ESTTA Tracking number: **ESTTA1029749**

Filing date: **01/17/2020**

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

Proceeding	94002792
Party	Applicant Kent Elliott Construction, Inc.
Correspondence Address	LISA R HEMPHILL FOLEY & LARDNER LLP 2021 MCKINNEY AVENUE SUITE 1600 DALLAS, TX 75201 UNITED STATES ip@gardere.com, kschwartz@gardere.com, lhemphill@foley.com 214-999-4702
Submission	Response to Board Order/Inquiry
Filer's Name	Lisa R. Hemphill
Filer's email	ipdocketing@foley.com, kschwartz@foley.com, lhemphill@foley.com, as-trange@feesmith.com
Signature	/Lisa R. Hemphill/
Date	01/17/2020
Attachments	Concurrent Use Proceeding 94002792-Kent Elliot.pdf(384120 bytes)

BEFORE THE U.S PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

January 17, 2020

Concurrent Use No. 94002792

Kent Elliott Construction, Inc.
(Concurrent Use Applicant)

v.
C&C Investment Holdings, LLC
(Registrant)

RESPONSE TO BOARD'S ORDER OF NOVEMBER 22, 2019

Pursuant to the Board's Order of November 22, 2019, the parties herein submit a fully executed Consent Agreement reciting facts and conditions that should be sufficient to persuade the Board that the concurrent use of the same or highly similar marks used by the parties for the same or similar services in their respective geographical areas is not likely to cause confusion.

CONCLUSION

The parties respectfully request that the concurrent use registrations of their respective marks be accepted and entered by the Board.

Respectfully submitted,

/Lisa R. Hemphill/
Lisa R. Hemphill
Kay Lyn Schwartz
FOLEY & LARDNER LLP
2021 McKinney Ave., Suite 1600
Dallas, TX 75201
Email: ipdocketing@foley.com
Phone: 214.999.3000

ATTORNEYS FOR
CONCURRENT USE APPLICANT

CONSENT AGREEMENT

This CONSENT AGREEMENT (the "**Agreement**") is entered into and effective as of the last date of the last signatory below (the "**Effective Date**"), by and between **Kent Elliott Construction, Inc.**, a Texas corporation, having a business address at 2916 Eggleston Road, Crowley, Texas 76036 ("**Kent Elliott**") and **C&C Investment Holdings, LLC DBA Elliott Roofing**, an Oklahoma limited liability company, having a business address at 3900 North Harvard Avenue, Oklahoma City, OK 73122 ("**CCIH**"). (Sometimes Kent Elliott and CCIH are collectively referred to as "the Parties" or individually referred to as the "Party.") In consideration of the following terms, covenants and conditions, and other good and valuable consideration, the receipt of which is hereby acknowledged, the Parties acknowledge and agree as follows:

1. Kent Elliott and CCIH are parties to that certain Coexistence and Concurrent Use Registration Agreement dated as of April 30, 2019 (the "**Initial Coexistence Agreement**") which governs the parties' respective use and registration of certain marks used in their respective businesses, specifically the following marks used by Kent Elliott:

a. KENT ELLIOTT ROOFING;

b.

; and

c.

(the "KENT ELLIOTT Marks") and the following marks used by CCIH:

a. ELLIOTT ROOFING; and

b.

(the "CCIH Marks").

2. For more than 35 years prior to the Initial Coexistence Agreement, and continuing up and until the Effective Date of this Agreement, there have been no known instances of actual confusion between the Parties' uses of their respective marks, and the Parties have been able to peacefully co-exist.

3. On March 31, 2016 and August 25, 2016, respectively, Kent Elliott filed federal applications with the U.S. Patent and Trademark Office ("**USPTO**") for registration of its KENT ELLIOTT Marks, having the following filing particulars (hereinafter the "Kent Elliott Applications"):

Mark	**U.S. Application Serial No.**	**Services**	**Filing Date**
KENT ELLIOTT ROOFING	86/960378 (the '378 application)	Roofing consultation; roofing contracting; roofing installation; roofing repair; roofing services in Class 37	03-31-2016
	76/719664 (the '664 application)	Roofing services; roofing consultation; roofing contracting; roofing installation; roofing repair in Class 37; and roof inspection in Class 42	08-25-2016
	76/719665 (the '665 application)	Roofing services; roofing consultation; roofing contracting; roofing installation; roofing repair in Class 37; and roof inspection in Class 42	08-25-2016

4. On December 13, 2016, the USPTO issued Office Actions against the above-identified '664 and '665 applications, and on April 3, 2017 the USPTO issued an Office Action against the above-identified '378 application, all citing CCIH's U.S. Registration No. 4059669 for ELLIOTT ROOFING, and Registration No. 4059671 for the CCIH Marks for use in connection with roofing consultation; roofing contracting; roofing installation; roofing repair; roofing services in Class 37, as a bar to registration of the KENT ELLIOTT Marks.

5. The Parties have reviewed information regarding their respective businesses, and have concluded that there has not been any actual confusion, and there is no likelihood of confusion as to the concurrent use of the Parties' respective marks for many reasons based upon the best information available to the Parties and their knowledge of the marketplace conditions under which the respective marks have been used, including but not limited to the following:

a. Historical Coexistence. The historical coexistence of the Parties' roofing businesses and corresponding KENT ELLIOTT and ELLIOTT ROOFING marks for more than 35 years in their geographical areas of use.

b. Different Marks. The Parties' respective marks have distinct commercial impressions and are distinguishable in the marketplace. In particular, the KENT ELLIOTT Marks all contain the additional term "KENT." Further, the Parties'

respective design marks/logos contain dissimilar design elements. Specifically, the Kent Elliott design marks are used in connection with a half diamond design comprised of six smaller diamond designs appearing to the left of the words KENT ELLIOTT Roofing; whereas, CCIH's design mark incorporates a portion of a roof having a chimney depicted above a curved line. Such distinct visual differences create different commercial impressions in the marketplace and will not lead to confusion among consumers.

c. No Advertising in the Other Party's Market. The Parties have agreed to refrain from using or advertising their respective marks in the other's current geographic markets, including local print ads, radio ads, etc. with the exception that use of their respective marks on their respective social media and Internet platforms will be acceptable. This prohibition does not prevent either party from travelling through any of the Texas Counties identified in Paragraph 7 below in a vehicle with their respective marks for non-business/non-advertising purposes.

d. Distinctive Signage. The Parties agree to use their respective marks on the signage used on their buildings and trucks to prevent any consumer confusion.

e. Cooperate. The Parties agree to take whatever steps are necessary to prevent actual confusion in the marketplace.

6. Kent Elliott agrees to the amendment of its applications, Nos. 86/960378, 76/719665, and 76/719664, to restrict the registration of the KENT ELLIOTT Marks to only the following Texas counties: Coke, Concho, Crocket, Ector, Edwards, Irion, Llano, Menard, Midland, Pecos, Reagan, Runnels, Schleicher, Sutton, Taylor, Tom Green, and Val Verde.

7. CCIH agrees to amend its Registrations, Nos. 4059669 and 4059671, to restrict the registration protection to the entire United States except for the Texas counties of Coke, Concho, Crocket, Ector, Edwards, Irion, Llano, Menard, Midland, Pecos, Reagan, Runnels, Schleicher, Sutton, Taylor, Tom Green, and Val Verde.

8. CCIH consents to the use and registration of the KENT ELLIOTT Marks in connection with U.S. Application Serial Nos. 86/960378, 76/719665, and 76/719664 for use in the following Texas counties only: Coke, Concho, Crocket, Ector, Edwards, Irion, Llano, Menard, Midland, Pecos, Reagan, Runnels, Schleicher, Sutton, Taylor, Tom Green, and Val Verde.

IN WITNESS WHEREOF, the duly authorized agents of the parties to this Agreement have executed it effective as of the last date signed below.

KENT ELLIOTT CONSTRUCTION, INC.

By: _____

Printed Name: Brandon Smythe

Title: Owner

Date: 1/13/20

C & C INVESTMENT HOLDINGS, LLC
DBA ELLIOTT ROOFING

By: _____

Printed Name: Matthew Case

Title: Partner

Date: 1/16/2020