

THIS ORDER IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Myles/Butler

March 8, 2021

Concurrent Use No. 94002984

Southcoast Medical Group, LLC

v.

Southcoast Health System, Inc

By the Trademark Trial and Appeal Board:

Southcoast Medical Group, LLC (“Applicant”) seeks concurrent use registration of the standard character mark SOUTHCOAST for the following services: “Patient relationship management services; Retail optical store services; Retail pharmacy services” in International Class 35; “Medical laboratory services; Medical and scientific research, namely, conducting clinical trials for others” in International Class 42; “Dietitian services; Massage therapy services; Medical services; Medical testing for diagnostic or treatment purposes; Urgent medical care centers” in International Class 44; and “Providing patient advocate services in the field of case management, procurement coordination and healthcare provider management” in

International Class 45.¹ Applicant identifies its claimed territory of use as the geographic area comprising the states of Georgia and South Carolina.

As an exception to its exclusive right to use its mark, Applicant names use by Southcoast Health System, Inc. (“Registrant”). Registrant owns Registration No. 4363636 for the standard character mark SOUTHCOAST for “Administration of pre-paid health care plans; Credit union services” in International Class 36 and “Health care; Health care services, namely, wellness programs; Managed health care services” in International Class 44.²

On December 17, 2020, the Board instituted this concurrent use proceeding. On January 26, 2021, Registrant filed the parties’ “Notice of Settlement Providing for Concurrent Registration” (“Notice”) together with a copy of a Trademark Coexistence Agreement (“Agreement”) executed by both parties.³ In the Agreement, Registrant’s geographic area is identified as comprising the entire United States, except for the states of Georgia and South Carolina.⁴

The Notice and Agreement provide that the parties do not believe there is a likelihood of confusion between their respective marks in their geographically restricted areas based upon the differences in the parties’ customers and based upon

¹ Application Serial No. 88555131, filed July 31, 2019, claiming May 1, 1995 as both the date of first use anywhere and the date of first use in commerce.

² Registration No. 4363636, filed July 30, 2012, and issued July 9, 2013, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

³ Registrant’s notice of appearance, filed January 26, 2021 is noted and Board records have been updated accordingly.

⁴ 4 TTABVUE 3, 8.

the fact that the parties have a long history of coexistence without any evidence of actual confusion.⁵

The Agreement provides for concurrent use of the parties' respective marks within the specified geographic territories, in accordance with the following terms: (1) Applicant agrees not to use its mark in connection with the operation of a hospital; (2) each party will identify its geographic area on the home page of its website; (3) the parties will not intentionally promote their goods or services in a manner to cause confusion; (4) the parties will not suggest any affiliation or association with each other; (5) the parties agree to take any other reasonable measures to avoid confusion and to consult with each other in good faith; and (6) the parties agree to notify each other in the event actual confusion arises and to take steps to remedy such confusion.⁶

Based upon the Agreement, the Board is persuaded that Applicant and Registrant are entitled to concurrent use registrations. In making its 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 that 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 N.Y. v. Amalgamated Trust & Savings*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988).

⁵ *Id.* at 3, 7.

⁶ *Id.* at 8-9.

DECISION

Concurrent use registration is **approved** for Applicant's pending application for the mark SOUTHCOAST for the following services: "Patient relationship management services; Retail optical store services; Retail pharmacy services" in International Class 35; "Medical laboratory services; Medical and scientific research, namely, conducting clinical trials for others" in International Class 42; "Dietitian services; Massage therapy services; Medical services; Medical testing for diagnostic or treatment purposes; Urgent medical care centers" in International Class 44; and "Providing patient advocate services in the field of case management, procurement coordination and healthcare provider management" in International Class 45.

Restriction of Registrant's registration for the mark SOUTHCOAST for "Administration of pre-paid health care plans; Credit union services" in International Class 36 and "Health care; Health care services, namely, wellness programs; Managed health care services" in International Class 44 is **approved**.⁷

The concurrent use statements will read as follows:

Southcoast Medical Group, LLC's Application Serial No. 88555131

Registration limited to the area comprising the states of Georgia and South Carolina, pursuant to Concurrent Use No. 94002984. Concurrent registration with Southcoast Health System, Inc. (Registration No. 4363636).

Southcoast Health System, Inc.'s Registration No. 4363636

Registration limited to the area comprising the entire United States, except for the states of Georgia and South Carolina, pursuant to Concurrent Use No.

⁷ In view of the foregoing, the parties' stipulated motion to extend, filed February 25, 2021, is moot.

Concurrent Use No. 94002984

94002984. Concurrent registration with Southcoast Medical Group, LLC
(Application Serial No. 88555131).