

THIS ORDER IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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CCL

Mailed: June 9, 2017

Concurrent Use No. 94002700

Bras for the Cause Iowa, Inc.

v.

Soroptimist International of Glendale, CA

Before Mermelstein, Kuczma, and Lynch,
Administrative Trademark Judges.

By the Board:

In the context of now-terminated Opposition No. 91224064, which was converted to this concurrent use proceeding, Bras for the Cause Iowa, Inc. (“Applicant”) amended its application, Application Serial No. 86182644, to seek concurrent use registration of the standard character mark BRAS FOR THE CAUSE for “Charitable fundraising services for screening, diagnosis, and eradication of breast and cervical cancer” in International Class 36¹ “throughout the United States of America, with the exception of the State of California.”² Applicant identified Soroptimist

¹ Application Serial No. 86182644, filed on February 3, 2014 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), stated 2007 as the date of first use and first use in commerce.

² Opposition No. 91224064, 5 TTABVUE 3; Concurrent Use No. 94002700, 1 TTABVUE (Board order accepting the amendment to concurrent use).

International of Glendale, CA (“SIG”) as the sole exception to Applicant’s exclusive right to use its mark in commerce. At that time, SIG had a pending application, Application Serial No. 86678705 for the standard character mark BRAS FOR A CAUSE for “charitable fundraising services, namely, conducting fundraising to support women’s causes” in International Class 36. SIG’s application was filed after Applicant’s, but claimed a date of first use in commerce earlier than Applicant’s.

The parties engaged in settlement negotiations and on December 29, 2016, Applicant filed a motion to dismiss this proceeding, accompanied by a settlement agreement that the parties sought to have entered.³ The Board did not grant the motion out of concern whether the terms of the agreement sufficiently averted likely confusion, because of the agreed-upon concurrent use of the parties’ nearly identical marks for overlapping services in potentially overlapping geographic territory.⁴ A concurrent use registration may issue only where it is determined “that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used.” Trademark Act Section 2(d), 15 U.S.C. § 1052(d); *see also Southwestern Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1020 (TTAB 2015).

The Board’s order allowed the parties 60 days to present a revised agreement to “provide[] more specific information as to why confusion is believed to be unlikely,

³ 3 TTABVUE.

⁴ 5 TTABVUE.

together with supporting facts and undertakings of the parties.”⁵ The order further noted that “[a]ny such revised agreement also should include a specific provision regarding the proposed geographic restriction to be placed in Applicant’s application,” as such a proposed restriction was omitted from the settlement agreement.⁶ Within the allotted time, Applicant submitted a revised settlement agreement (“Revised Agreement”).⁷ Like the first agreement, the Revised Agreement involves the parties to this proceeding, as well as an additional entity, Soroptimist International of the Americas, Inc. (“SIA”). According to the Revised Agreement, SIA uses the mark BRAS FOR THE CAUSE for charitable fundraising to support women’s causes in California, Colorado, Florida, Oregon, Pennsylvania, Washington and Wyoming.⁸

In the Revised Agreement, the parties and SIA agree, *inter alia*:

- That SIG and SIA will not “use the mark BRAS FOR THE CAUSE in Iowa or its contingent states of Minnesota, Wisconsin, Illinois, Missouri, Nebraska or South Dakota,” which are designated for Applicant’s use;
- That Applicant will not “use the mark BRAS FOR A CAUSE in the states of California, Colorado, Florida, Oregon, Pennsylvania, Washington, or Wyoming,” which are designated for SIG’s and SIA’s use, and Applicant “will so limit its pending trademark application;”

⁵ *Id.* at 5.

⁶ *Id.* at 6.

⁷ 6 TTABVUE.

⁸ *Id.* at 3.

- That if either party desires to expand the use of its marks outside the designated states, they will follow the procedure set out in the Revised Agreement to prevent overlap, providing for advance notice and in certain scenarios, consent or the withholding thereof;
- That potential confusion is *de minimis* or unlikely;
- That their respective trade channels differ and their respective fundraising activities are “highly localized,” each “within a limited geographic community near” their respective offices;
- That they will follow a procedure set out in the Revised Agreement to address any instances of actual confusion that may arise;
- That SIG has abandoned its application,⁹ and neither SIG nor SIA will apply to register BRAS FOR A CAUSE as long Applicant continues to use its mark;
- That Applicant “agrees to permit SIG and any of the SIA clubs to use SIG’s mark, as well as any logo that includes the words ‘BRAS FOR A CAUSE;’” and
- That SIA will not oppose Applicant “in using Applicant’s mark and any logo that includes the words ‘BRAS FOR THE CAUSE’” and SIG and SIA consent to the use and registration of Applicant’s mark.

An agreement that includes information as to why the parties believe confusion is unlikely, that evidences the parties’ business-driven belief and conclusion that there is no likelihood of confusion, and that includes provisions to avoid any potential

⁹ SIG filed an express abandonment of Application Serial No. 86678705.

confusion, is entitled to great weight in finding confusion unlikely. *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071, 1072 (Fed. Cir. 1993); *Bongrain Int'l (Am.) Corp. v. Delice De France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987). The Revised Agreement adequately addresses the concerns previously noted by the Board with the first settlement agreement, as it includes procedures addressing potential use by either party in any undesignated territory, specific measures for the avoidance of confusion, and specific measures to address actual confusion in the event it arises. The Revised Agreement also sets forth the proposed geographic restriction to be placed in Applicant's application. Accordingly, we find that concurrent use of the involved marks is not likely to cause confusion under 15 U.S.C. § 1052(d).

Decision:

Applicant demonstrated that it is entitled to a restricted registration of its mark, and the registration to issue from Application Serial No. 86182644 will be restricted by addition of the following statement:

Registration limited to the area comprising the United States except the states of California, Colorado, Florida, Oregon, Pennsylvania, Washington, and¹⁰ Wyoming, pursuant to Concurrent Use Proceeding No. 94002700.

¹⁰ To adapt the representation in the Revised Agreement regarding geographic territory to the restriction statement, "and" has been substituted for "or."