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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Andrew Jimerson II

v.

Payam Jarrahnejad

Concurrent Use No. 94002612

JungJin Lee and Eric C. Bray of Lee, Lee & Associates
for Andrew Jimerson II.

Edouard V. Rosa, Esq.
for Payam Jarrahnejad.

Before Quinn, Heasley and Pologeorgis,
Administrative Trademark Judges.

By Quinn, Administrative Trademark Judge:

Andrew Jimerson II ("Applicant") filed an application, as amended, to seek concurrent use registration of the mark DR. J. CURVES (in standard characters) for "plastic surgery services" in International Class 44 for the area comprising the state of Georgia and the Eastern United States.[1] The application identifies the

[1] Application Serial No. 85762778, filed October 24, 2012, alleging first use anywhere and first use in commerce on April 6, 2007. The application indicates that "Dr. J." identifies a particular living individual whose consent is of record.

following registration issued to Payam Jarrahnejad ("Registrant") as an exception to Applicant's exclusive right to use the mark in the area comprising the state of California: DR. J (in standard characters) for "cosmetic and reconstructive plastic surgery" in International Class 44.[2]

The Board, on October 3, 2014, instituted this concurrent use proceeding. In lieu of an answer, the parties filed, on March 4, 2015, a consent agreement.[3] The parties assert that the agreement removes any likelihood of confusion between their marks and, accordingly, there is no need for the present concurrent use proceeding to go forward.

The agreement executed by the parties (8 TTABVUE 5-10) indicates that they

> recognize and acknowledge the differences between their marks, services, and trade channels, and that they have coexisted and simultaneously used their respective service marks in commerce for their respective services … [for] more than five (5) years….

Further, the parties

> are not aware of any actual confusion between them, their marks, and their respective services during their peaceful coexistence in the marketplace for over five years, and agree to continue to use their respective marks in a manner calculated to avoid confusion and will cooperate in taking any and all reasonable actions to avoid confusion, including correcting any instance of confusion

[2] Registration No. 4038924, issued October 11, 2011. The registration includes the following statement: "The name 'Dr. J' identifies a particular living individual whose consent is of record."

[3] The agreement was accompanied by a "Stipulated Motion to Suspend and Remand for Consideration of Consent Agreement." The parties essentially requested that the Board suspend the present concurrent use proceeding, and remand the application to the examining attorney for further examination relating to the parties' consent agreement. However, inasmuch as the Board can consider the sufficiency of the agreement, a remand is not necessary.

> or likelihood of confusion which may come to their attention.

Each party "recognizes and consents to and agrees not to object to, oppose, or otherwise seek to limit in any way" the other party's rights as reflected in the respective application and registration. The parties

> agree and acknowledge that it is unlikely that the concurrent use of [Applicant's] mark as applied to [Applicant's] services and [Registrant's] mark as applied to [Registrant's] services will create confusion among consumers as to the source, origin, or sponsorship of the parties' respective services based on the likely to continue channels of trade in which their goods and services are offered, the conditions under which sales are made, and buyers to whom sales are made.

Settlement agreements in concurrent use proceedings generally identify geographical territories of use that are mutually exclusive. *See* TMEP § 1207.04 (2015). Notwithstanding the concurrent use statement in Applicant's involved application, the parties now have agreed to not restrict either Applicant's use and/or registration of its involved mark or Registrant's use and/or registration of its involved mark to a geographical territory. Rather, the parties have entered into a consent agreement (not a concurrent use agreement) that allows for the parties' geographically unrestricted uses and/or registrations. Such consent agreements may avoid geographical restrictions being placed on any party's registration, with the possible desired result of each party owning an unrestricted registration, pursuant to the terms of the consent agreement. *See Holmes Oil Co.* v. *Myers Cruizers of Mena Inc.*, 101 USPQ2d 1148, 1150 (TTAB 2011) (traditional consent agreement considered in concurrent use proceeding where only applicant's

registration was to be geographically restricted found sufficient in view of provisions in agreement indicating nature of each party's use, restrictions on use, basis for parties' consent, and measures to be taken should actual confusion arise).

An agreement that includes provisions for the use and registration of the parties' respective marks, when it would be clearly against their business interests to cause confusion on the part of the public, can be persuasive in showing that the marks are not likely to cause confusion. *See Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988). Consent agreements that include information as to why the parties believe confusion is unlikely, evidencing the parties' business-driven belief that there is no likelihood of confusion, and provide provisions to avoid any potential confusion, are entitled to great weight in favor of a finding that confusion is not likely. *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *Bongrain Int'l (Am.) Corp.* v. *Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987). The persuasiveness of a consent agreement depends on the reasons provided by the parties as to why they have reached the conclusion that confusion is not likely.

The present agreement could be improved upon by including a more detailed statement of steps that the parties will take should cases of actual confusion arise and an explanation of the specific reasons for the parties' belief that confusion is not likely. We note, however, that the parties in their agreement highlight "the differences between their marks, services, and trade channels," as well as the

"peaceful coexistence" of their marks without actual confusion for over five years. Further, the parties agree to take corrective action in the event any confusion between the marks comes to their attention. Moreover, although the agreement is silent on this point, plastic surgery is, to state the obvious, a relatively expensive medical procedure. And, given the consequences of plastic surgery, consumers of plastic surgery services are likely to be knowledgeable and to exercise a high degree of care when making their purchasing decision. *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1413 (TTAB 2010). This sophistication of purchasers also militates against a likelihood of confusion.

We find that this agreement between parties who are familiar with trade and market practices for their respective services provides adequate evidence that confusion is unlikely and supports Applicant's right to register its mark without a geographical restriction. *See In re Four Seasons Hotels Ltd.*, 26 USPQ2d at 1073; *Bongrain Int'l (Am.) Corp. v. Delice de France Inc.*, 1 USPQ2d at 1775; *Holmes Oil Co.* v. *Myers Cruizers of Mena Inc.*, 101 USPQ2d at 1150. *See also In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 970 (Fed. Cir. 1985) ("While we are uninformed as to all the details of the disputes and negotiations, these competitors clearly thought out their commercial interests with care. We think it highly unlikely that they would have deliberately created a situation in which the sources of their respective products would be confused by their customers.").

Although the parties did not file a stipulated amendment of the concurrent use application to delete the previously recited geographical restriction, we nonetheless

construe the parties' consent agreement to include a consented motion to amend Applicant's concurrent use application to a geographically unrestricted application, which we hereby grant.

Accordingly, it is so ordered that:

The geographical restriction in Application Serial No. 85762778 is removed (and there is no geographical restriction in Registration No. 4038924). This amendment expands Applicant's rights and, accordingly, requires notice to third parties by way of republication. *See* TMEP § 1501.03.

Application Serial No. 85762778 will be republished for opposition in the *Official Gazette* as a geographically unrestricted application.

This proceeding is hereby dissolved with prejudice.