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United States: Trademark Trial And Appeal Board: In Unusual Circumstances, TTAB Rejects A Coexistence Agreement (Consent To Registration)

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In re Bay State Brewing Company, Inc., 117 U.S.P.Q.2d 1958 (T.T.A.B. 2016)

In a precedential case decided on February 25, 2016, the Trademark Trial and Appeal Board ("TTAB") took the unusual step of rejecting a coexistence agreement as a sufficient basis to remove a blocking citation of a prior registration, in an appeal of the examining attorney's rejection of the agreement. This is an unusual outcome because United States Patent and Trademark Office examining attorneys almost always accept coexistence agreements as sufficient to remove blocking citations, based on a long line of precedents holding that coexistence agreements are entitled to great weight, so long as they state some credible reasons why confusion is unlikely.

Such coexistence agreements often include provisions that each party will use the mark at issue only with a distinguishing house mark and that the parties will use distinctly different trade dress. The agreement under review in this case included both those provisions. However, the applicant's mark, TIME TRAVELER BLONDE for beer, with the descriptive term BLONDE disclaimed, was essentially identical to the prior registered mark, TIME TRAVELER for beer. The registrant apparently agreed to the coexistence only because the applicant had priority, based on earlier use, although the registrant had the earlier filing date. The TTAB held that these confusion-avoiding provisions were insufficient to avoid confusion given the identity of the goods and the near identity of the marks. *In re Bay State Brewing Company, Inc.*, 117 U.S.P.Q.2d 1958, 1967 (T.T.A.B. 2016). The TTAB was also troubled by the fact that the two parties were located in adjacent states in New England, and that the coexistence agreement allowed the parties to use their marks in the same geographic area. *Id.* at 1964. The TTAB's opinion noted that beers are often ordered on draft, so that consumers might not ever see the different product labels bearing distinguishing house marks and different trade dress. *Id.* at 1967 n.16. Also, the TTAB noted that beer can be inexpensive and bought on impulse, another factor that makes it easy for consumers to be confused. *Id.* at 1960.

Apart from the agreement's inadequacy to prevent consumer confusion, the TTAB also expressed concern that the registration resulting from the agreement would not reflect commercial reality. The applicant sought a nationwide registration, with no geographic restriction, but the coexistence agreement required the applicant to limit its use of the mark to New England and New York. Therefore, the "registration would be misleading." *Id.* at 1965. In a footnote, the TTAB said that "we see harm to the registration system of searching and clearing marks when the register includes marks that appear to be in direct conflict with each other and yet are on the register at the same time." *Id.* at 1965 n.11.

This case is a reminder that trademark coexistence agreements do not always work and that especially thorough and convincing provisions to avoid confusion will be necessary when both the marks and goods are very close. In most coexistence

agreements, either the marks or the goods are more different than those involved in this case. In addition, when marks and goods are very close, the applicant may wish to include a provision in the coexistence agreement requiring the registrant to (1) provide an additional and more detailed coexistence agreement, if possible, if the first agreement is rejected by the USPTO examining attorney, and (2) consent to a further application for the mark plus additional matter, such as a house mark or the whole proposed label containing the mark, or to voluntarily cancel or amend its registration (in cases where the applicant has priority), if the coexistence agreement for the applicant's mark in standard characters is rejected.

The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.

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