

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

Mailed: July 19, 2013

Concurrent Use No. 94002554

Mission Health System, Inc.

v.

Mission Hospital Regional  
Medical Center

Before Bergsman, Ritchie, and Lykos,  
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Mission Hospital Regional Medical Center ("Mission-CA") filed an application, as amended, for concurrent use registration on the Principal Register of the mark MISSION HOSPITAL (in standard characters) for "medical services, hospital services, health care services," in International Class 44<sup>1</sup> (the "Mission-CA Mark"). Mission-CA seeks concurrent use registration in the area comprising the state of California.

Mission Health System, Inc. ("Mission-NC") is named as the exception to Mission-CA's claim of exclusive right to use the mark in commerce. Mission-NC owns the following

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<sup>1</sup> Application Serial No. 77648715 was filed on January 13, 2009, reciting May 31, 1999 as a date of first use of the mark anywhere and in commerce.

registrations on the Principal Register (collectively, the "Mission-NC Marks"):

- a. Registration No. 2,917,751, for the mark MISSION, in typed drawing, for "Educational services, namely, conducting classes, seminars and workshops in the fields of health care and medical services," in International Class 41; "Health care services; medical services; providing medical information via an on-line website," in International Class 44;<sup>2</sup>
- b. Registration No. 3,656,385, for the mark MISSION, and design, for "Newsletters and magazines in the fields of health care and medical services" in international class 16; "Educational services, namely, conducting classes, seminars and workshops in the fields of health care and medical services; providing an on-line newsletter in the fields of health care and medical services," in International Class 41; and "Health care services; medical services; providing medical information via an on-line website," in International Class 44.<sup>3</sup>
- c. Registration No. 3,604,905, for the mark MISSION CHILDREN'S HOSPITAL, in standard characters, for "Educational services, namely, conducting classes, seminars and workshops in the fields of health care and medical services; providing an on-line newsletter in the fields of health care and medical services," in International Class 41; and "health care services; medical services; providing medical information via an on-line website," in International Class 44.<sup>4</sup>
- d. Registration No. 3,593,707, for MISSION HOSPITALS, in standard characters, for "Newsletters and magazines in the fields of health care and medical services," in International Class 16; "Educational

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<sup>2</sup> Registration No. 2,917,751, issued on January 11, 2005, without any geographical restrictions. Sections 8 and 15 affidavits accepted and acknowledged.

<sup>3</sup> Registration No. 3,656,385, issued on July 21, 2009, without any geographical restrictions.

<sup>4</sup> Registration No. 3,604,905, issued on April 14, 2009, without any geographical restrictions, and disclaiming the exclusive right to the term "CHILDREN'S HOSPITAL" apart from the mark as shown.

services, namely, conducting classes, seminars and workshops in the fields of health care and medical services; providing an on-line newsletter in the fields of health care and medical services," in International Class 41; and "Health care services; medical services; providing medical information via an on-line website," in International Class 44.<sup>5</sup>

- e. Registration No. 3,593,708, for MISSION HEALTH & HOSPITALS, in standard characters, for "Newsletters and magazines in the fields of health care and medical services," in International Class 16; "educational services, namely, conducting classes, seminars and workshops in the fields of health care and medical services; providing an on-line newsletter in the fields of health care and medical services," in International Class 41; and Health care services; medical services; providing medical information via an on-line website," in International Class 44.<sup>6</sup>
- f. Registration No. 3,763,900, for MISSION HEALTH SYSTEM, in standard characters, for "Newsletters and magazines in the fields of health care and medical services," in International Class 16; "Educational services, namely, conducting classes, seminars and workshops in the fields of health care and medical services; providing an on-line newsletter in the fields of health care and medical services," in International Class 41; and Health care services; medical services; providing medical information via an on-line website," in International Class 44.<sup>7</sup>
- g. Registration No. 3,921,008, for MISSION MEDICAL ASSOCIATES, in standard characters, for "Newsletters in the fields of health care and medical services," in International Class 16; "Educational services, namely, conducting classes,

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<sup>5</sup> Registration No. 3,593,707, issued on March 24, 2009, without any geographical restrictions, and disclaiming the exclusive right to the term "HOSPITALS" apart from the mark as shown.

<sup>6</sup> Registration No. 3,593,708, issued on March 24, 2009, without any geographical restrictions, and disclaiming the exclusive right to the term "HEALTH & HOSPITALS" apart from the mark as shown.

<sup>7</sup> Registration No. 3,763,900, issued on March 23, 2010, without any geographical restrictions, and disclaiming the exclusive right to the term "HEALTH SYSTEM" apart from the mark as shown.

seminars and workshops in the fields of health care and medical services; providing an on-line newsletter in the fields of health care and medical services," in International Class 41; and "Health care services; medical services," in International Class 44.<sup>8</sup>

On May 21, 2013, the parties submitted a "Concurrent Use Agreement" (the "settlement agreement"). By way of the settlement agreement, Mission-CA and Mission-NC have agreed, *inter alia*, that the parties have been using their MISSION-CA and MISSION-NC Marks concurrently "in remote geographical areas." Specifically, Mission-CA "asserts that it has used" the Mission-CA Mark "in California," and will continue to use its mark only "in the state of California," while Mission-NC has established use of its mark outside California, and "shall not use" the Mission-NC Marks "in Mission-CA's Geographic Territory." The parties agree to terms that address potentially overlapping advertising.

The parties further agree "it is unlikely that their use of their respective marks will create any likelihood of customer confusion"; "that in the unlikely event that likelihood of customer confusion" should arise, the parties "will cooperate and consult with one another in good faith and take whatever steps are reasonably necessary to

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<sup>8</sup> Registration No. 3,921,008, issued on February 15, 2011, without any geographical restrictions.

eliminate any confusion" and that each party "consents to" the "concurrent use and concurrent registration" of the other's marks noted herein with the geographic restrictions as noted.

Based upon the foregoing, we are convinced that a *prima facie* showing has been established that concurrent use of the involved marks is not likely to cause confusion, mistake or deception. See Section 2(d) of the Trademark Act and *Precision Tune Inc. v. Precision Auto Tune Inc.*, 4 USPQ2d 1095 (TTAB 1987).

Accordingly, Mission-CA is entitled to a concurrent use registration for which it has made application and Mission-NC's registrations will be restricted geographically, as agreed upon by the parties.

Specifically, Mission-CA shall be granted a registration in due course based on its application Serial No. 77648715 for the territory comprising "the State of California."

Mission-NC's Registration Nos. 2,917,751, 3,656,385, 3,604,905, 3,593,707, 3,593,708, 3,763,900, and 3,921,008 shall be geographically restricted to the territory comprising "all the United States, its territories, and its possessions other than the State of California."