

Faint

Mailed: January 16, 2013

Cancellation No. 92049792  
Concurrent Use No. 94002522

Aurora Health Care, Inc.

V.

Jeffrey M. Rosenfield

**Before Zervas, Wellington and Shaw,  
Administrative Trademark Judges.**

**By the Board:**

Concurrent Use applicant/Petitioner, Aurora Health Care, Inc., (hereinafter "Aurora") seeks to register the mark AURORA QUICKCARE in standard character form for, "health care; medical clinics; medical consultations; medical services; medical testing; providing health information" in Class 44.<sup>1</sup>

Registrant, Jeffrey M. Rosenfield is the owner of a U.S. registration for the mark ER QUICKCARE in standard character form for, "medical services" in Class 44.<sup>2</sup>

---

<sup>1</sup> Application Serial No. 78934532, filed July 21, 2006, claiming dates of first use and first use in commerce of April 15, 2004. A claim under Trademark Act § 2(f) in part as to "QUICKCARE" is of record. The mark was published for opposition on May 3, 2011 with the concurrent use statement.

<sup>2</sup> Registration No. 3353607, registered December 11, 2007, claiming dates of first use and first use in commerce of August 31, 2005. A disclaimer of "ER" is of record.

Aurora names Mr. Rosenfield as an excepted user to its exclusive right to use its mark. On August 11, 2008, Aurora filed a petition to cancel Mr. Rosenfield's Registration No. 3353607; on January 26, 2011, Aurora amended its application to one for concurrent registration; and on March 30, 2012, Aurora filed a motion for withdrawal of the cancellation without prejudice in favor of the concurrent use proceeding.

On September 17, 2012, confidential copies of a "coexistence and concurrent use agreement" and "letter of consent" between the parties were filed with the Board in the concurrent use proceeding.<sup>3</sup> Subsequently, on November 14, 2012 in response to an order of the Board, Aurora filed a redacted copy of the agreement for entry in the concurrent use proceeding.<sup>4</sup>

### **Cancellation Proceeding**

---

<sup>3</sup> On January 26, 2011, a copy of a concurrent use "agreement" between the parties was filed as an attachment to Aurora's response to an Office Action in the pending application file. Subsequently, the Board was made aware of that filing and entered it into the instant proceeding. The better practice would have been for Aurora, as applicant, in addition to file a copy of the agreement with the Board together with a request for issuance of the concurrent registration sought. See TBMP § 1110 (3d ed. rev. 2012).

<sup>4</sup> Aurora redacted all except the first and last paragraphs of the copy of the agreement subsequently filed with the Board. There is no apparent reason for the redaction, especially since the signed agreement was filed publicly in Cancellation No. 92049792. Therefore we disclose that information necessary to issue this order. See, e.g., *Edwards Lifesciences Corp. v. Vigilanz Corp.*, 94 USPQ2d 1399, (TTAB 2010) (finding where parties have improperly designated information as confidential, Board may refer to information necessary to issue decision).

The settlement agreement provides that the parties will terminate the cancellation proceeding in favor of a concurrent use proceeding, and for amendment of the application and registration to state the geographic restrictions. In view thereof, the Board finds that dismissal of the cancellation proceeding is appropriate. *See, e.g., Holmes Oil Co. v Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1149 n.1 (TTAB 2011) (parties stipulated to terminate opposition proceeding in favor of concurrent use proceeding and to an amendment of the application to state geographic restrictions).

**Concurrent Use Proceeding**

The agreement between the parties sets forth mutually exclusive geographic territories and includes restrictions concerning use of the parties' respective marks in the United States. Specifically, the agreement and letter of consent describe the geographic area for Aurora as, "the area comprising Illinois, Indiana, Iowa, Kansas, Kentucky, Michigan, Minnesota, Missouri, Nebraska, North Dakota, South Dakota and Wisconsin." The geographic area for Mr. Rosenfield is described as, "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

Cancellation No. 92049792 & Concurrent Use No. 94002522

Mexico, New Hampshire, New Jersey, New York, North Carolina, Ohio, Oklahoma, Oregon, Pennsylvania, Rhode Island, South Carolina, Tennessee, Texas, Utah, Vermont, Virginia, Washington, West Virginia and Wyoming."

The parties agree to take steps to avoid and prevent instances of actual confusion including: (1) with respect to their websites, each party may continue using their respective marks on their websites as "passive promotion;" (2) each party is prohibited from directly targeting through promotion or advertisement all or a portion of the geographic territory of the other party; (3) in the event any instances of actual confusion are encountered, the party encountering such confusion shall promptly advise the other party of such confusion, and the parties will cooperate and take all reasonable steps necessary to correct such confusion; (4) the parties agree to consult and cooperate with each other in good faith to develop policies and procedures to avoid the occurrence of any future incidents of confusion.

Upon careful consideration of the agreement between the parties the Board is persuaded that, under the circumstances of this case, confusion is unlikely to occur. In making this determination, the Board has taken into account not only the provisions of the agreement and the actual geographic restrictions of the areas of use, but also the voluntary entry by the parties into an agreement which

Cancellation No. 92049792 & Concurrent Use No. 94002522

includes provisions for concurrent use when it would be clearly against their business interests to cause confusion on the part of the public. See *Amalgamated Bank of New York v. Amalgamated Trust & Savings*, 842 F.2d 1270, 6 USPQ2d 1305, 1307-08 (Fed. Cir. 1988).

**DECISION:**

The petition for cancellation is dismissed without prejudice.

The following is hereby ordered:

Applicant, Aurora Health Care, Inc., is entitled to the registration of its mark, AURORA QUICKCARE for "health care; medical clinics; medical consultations; medical services; medical testing; providing health information" in Class 44, for "the area comprising Illinois, Indiana, Iowa, Kansas, Kentucky, Michigan, Minnesota, Missouri, Nebraska, North Dakota, South Dakota and Wisconsin." (Application Serial No. 78934532). The registration will issue in due course.

Registration No. 3353607 for the mark ER QUICKCARE owned by Jeffrey M. Rosenfield, will be restricted to the area consisting of "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, Texas, Utah, Vermont, Virginia, Washington, West Virginia and Wyoming."

\*\*\*