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Filing date: **11/14/2012**

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

Proceeding	94002522
Party	Applicant Aurora Health Care, Inc.
Correspondence Address	RICHARD J MCKENNA FOLEY & LARDNER LLP 777 E WISCONSIN AVENUE MILWAUKEE, WI 53202-5300 UNITED STATES ptomailmilwaukee@foley.com
Submission	Other Motions/Papers
Filer's Name	Richard J. McKenna
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Signature	/R.J. McKenna/
Date	11/14/2012
Attachments	9400252 Response to Notice.pdf (14 pages)(1423313 bytes)

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

Aurora Health Care, Inc.)
Applicant,)
)
v.)
)
Jeffrey M. Rosenfeld)
Defendant.)
_____)

Concurrent Use No.: 94002522

Attention: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

SUBMISSION OF REDACTED PUBLIC VERSION OF TTAB FILING

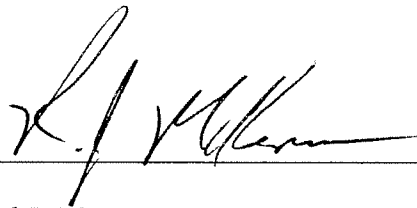
This paper is being filed in response to a Notice issued by the TTAB on November 5, 2012 in the above identified Concurrent Use Proceeding. Applicant, Aurora Health Care, Inc. and Defendant, Jeffery M. Rosenfeld, by and through their respective counsels, submitted on September 17, 2012 a Consented Stipulation along with (i) a complete copy of a Settlement Agreement and (ii) a Redacted Copy of the Settlement Agreement. However, the Redacted copy of the Settlement Agreement incorrectly included a “Confidential” stamp notation.

Submitted herewith is a copy of the Consented Stipulation and Redacted Copy of the Settlement Agreement as submitted on September 17, 2012, without the “Confidential” stamp and the enclosed copy may be viewed by the public. The TTAB is requested to only make the enclosed copy of the September 17, 2012 submission publicly available, the “Confidential” stamped documents submitted on September 17, 2012 should be maintained in confidence.

Applicant, Aurora Health Care, Inc., believes that this filing is fully responsive to all of the issues raised in the November 5, 2012 Notice so that the Concurrent Use proceeding is now ready for issuance of concurrent use registrations consistent with the terms of the Stipulation submitted on September 17, 2012.

Respectfully submitted,

FOLEY & LARDNER LLP



Richard J. McKenna
777 E. Wisconsin Ave.
Milwaukee, Wisconsin 53202-5367
Phone: (414) 271-2400
Fax: (414) 297-4900
Email: ipdocketing@foley.com
Counsel for Applicant

Date: 11/14/12

CERTIFICATE OF SERVICE

I, Richard McKenna, hereby certify that a copy of the SUBMISSION OF REDACTED PUBLIC VERSION OF TTAB FILING was deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to:

EDWARD M LIVINGSTON
THE LIVINGSTON FIRM
963 TRAIL TERRACE DRIVE
NAPLES, FL 10022

Dated: 11/14/12

Signed: 

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

Aurora Health Care, Inc.)
Applicant,)
v.)
Jeffrey M. Rosenfeld)
Defendant.)

Concurrent Use No.: 94002522

Attention: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

CONSENTED STIPULATION TO ENTRY OF ORDER

Applicant, Aurora Health Care, Inc. and Defendant, Jeffery M. Rosenfeld, by and through their respective counsels, hereby stipulate to the entry of an Order to issue concurrent use registrations for the pending application for the mark AURORA QUICKCARE owned by Aurora Health Care and the issued registration for the mark ER QUICKCARE as follows:

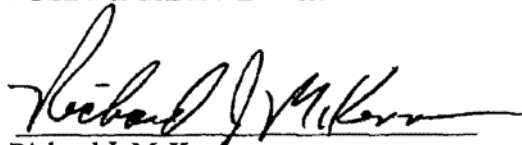
Applicant's Mark:	AURORA QUICKCARE
Serial No.:	78/934532
Services:	Health care; Medical clinics; Medical consultations; Medical services; Medical testing; Providing health information
Territory:	Illinois, Indiana, Iowa, Kansas, Kentucky, Michigan, Minnesota, Missouri, Nebraska, North Dakota, South Dakota and Wisconsin.

Defendant's Mark: ER QUICK CARE
Reg. No.: 3353607
Services: Medical services
Territory: Alabama, Alaska, Arkansas, Arizona, California, Colorado, Connecticut, Delaware, District of Columbia, Florida, Georgia, Hawaii, Idaho, Louisiana, Maine, Maryland, Massachusetts, Mississippi, Montana, Nevada, New Mexico, New Hampshire, New Jersey, New York, North Carolina, Ohio, Oklahoma, Oregon, Pennsylvania, Rhode Island, South Carolina, Tennessee and Texas Utah, Vermont, Virginia, Washington, West Virginia and Wyoming

The Parties have entered into an agreement expressly consenting to the issuance of concurrent registrations as noted above. Attached hereto as CONFIDENTIAL Attachment A is a copy of the Settlement Agreement. The pages of the Settlement Agreement which are requested to be maintained confidential include a "CONFIDENTIAL" notation at the top of each page. The parties expressly request that the Board (a) enter an Order to issue the concurrent use registrations as noted above and in the Settlement Agreement, and (b) maintain the confidential nature of the Attachment A Settlement Agreement.

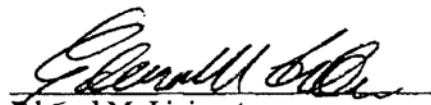
Respectfully submitted,

FOLEY & LARDNER LLP



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Milwaukee, Wisconsin 53202-5367
Phone: (414) 271-2400
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Email: ptomailmilwaukee@foley.com
Counsel for Applicant
Date: Aug. 31, 2012

THE LIVINGSTON FIRM



Edward M. Livingston
963 Trail Terrace Drive
Naples, FL 10022
Phone: (239) 262-8502
Fax: (239) 261-3773
Email: eml@thelivingstonfirm.com
Counsel for Defendant
Date: Sept. 5, 2012

CERTIFICATE OF SERVICE

I, Richard McKenna, hereby certify that a copy of the CONSENTED STIPULATION TO ENTRY OF ORDER was deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to:

EDWARD M LIVINGSTON
THE LIVINGSTON FIRM
963 TRAIL TERRACE DRIVE
NAPLES, FL 10022

Dated: 

Signed: Sept. 17, 2012

COEXISTENCE AND CONCURRENT USE REGISTRATION AGREEMENT

This Coexistence and Concurrent Use Registration Agreement (the "Agreement") is effective and entered into as of this ²⁰¹¹ 4th day of Jan, ~~2010~~ (the "Effective Date") by and between Aurora Health Care, Inc., a Wisconsin non-profit corporation with offices located at 3000 West Montana Avenue, Milwaukee, Wisconsin 53215 ("Aurora") and Dr. Jeffrey Rosenfield ("Rosenfield"), an individual resident of Florida with a place of business located at 13030 Livingston Road, Naples, Florida 34105.

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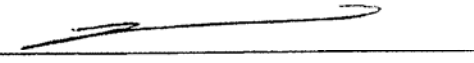
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IN WITNESS WHEREOF, the parties' duly authorized representatives have executed this Agreement as of the Effective Date.

Aurora Health Care, Inc.

Dr. Jeffrey Rosenfield

By: 

By: 

Print Name: STEPHEN E. BABLITCH

Title: Secretary and SVP

Date: 10/14/10

Date: 1-4-11

LETTER OF CONSENT

I, Dr. Jeffrey Rosenfield ("Rosenfield"), am an individual residing in Florida with a place of business located at 13030 Livingston Road, Naples, Florida 34105. I filed U.S. Trademark Application No. 78/704,155, for ER QUICKCARE covering medical services on August 31, 2005, and was issued U.S. Registration No. 3,353,607 (the "Rosenfield Registration"), on December 11, 2007.

I understand that Aurora Health Care, Inc. has used the mark "AURORA QUICKCARE" in connection with health care, medical clinics, medical consultations, medical services, medical testing, and providing health care information ("health care services") since at least as early as April 15, 2004, and that Aurora has filed U.S. Trademark Application No. 78/934,532 (the "Aurora Application"), for the mark AURORA QUICKCARE covering these health care services on July 21, 2006.

I also understand that the Aurora Application has been refused registration based on an alleged likelihood of confusion with the Rosenfield Registration.

I acknowledge and agree that the contemporaneous use and concurrent registration of the AURORA QUICKCARE mark by Aurora and my ER QUICKCARE mark will not cause confusion in the marketplace, in light of the differences in the overall marks, the care and discretion exercised by purchasers of each party's services, and provided that the use and concurrent registration of each mark is limited as follows:

Aurora. I understand that Aurora will limit its use and registration of AURORA QUICKCARE or any confusingly similar mark to the following U.S. states and territories: Illinois, Indiana, Iowa, Kansas, Kentucky, Michigan, Minnesota, Missouri, Nebraska, North Dakota, South Dakota, and Wisconsin (the "Aurora States").

Rosenfield. I will limit my use and registration of ER QUICKCARE or any confusingly similar mark to the following U.S. states and territories: Alabama, Alaska, Arkansas, Arizona, California, Colorado, Connecticut, Delaware, District of Columbia, Florida, Georgia, Hawaii, Idaho, Louisiana, Maine, Maryland, Massachusetts, Mississippi, Montana, Nevada, New Mexico, New Hampshire, New Jersey, New York, North Carolina, Ohio, Oklahoma, Oregon, Pennsylvania, Rhode Island, South Carolina, Tennessee and Texas, Utah, Vermont, Virginia, Washington, West Virginia and Wyoming (the "Rosenfield States").

I understand that Aurora is filing, contemporaneously with the filing of this Letter of Consent, a Response to Notice of Suspension, in which Aurora is amending the Aurora Application to a Concurrent Use registration, citing the Rosenfield Registration as a concurrent registration and subject to the guidelines set forth herein.

I expressly consent to the registration of the Aurora Application on the grounds stated herein and respectfully request the Examiner responsible for the Aurora Application to allow this application over my earlier registration so that the Aurora Application may proceed to a concurrent use proceeding in front of the Trademark Trial and Appeal Board.

By: _____

Dr. Jeffrey Rosenfield

10/14/10

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: AURORA QUICKCARE

Serial No.: 78/934,532

Filing Date: July 21, 2006

Applicant: Aurora Health Care, Inc.

Examiner: Ms. Mary Rossman
Law Office 109

RESPONSE TO NOTICE OF SUSPENSION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

This communication responds to the Notice of Suspension mailed October 14, 2008, concerning the above-referenced application.

AMENDMENTS

1. Application for Concurrent Registration

Please amend the application to an Application for Concurrent Registration, subject to Registration Number 3,353,607 by Dr. Jeffrey Rosenfield ("Rosenfield Registration").

2. Alternative Claim of Acquired Distinctiveness in Part

Please add the following alternative claim of distinctiveness, under Section 2(f) of the Trademark Act (15 U.S.C. § 1052(f)):

"QUICKCARE has become distinctive of the identified goods as a result of Applicant's substantially exclusive and continuous use of the mark in commerce, in its territory and subject to the Rosenfield Registration."

REMARKS

In this Notice of Suspension, the Examiner has suspended the application pending resolution of Cancellation Number 92/049,792. In addition, the Examiner maintained a request for the disclaimer of “QUICKCARE.” Applicant addresses each issue in turn below.

1. Amendment to Application for Concurrent Registration

This application was suspended pending a Cancellation Action which was filed by Applicant against the Rosenfield Registration due to an alleged likelihood of confusion citation. The Applicant and Dr. Rosenfield have come to an agreement. The parties agree that, given the differences in the overall marks and the care and discretion of each party’s consumers, there is no likelihood of confusion between their respective marks provided that each party’s rights are geographically limited in scope. Applicant submits herewith a Letter of Consent signed by Dr. Rosenfield, in which he agrees to the registration of this Application according to the terms of the parties’ agreement.

Applicant respectfully requests that this Application be amended to request concurrent registration with the Rosenfield Registration. Applicant’s rights and registration should be limited to the following territories:

Illinois, Indiana, Iowa, Kansas, Kentucky, Michigan, Minnesota, Missouri, Nebraska, North Dakota, , South Dakota, and Wisconsin (the “Aurora States”).

Once this Application is removed from suspension and published, Applicant and Dr. Rosenfield will convert the pending Cancellation Action into a Concurrent Use Proceeding. During the Concurrent Use Proceeding, Dr. Rosenfield will agree to limit his rights and the scope of the Rosenfield Registration to the following territories:

Alabama, Alaska, Arkansas, Arizona, California, Colorado, Connecticut, Delaware, District of Columbia, Florida, Georgia, Hawaii, Idaho, Louisiana, Maine, Maryland, Massachusetts, Mississippi, Montana, Nevada, New Mexico, New Hampshire, New Jersey, New York, North Carolina, Ohio, Oklahoma, Oregon, Pennsylvania, Rhode Island, South Carolina, Tennessee and Texas Utah, Vermont, Virginia, Washington, West Virginia and Wyoming (the “Rosenfield States”).

Given the consent of the owner of the cited registration, and the amendment of this application to request a concurrent use registration, Applicant respectfully submits that it has fully addressed the alleged likelihood of confusion and the reason for suspension, and requests that the application be removed from suspension.

2. Disclaimer of "QUICKCARE"

In the Notice of Suspension, Examiner maintained her request for a disclaimer of "QUICKCARE," alleging that it is merely descriptive of the services. Applicant continues to respectfully disagree with Examiner, and reiterates and reincorporates by reference all of its arguments in its August 11, 2008, Response to Office Action.

However, in the interest of advancing prosecution of the application, the Applicant, in the alternative, submits that "QUICKCARE" has become distinctive of its goods through Applicant's substantially exclusive and continuous use of the mark in commerce in its territory and subject to the Rosenfield Registration, for more than five years. Applicant has used QUICKCARE to identify its health care services since at least as early as April 14, 2004,, and attaches hereto a declaration to this effect. This alternative claim does not constitute a concession that the matter to be registered is not inherently distinctive. TMEP § 1212.02(c); *see, e.g., In re E.S. Robbins Corp.*, 30 U.S.P.Q. 2d 1540 (TTAB 1994).

CONCLUSION

In light of the above, Applicant believes that it has responded to all issues raised in the Notice of Suspension. However, should any questions arise with respect to the application or the issues addressed herein, please contact the undersigned.

Respectfully submitted,

Date: _____

Richard J. McKenna
FOLEY & LARDNER LLP
777 East Wisconsin Avenue
Milwaukee, Wisconsin 53202
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