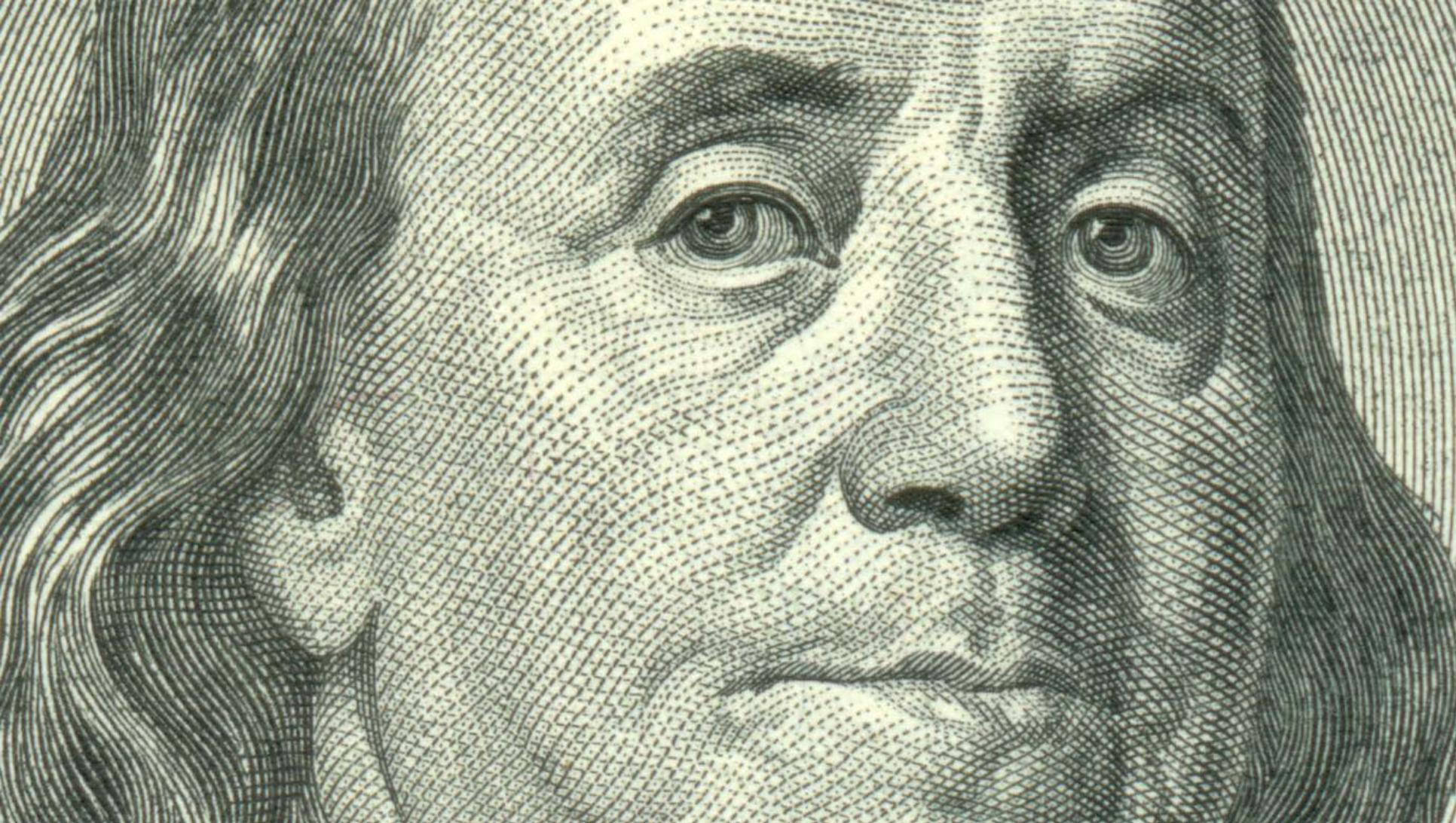


Sharing Trademarks

Concurrent Trademark Use in the United States



Concurrent Use in the U.S.

- Use-Based System Encourages Concurrent Use
- Good Faith Use of Confusingly Similar Marks
- Multiple Parties
- Used in Manner that Avoids Source Confusion
 - Geographic diversity
 - Different channels of trade



**U.S. Common
Law Rights**

U.S. Use-Based System

- Trademark Rights are not a Property Right or Government Grant
 - Consumer right to be free from confusion
- Valid “Common Law” Rights
 - Protectable mark
 - Use in commerce
 - Geographic “firstness”
- Common Law Rights Are Limited by Actual Market Area
- Consumer Perception/Awareness is Key

Common Law Question: Who Owns The Mark?

- First In Time User in Each Separate Market Area Owns Rights in That Area (plus logical zone of expansion)
- Rights Are Limited to Specific Market Area
- Race to Remaining Markets



U.S. Use-Based System

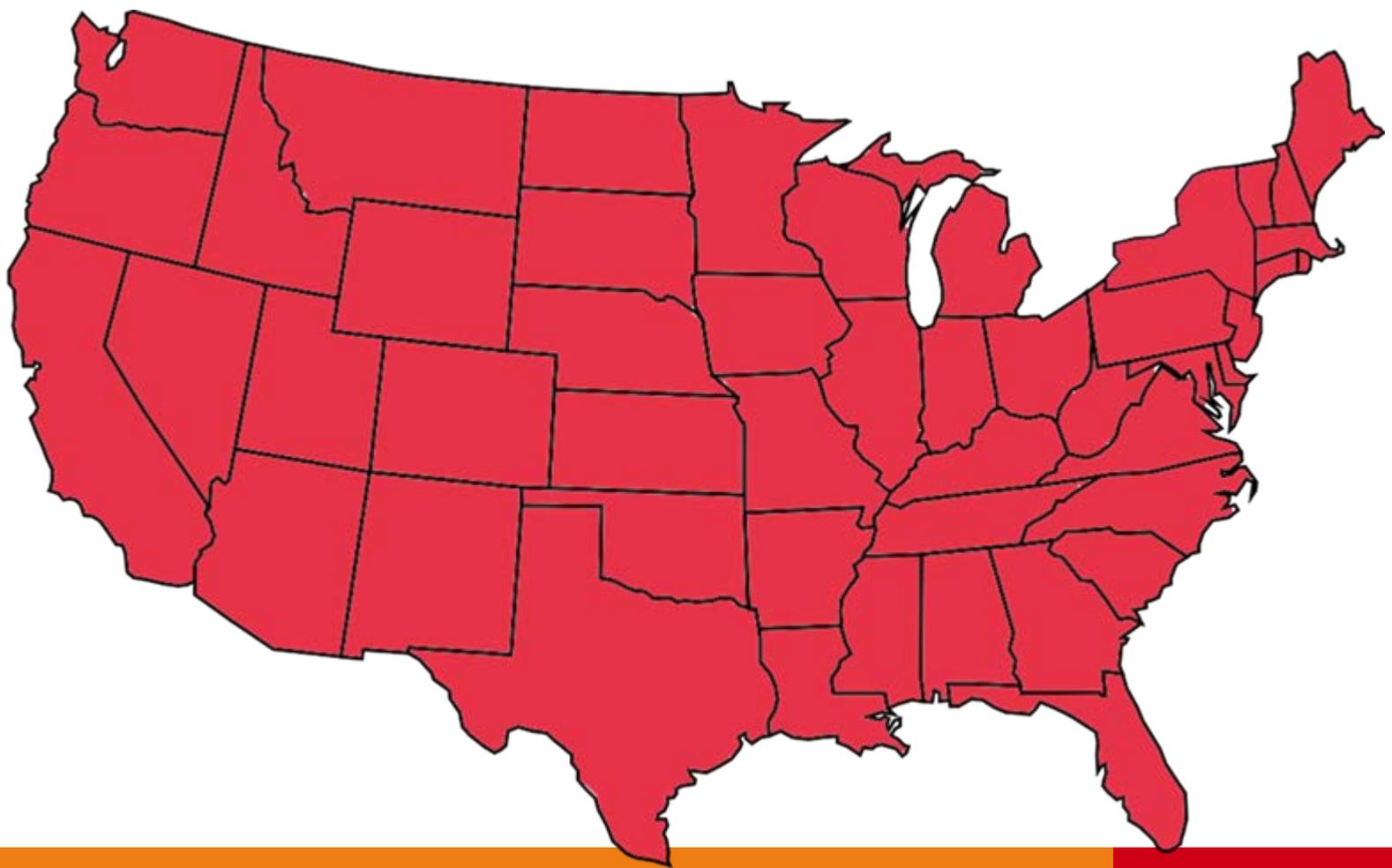
- Often Results in Concurrent Use on a Nationwide Scale, but Avoids Consumer Confusion
- Geographic Diversity Prevents a Likelihood of Confusion (In Most Cases)
 - The same consumers are not encountering both marks
 - No overlap in area, no confusion
 - Largely depends on nature of products/services
 - What about the internet?



**U.S.
Nationwide
Registration**

U.S. Registration

- Does Not Replace Common Law System
 - Merely enhances existing common law rights
 - Provides presumption of nationwide rights to use mark
 - Prior common law rights remain superior in limited geographic areas, but common law rights are “frozen” in place
- Registration System Creates Concurrent Use Conflicts



Who Owns The Mark?

- Two Parties Own Common Law Rights
- Who Gets a Registration?
 - Possibly neither party
 - Possibly both
- What Does the Registration Cover?
 - Nationwide registration with exception?
 - Concurrent use proceeding
 - If marks can truly coexist; rights can still be nationwide

Registration Process

- Subsequent Applications Refused Based on Prior Registrations
 - USPTO is extremely cautious- marks always closer than they appear in the real world
- Coexistence Agreements Given Great Weight In Prosecution
 - Must actually be designed to prevent marketplace confusion
 - Need specific facts that ensure consumers will not be confused
 - Different goods, consumers, channels of trade; limited geography; etc.
 - Insufficient agreements are rejected
- Only Guarantee of Nationwide Rights in U.S.: File Application Before Any Competing Use



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KING**

**DB CHEESEBURGERS
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\$ 2.79**

DRINK
Coca-Cola





LOCATIONS

[International Locations](#)

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Search Radius 15 miles

Find Your BK®

! No restaurants found. Please try adjusting the search radius.

Map data ©2013 Google 20 km Terms of Use Report a map error

Dawn Donut Rule

- Senior User Registrant Cannot Enjoin Use of Infringing Mark by a Junior User in Geographically Separate Area
- Court Held:
No Confusion, No Problem
- Still Relevant in Internet Age?

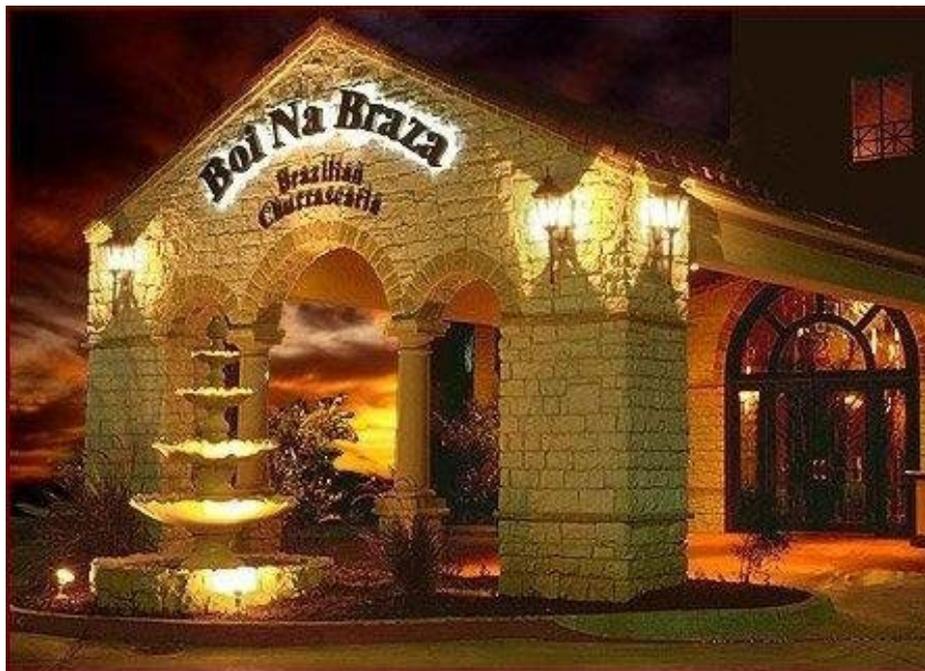




**Formal
Concurrent
Use**

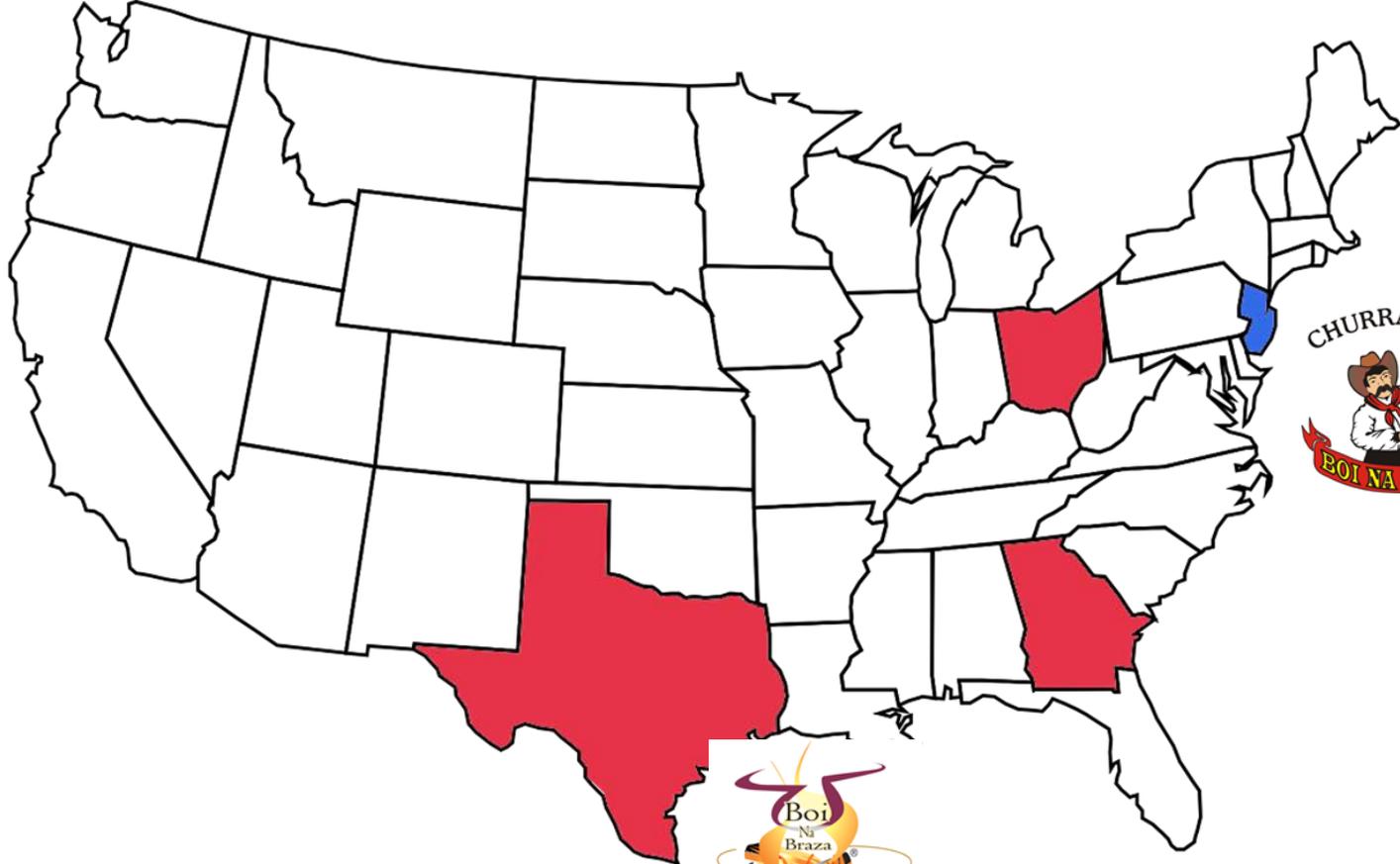
USPTO Concurrent Use Procedure

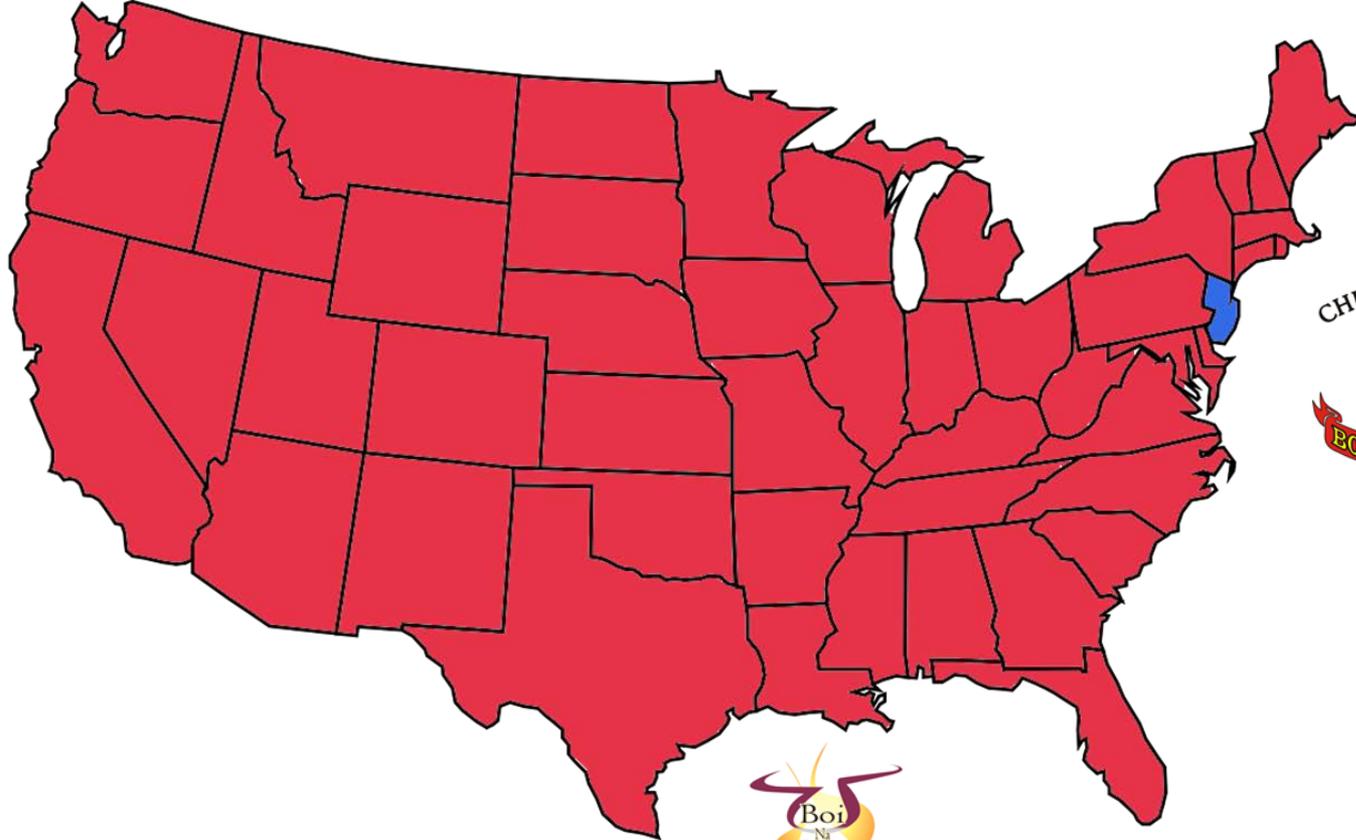
- Requirements
 - Good faith concurrent use in commerce
 - No likelihood of confusion based on concurrent use
- Almost Always a Geographic Restriction
 - Does geography prevent confusion?
 - Years of coexistence to date?
- Scope of Geographic Limitation
 - TTAB looks at previous business activity, expansion history/plans, dominance of use in contiguous areas, any other considerations to determine scope of rights

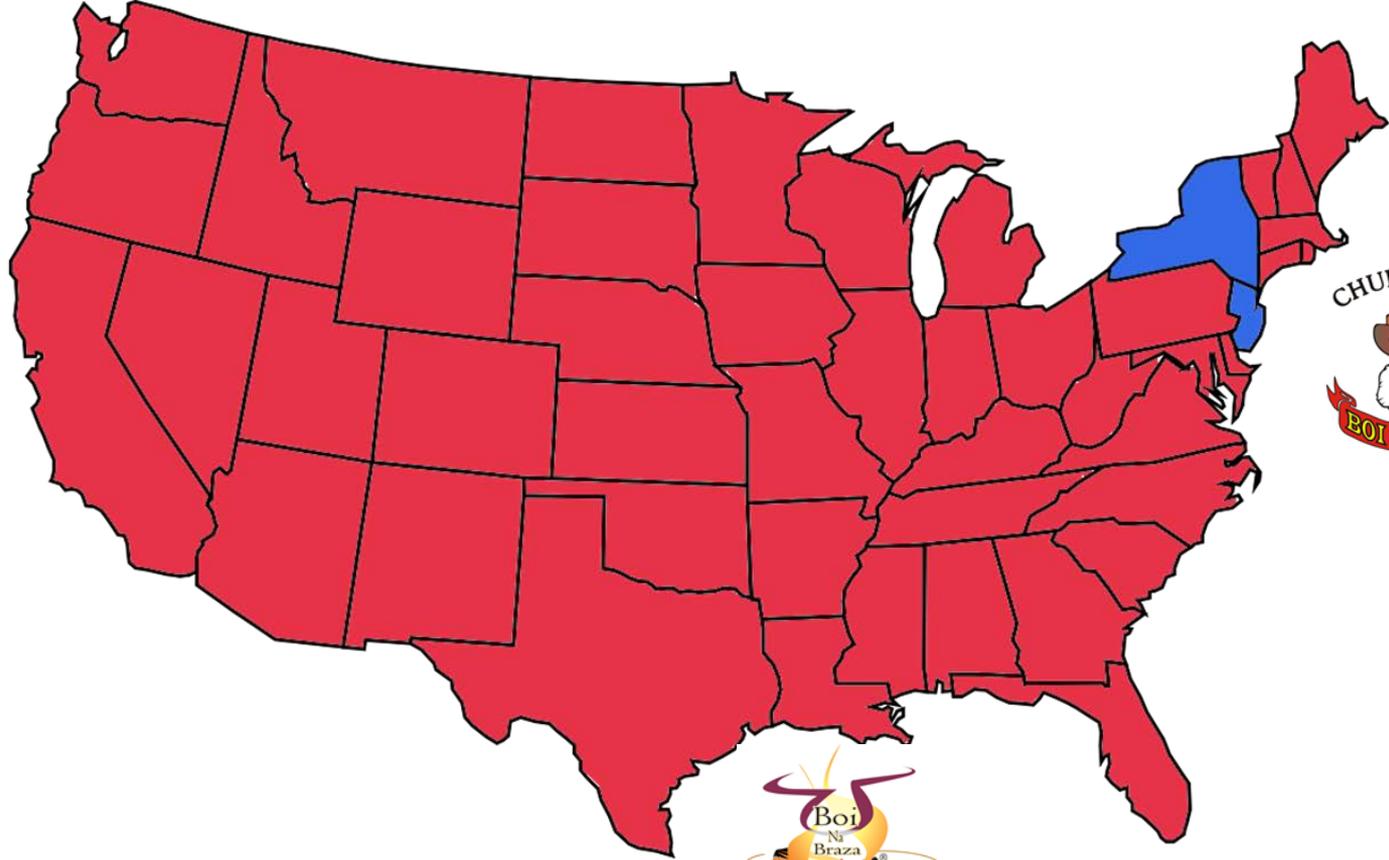












BOI NA BRAZA

Reg. No. 4,535,159

Registered May 27, 2014

Int. Cl.: 43

SERVICE MARK

PRINCIPAL REGISTER

BOI NA BRAZA, LLC (TEXAS LIMITED LIABILITY COMPANY)
4025 WILLIAM D. TATE AVENUE
GRAPEVINE, TX 76051

FOR: RESTAURANT AND BAR SERVICES, IN CLASS 43 (U.S. CLS. 100 AND 101).

FIRST USE 7-19-1999; IN COMMERCE 9-11-2000.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

REGISTRATION LIMITED TO THE AREA COMPRISING THE ENTIRE UNITED STATES EXCEPT THE STATES OF NEW JERSEY AND NEW YORK PURSUANT TO CONCURRENT USE PROCEEDING NO. 94002525. CONCURRENT REGISTRATION WITH TERRA SOL CORPORATION A/K/A/ CHURRASCARIA BOI NA BRASA.

OWNER OF U.S. REG. NO. 2,666,968.

THE ENGLISH TRANSLATION OF THE MARK IS "STEER OVER EMBERS".

SER. NO. 77-779,339, FILED 7-13-2009.

“Registration limited to the area of the entire United States except the states of New Jersey and New York . . .”



Takeaways

Takeaways

- A Great Deal of Concurrent Use in the US
 - Most is not an issue
- Registration Does Not Automatically Provide Nationwide Rights
- Coexistence Agreements are Common
 - Define rights of parties
 - Avoid consumer confusion
 - May even allow both parties to register
- Formal Concurrent Use Proceedings are Rare
- Best Case Scenario: File Registration Before Another Party Uses Mark



Thanks!

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