This Opinion is Not a Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Richard A. Harris, a Professional Corporation

v.

Ticket Busters Inc., a New York Corporation

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Concurrent Use No. 94002429

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Before Kuhlke, Wolfson and Shaw,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Richard A. Harris, a Professional Corporation ("Applicant") filed an application for a concurrent use registration of the mark TICKET BUSTERS in standard characters for "legal services" in International Class 45 (the "Application").[1] The Application was filed under Trademark Act § 1(a), 15 U.S.C. § 1051(a), with claims of first use and first use in commerce of October 22, 2002. The Application contained a disclaimer of the exclusive right to use TICKET apart from the mark as shown.

The Application requested registration of Applicant's mark for the geographic territory defined as "the entire United States with the exception of the State of

[1] Application Serial No. 77601168, filed on October 27, 2008.

Florida, the cities of Flushing, New York; New York City, New York; and Somerset New Jersey." The Application identified three entities as exceptions to Applicant's exclusive right to use its mark in commerce, naming Ticket Busters, Inc. of Flushing N.Y. ("TBI") with rights to use the mark in Flushing, N.Y.; Parking Ticket Busters of New York ("PTB") with rights to use the mark in New York City, N.Y. and in Somerset, New Jersey; and Ticket Busters Inc. of Florida ("TBF") with rights to use the mark in the state of Florida. None of the excepted users was specified as holding any trademark application or registration.

Of the three named excepted users, only TBI responded to the notice of institution of the concurrent use proceeding. In view thereof, Applicant filed a motion for leave to amend its territorial statement to delete PTB and TBF as excepted users and the state of Florida and the cities of New York City (N.Y.) and Somerset (N.J.) as exceptions to Applicant's restricted territory. The Board denied the motion, pending proof of service of the notice of institution on PTB and TBF, or proof that they were no longer in business or had abandoned their mark. Applicant provided proof that TBF had abandoned its mark.[2] Applicant subsequently provided proof of service of the institution notice on PTB and PTB did not file an answer to the institution notice. *See* Trademark Rule 2.99. Moreover, Applicant provided additional facts to support its statement that PTB had abandoned its mark.[3]

[2] 19 TTABVUE.

[3] 24 TTABVUE.

Accordingly, both entities were deleted from this proceeding.[4] TBI thus remained the sole exception to Applicant's exclusive right to use the mark in commerce.

This case now comes before the Board for consideration of Applicant and TBI's "Stipulation Regarding Settlement of Concurrent Use Proceeding and to Modify Concurrent Use Statement," jointly filed on November 20, 2015. The parties request that the Board amend the concurrent use statement in Applicant's application to read:

> Applicant seeks registration for the entire United States with the exception of the five boroughs of New York City, which include the Bronx, Brooklyn, Queens, Manhattan and Staten Island, plus an additional twenty-five (25) miles outside of the city limit only within the state of New York.

The burden of proof in a concurrent use proceeding is upon the concurrent use applicant to establish facts which would show, *prima facie*, that there is no likelihood of confusion arising from the concurrent use of similar marks in the parties' respective geographical areas. *See In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970); and *Handy Spot Inc. v. J.D. Williams Co., Inc.,* 181 USPQ 351 (TTAB 1974). The primary concern of the Board in determining whether and to what extent a registration is to be granted is the avoidance of any likelihood of confusion. The Board will enter judgment in favor of a concurrent use applicant on the basis of a stipulation or settlement agreement only if the terms

[4] Applicant moved for leave to amend the statement of concurrent use as a result of the deletion of these two excepted users, but the motion was denied as premature.

of the agreement are sufficient to persuade the Board that confusion, mistake or deception are not likely to result from the continued concurrent use by the parties of their marks. Trademark Act § 2(d), 15 U.S.C. § 1052(d).

According to the parties' agreement, TBI provides its ticket services only within the five boroughs of New York City (the Bronx, Brooklyn, Queens, Manhattan and Staten Island) as well as within an area that "may extend slightly outside of the city." The parties state that a likelihood of confusion will be avoided by a "modified concurrent use claim" that acknowledges TBI's rights to this limited territory. They further state that confusion is unlikely because they use their marks "in separate and distinct geographic markets and will continue to do so." The parties undertake not to "intentionally promote, market, advertise, license, or sell their services in connection with their respective marks in a manner that will cause consumer confusion," and agree to cooperate with each other to prevent actual confusion and take steps to "avoid, discover and dispel" any instances of confusion.

By their agreement and in light of the nearly 8 years of concurrent use conducted without apparent confusion,[5] the parties have *prima facie* established that concurrent use of the involved marks is not likely to lead to confusion, mistake, or deception. *See In re N.A.D. Inc.,* 754 F.2d 996, 224 USPQ 969, 970 (Fed. Cir. 1985) ("We think it highly unlikely that [these competitors] would have deliberately

[5] Counting from October 27, 2008, the constructive use date of the Application. In the application, Applicant claims a first use in commerce date of 2002 (specifically, October 22, 2002). This date is not proof of Applicant's actual use; however, we note there has been no challenge to that date.

created a situation in which the sources of their respective products would be confused by their customers.") There can be no better assurance of the absence of a likelihood of confusion, mistake or deception than the parties' promises to avoid any activity which might lead to such confusion. *See In re Four Seasons Hotels Ltd.,* 987 F.2d 1565, 26 USPQ2d 1071, 1073 (Fed. Cir. 1993) ("There is no reason to ignore [the parties'] assessment of likelihood of confusion and not give substantial weight to their agreement as evidence that likelihood of confusion does not exist."); *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank,* 6 USPQ2d 1305 (Fed. Cir. 1988) (great weight must be given to agreements between parties who are most familiar with use in the marketplace and who are most interested in precluding confusion).

Accordingly, on the record now before us, we find that the measures set forth in the parties' agreement are sufficient to ensure that TBI's use of its mark limited as set forth in the agreement is not likely to cause confusion, and that Applicant is entitled to a concurrent use registration limited to the entire United States with the exception of the five boroughs of New York City plus an additional twenty-five (25) miles outside of the city limit only within the state of New York, as set forth in the agreement.

Decision: Application Serial No. 77601168 requires republication because it initially named three excepted users and acknowledged greater restrictions to the territory claimed by Applicant than are presently awarded to Applicant by this

decision. Accordingly, proceedings are hereby suspended pending republication of Application Serial No. 77601168. *See* TMEP § 1505.03(a) (republication required after entry of any post-publication amendment that expands an applicant's rights or would otherwise require notice to third parties). Following the close of the opposition period within which no opposition will have been filed (or any filed opposition will have been dismissed):

1.) this application will issue as a concurrent use registration for the area comprising the entire United States with the exception of the five boroughs of New York City, which include the Bronx, Brooklyn, Queens, Manhattan and Staten Island, plus an additional twenty-five (25) miles outside of the city limit only within the state of New York; and

2.) Applicant's presently unrestricted Reg. No. 3668729 for the mark TICKET BUSTERS and design will be restricted to the area comprising the entire United States with the exception of the five boroughs of New York City, which include the Bronx, Brooklyn, Queens, Manhattan and Staten Island, plus an additional twenty-five (25) miles outside of the city limit only within the state of New York.