STRATEGIES in connection with an office in PSW's Trading Area.
3. PSW agrees not to use or cause to be used directly or indirectly the mark PUBLIC STRATEGIES apart from the words WASHINGTON or WASHINGTON DC.
4. PSW agrees that it will not use any mark containing the word PUBLIC STRATEGIES in connection with an office in PSI's Trading Area.
5. PSW acknowledges that PSI is entitled to seek a concurrent use registration for the mark PUBLIC STRATEGIES covering PSI's Trading Area.
6. PSI acknowledges that PSW is entitled to seek a concurrent use registration for the mark PUBLIC STRATEGIES WASHINGTON covering PSW's Trading Area.
7. Each Party shall execute any and all additional documents and take such further reasonable actions as may be necessary to effect the terms of this Agreement, including a letter consenting to the other party's concurrent use registration, and to ensure the issuance of concurrent use registrations for their respective marks.

8. The Parties shall cooperate and take such reasonable steps as may be mutually agreeable for the purpose of avoiding any likelihood of confusion. Should either Party become aware of any actual confusion among the purchasing public as a result of the Parties' respective marks and uses, it shall advise the other Party of the same, and the Parties shall cooperate and take reasonable measures to prevent further confusion.

9. This Agreement shall be construed as if the Parties have jointly prepared it, and any uncertainty of ambiguity shall not be interpreted against any one Party.

10. The terms and conditions of this Agreement shall bind, inure to the benefit of, and be enforceable against, each Party's agents, successors, licensees, assignees, and other present or future parties in interest.

IN WITNESS WHEREOF, the Parties have executed and have acknowledged this Agreement, to be effective as of the Effective Date, on the dates provided below:

PUBLIC STRATEGIES WASHINGTON, INC.

By _____
Joseph P. O'Neill
Title: President and CEO
Date: _____

PUBLIC STRATEGIES, INC.

By Meredith Marks
Meredith Marks
Chief Operating Officer
Date: 1/9/09

EXHIBIT B

CONCURRENT USE AGREEMENT

This Concurrent Use Agreement (the "Agreement") is made and entered into as of JANUARY 5TH, 2009 (the "Effective Date") by and between Public Strategies, Inc., a Texas corporation with an address at 98 San Jacinto, Suite 900, Austin, Texas 78701 ("PSI"); and Public Strategies Washington, Inc., a District of Columbia corporation with an address at 633 Pennsylvania Avenue, NW, Washington, D.C. 20004 ("PSW") (collectively, the "Parties").

WHEREAS, PSW is using the mark PUBLIC STRATEGIES WASHINGTON as its trade name and service mark in connection with its government relations consulting services in the District of Columbia, the Commonwealth of Virginia, and the State of Maryland ("PSW's Trading Area");

WHEREAS, PSI is using the mark PUBLIC STRATEGIES as its trade name and service mark in connection with its public relations consulting services, throughout the United States other than the District of Columbia, the Commonwealth of Virginia, and the State of Maryland ("PSI's Trading Area");

WHEREAS, each Party has objected to use by the other Party of marks containing the phrase PUBLIC STRATEGIES in their respective Trading Areas, and PSI has filed Opposition No. 91,157,005 against PSW's U.S. Trademark Application Serial No. 76/271,837 and Opposition No. 91,163,992 against PSW's U.S. Trademark Application Serial No. 76/274,706;

WHEREAS, the Parties wish to provide for their continued use of their respective marks in their respective Trading Areas, to avoid likelihood of confusion, and to resolve any potential

conflicts arising by virtue of their use of or applications to register their respective marks pursuant to the terms of this Agreement;

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged by both Parties, the Parties agree as follows:

1. PSI agrees that it will not use or cause to be used directly or indirectly the mark PUBLIC STRATEGIES WASHINGTON or a mark that contains the words PUBLIC STRATEGIES with the words WASHINGTON or WASHINGTON DC in connection with any goods or services or on any printed materials.
2. PSI agrees that it will not use any mark containing the word PUBLIC STRATEGIES in connection with an office in PSW's Trading Area.
3. PSW agrees not to use or cause to be used directly or indirectly the mark PUBLIC STRATEGIES apart from the words WASHINGTON or WASHINGTON DC.
4. PSW agrees that it will not use any mark containing the word PUBLIC STRATEGIES in connection with an office in PSI's Trading Area.
5. PSW acknowledges that PSI is entitled to seek a concurrent use registration for the mark PUBLIC STRATEGIES covering PSI's Trading Area.
6. PSI acknowledges that PSW is entitled to seek a concurrent use registration for the mark PUBLIC STRATEGIES WASHINGTON covering PSW's Trading Area.
7. Each Party shall execute any and all additional documents and take such further reasonable actions as may be necessary to effect the terms of this Agreement, including a letter consenting to the other party's concurrent use registration, and to ensure the issuance of concurrent use registrations for their respective marks.

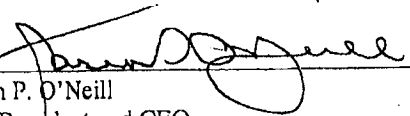
8. The Parties shall cooperate and take such reasonable steps as may be mutually agreeable for the purpose of avoiding any likelihood of confusion. Should either Party become aware of any actual confusion among the purchasing public as a result of the Parties' respective marks and uses, it shall advise the other Party of the same, and the Parties shall cooperate and take reasonable measures to prevent further confusion.

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10. The terms and conditions of this Agreement shall bind, inure to the benefit of, and be enforceable against, each Party's agents, successors, licensees, assignees, and other present or future parties in interest.

IN WITNESS WHEREOF, the Parties have executed and have acknowledged this Agreement, to be effective as of the Effective Date, on the dates provided below:

PUBLIC STRATEGIES WASHINGTON, INC.

By 
Joseph P. O'Neill
Title: President and CEO
Date: JANUARY 5, 2009

PUBLIC STRATEGIES, INC.

By _____
Meredith Marks
Chief Operating Officer
Date: _____